

No. 15893✓

United States
Court of Appeals
for the Ninth Circuit

CEE-BEE CHEMICAL CO., INC., a corporation,
Appellant,

vs.

DELCO CHEMICALS, INC., a corporation,
Appellee.

Transcript of Record

In Two Volumes

VOLUME I.

(Pages 1 to 222, inclusive)

Appeal from the United States District Court for the
Southern District of California,
Central Division

FILED

MAY 22 1958

PAUL P. O'BRIEN, CL

No. 15893

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Court of Appeals
for the Ninth Circuit

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[Clerk's Note: When deemed likely to be of an important nature, errors or doubtful matters appearing in the original certified record are printed literally in italic; and, likewise, cancelled matter appearing in the original certified record is printed and cancelled herein accordingly. When possible, an omission from the text is indicated by printing in italic the two words between which the omission seems to occur.]

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* Page numbers appearing at bottom of page of Original Transcript of Record.

In the United States District Court, Southern
District of California, Central Division

Civil Action No. 17387-WB

DELCO CHEMICALS, INC., a corporation,
Plaintiff,

vs.

CEE-BEE CHEMICAL CO., INC., a corporation,
TURCO PRODUCTS, INC., a corporation,
and DOE ONE to DOE FIVE,
Defendants.

COMPLAINT FOR DECLARATORY JUDG-
MENT OF PATENT INVALIDITY AND
NON-INFRINGEMENT, UNFAIR COMPE-
TITION, AND DAMAGES AND INJUNC-
TIVE RELIEF UNDER SHERMAN AND
CLAYTON ANTI-TRUST LAWS

Comes now the plaintiff, Delco Chemicals, Inc.,
a corporation, and complains and alleges against
the defendants, as follows:

Claim for Declaratory Judgment

1.

This claim is for declaratory judgment of patent
invalidity and non-infringement and this court has
jurisdiction thereof under 28 U.S.C., 2201 and
2202, and 28 U.S.C. 1338 (a).

2.

Plaintiff is a Delaware corporation having its [2]

principal place of business in the County of Los Angeles, State of California, within the Southern Judicial District of California, Central Division.

3.

Defendant Cee-Bee Chemical Co., Inc. is a California corporation doing business in the County of Los Angeles, State of California, within the Southern Judicial District of California, Central Division.

4.

Defendant Turco Products, Inc. is a California corporation doing business in the County of Los Angeles, State of California, within the Southern Judicial District of California, Central Division, and is a licensee of defendant Cee-Bee Chemical Co., Inc. under United States Patent No. 2,653,116.

5.

The true names or capacities, whether corporation or otherwise of defendants Doe 1 to Doe 5 are unknown to plaintiff and when their true names are discovered leave of Court will be requested to amend this complaint accordingly.

6.

An actual controversy has arisen and exists between plaintiff and defendants within the Southern District of California, Central Division, with respect to each and all of the following matters, to wit:

(a) Defendant Cee-Bee Chemical Co., Inc. on

behalf of itself and as agent for defendant Turco Products, Inc. has contended and continues to contend: that on the 22nd day of September, 1953, United States Patent No. 2,653,116 was duly and legally issued to it for an invention of Keith R. Whitcomb and Eugene E. Finch for Improvement in Method of Removing Sealant from Fuel Tanks; that it is the owner of said letters patent and that plaintiff is infringing upon said letters patent by making and [3] selling apparatus for use and practice of the methods set forth and claimed in said patent and each of the claims thereof.

(b) Plaintiff has contended and continues to contend: that said patent 2,653,116 was not duly or legally issued, that said patent does not claim or cover an invention or any inventions, that use of plaintiff's apparatus does not infringe said patent, and that said patent and each of the claims thereof are invalid and void for each of the following reasons:

(1) The said Keith R. Whitcomb and Eugene E. Finch were not the original or first inventors of that which is claimed to be patented therein or thereby, or any material or substantial part thereof, but that, on the contrary, prior to the alleged invention thereof by said Keith R. Whitcomb and Eugene E. Finch, or more than one year prior to the application for said patent, the methods claimed by said patent, and particularly those which are described in the claims thereof, and all material and substantial parts thereof, had been patented, de-

scribed and published in letters patent or applications therefor as follows:

United States Patents

| Number | Name | Date |
|------------|----------------|---------------|
| Re. 19,374 | Butterworth | Nov. 20, 1934 |
| 1,141,243 | Foster | June 1, 1915 |
| 1,628,141 | Gray | May 10, 1927 |
| 1,666,015 | Land | Apr. 10, 1928 |
| 1,701,824 | Robinson | Feb. 12, 1929 |
| 1,730,658 | Jensen | Oct. 8, 1929 |
| 1,892,950 | Houpt | Jan. 3, 1933 |
| 2,018,757 | Butterworth | Oct. 29, 1935 |
| 2,045,752 | Butterworth | June 30, 1936 |
| 2,065,462 | Olsson | Dec. 22, 1936 |
| 2,092,321 | McFadden | Sept. 7, 1937 |
| 2,123,434 | Paulson et al. | July 12, 1938 |
| 2,442,272 | Jaffe | May 25, 1948 |
| 2,458,333 | Brady | Jan. 4, 1949 |

and in the following printed publications:

Aviation's Notebook, page 166, published 1940 by Aviation, 330 West 42nd St., New York, N. Y.

Aviation Maintenance, Sept., 1944, issue, article by Major-General Clements McMullen

Oakite News Service, Jan.-Feb. 1949 issue, published by Oakite Products, Inc., New York, N. Y.

Turco for Oil Industry, published 1930 by Turco Products, Inc., Los Angeles, California

Technical Talk, published June 15, 1946 by

Turco Products, Inc., Los Angeles, California
Technical Talk, published May 15, 1947 by
Turco Products, Inc., Los Angeles, California
Technical Talk, published May 15, 1946 by
Turco Products, Inc., Los Angeles, California
Turco Material and Methods for Cleaning
Tank Cars, published July 2, 1930 by Turco
Products, Inc. — copyright registered Class
I-XXc #2502

and in other patents and printed publications the identities of which are not known at present to plaintiff but which, when ascertained, plaintiff will pray leave to add hereto by suitable amendment.

(2) The said Keith R. Whitcomb and Eugene E. Finch, the alleged inventors named in said patent 2,653,116, were not the original or first inventors of that which is claimed to be patented therein or thereby, or any material or substantial part thereof, but that on the contrary, prior to the claimed invention [5] thereof by said Keith R. Whitecomb and Eugene E. Finch, that which is claimed in and by said patent 2,653,116 and each of the claims thereof had been invented or used by or known to the patentees and persons named in the foregoing paragraph numbered 6 (b) (1), at the places of residence of the respective patentees named in said patents, and upon information and belief of plaintiff had been known to or used in the United States by the following additional persons and concerns at the addresses shown in conjunction with their respective names:

Carl Hirdler, Los Angeles, California
Pennzoil Company, Los Angeles, California
Douglas Aircraft Company, Santa Monica,
California

Shell Oil Company, Martinez, California
United Air Lines, Cheyenne, Wyoming
Oakite Products, Inc., New York, N. Y.
Turco Products, Inc., Los Angeles, Cali-
fornia

Butterworth Systems, Inc., Bayonne, New
Jersey

The Pyrate Corporation, Bayside, New York
Union Pacific Railroad, Los Angeles, Cali-
fornia

Atchison, Topeka and Santa Fe Railway,
Los Angeles, California

Denver and Rio Grande Western Railroad,
Denver, Colorado

and had been invented or used by or known to others whose addresses are at present unknown to plaintiff but which, when ascertained, plaintiff will pray leave to add hereto by amendment.

(3) That which is claimed by said patent 2,653,-116 and each of the claims thereof was in public use in the United States prior to the alleged invention thereof by said [6] Keith R. Whitcomb and Eugene E. Finch, or more than one year prior to the filing of the application for said patent, by the patentees, persons and concerns identified in paragraphs 6 (b) (1) and (2) hereof, at the places shown in said

patents as being the places of residence of said patentees and at the addresses of the remaining persons and concerns shown in said paragraphs, and by others whose names and places of use are at present unknown to plaintiff but which plaintiff will seek to add hereto by amendment when discovered.

(4) While the application for said patent 2,653,116 was pending in the United States Patent Office, the applicants therefor so limited and confined the claims thereof, under the requirements of the Commissioner of Patents, that the plaintiff herein can not now seek or obtain an interpretation thereof sufficiently broad to cover any method involved in the use of apparatus sold or used by plaintiff.

(5) The art in connection with the methods shown in said patent 2,653,116, as said art is identified in paragraphs 6 (b) (1), (2) and (3) hereof, was crowded prior to the alleged invention or discovery by said Keith R. Whitcomb and Eugene E. Finch, and the conception of the alleged invention or discovery of said patent required no invention whatsoever but only mechanical skill.

(6) The claims of said patent 2,653,116 do not cover any valid or patentable combination or method but embrace mere aggregations of elements or steps which have no patentable combination or cooperation.

(7) The specification and claims of said patent 2,653,116 are ambiguous, indefinite and uncertain, are not distinct and do not teach how to practice the alleged invention thereof and do not particu-

larly point out the parts, movements, combinations or methods which are claimed as the alleged invention of said patent, [7] and that the elements and steps of the claims of said patent were all publicly known prior to said alleged invention by the patentees named in said patents and resulted in no new or unexpected results.

7.

Plaintiff further alleges that, even if said patent 2,653,116 were valid and infringed by plaintiff or plaintiff's customers, which is not admitted but is denied, defendants are estopped to assert the same in a court of equity for each of the following reasons:

(a) That defendant Cee-Bee Chemical Co., Inc. wrongfully induced the Commissioner of Patents of the United States to issue said letters patent by misrepresentations and distortions of fact and by submitting to said Commissioner of Patents affidavits and arguments stating only part truths.

(b) That defendants have been and are now using said United States Letters Patent 2,653,116 as a means of maintaining an unlawful monopoly upon the sale and use of apparatus and chemicals not covered thereby.

(c) That defendants have used and are now using said letters patent 2,653,116 to intimidate the United States Air Force into paying unjust, unwarranted and exorbitant fees for using tank cleaning methods which are and have long been in the public domain.

Second Claim for Unfair Competition

For a second and separate claim against defendants, plaintiff alleges:

8.

This claim is for unfair competition and this court has jurisdiction thereof under 28 U.S.C. 1338 (b), and 15 U.S.C. 1126 (h) and (i). [8]

9.

Plaintiff repleads and incorporates herein by reference Paragraphs 2 to 7 inclusive of its first claim.

10.

Plaintiff and defendants are engaged in the business of manufacturing, selling, and leasing equipment for the cleaning of tanks and the sale of chemicals, that said business is a business in interstate commerce, and that plaintiff corporation and defendant corporation are engaged in interstate commerce.

11.

Defendant Cee-Bee Chemical Co., Inc. has been and is now committing, and threatens to continue to commit, without justification and for the purpose of interfering and damaging plaintiff's said business and good will and causing loss of profits to plaintiff, the following acts:

(a) Using, and threatens to continue to use said United States Patent 2,653,116 as a tool of unfair competition to cause plaintiff's customers and prospective customers to refuse to purchase and use plaintiff's tank cleaning apparatus and chemicals.

(b) Broadcasting, and threatens to continue to broadcast to plaintiff's customers and prospective customers and to the trade at large, unwarranted threats and notices in bad faith to the effect that such customers, prospective customers and trade will be sued by defendant if they use plaintiff's apparatus or chemicals.

12.

On December 4, 1953, defendant Turco Products, Inc. commenced an action in the United States District Court for the Southern District Court of California Central Division against defendant Cee-Bee Chemical Co., Inc. for Declaratory Judgment and Unfair Competition said action being assigned No. 16,103-C. [9]

Thereafter, during the course of said action No. 16,103-C defendant Turco Products, Inc. pleaded and alleged that the said patent 2,653,116 was invalid and brought a motion for summary judgment upon which a hearing was held, and the motion taken under submission by the Court.

14.

During the course of said action No. 16,103-C, if not before, both defendants became fully apprised of the obvious invalidity of said patent 2,653,116 in view of the prior art cited, the prior public uses, and the skill of the ordinary mechanic.

15.

Before judgment was given in said action No.

16,103-C defendants entered into a collusive and fraudulent agreement to dismiss said action, and conspired together to assert said patent in bad faith and as a fraud upon the public, and with the intent to injure plaintiff and others lawfully engaged in the business of tank cleaning and the sale of chemicals.

16.

That since entering into said collusive and fraudulent agreement as set forth in Paragraph 15 defendant Cee-Bee Chemical Co., Inc. on behalf of itself, and as agent for defendant Turco Products, Inc. has unlawfully and in bad faith continued and renewed the course of conduct as set forth in Paragraph 11 and threatens to continue said course of action for the purpose of interfering with and damaging plaintiff's business and good will and causing loss of profit to plaintiff.

17.

That by virtue of said acts of defendant, plaintiff has suffered loss of profits in the sum of fifty thousand dollars (\$50,000); and that defendant's said acts have been and are being committed willfully, wantonly and maliciously and that plaintiff [10] is entitled to exemplary damages in the sum of twenty-five thousand dollars (\$25,000).

Third Claim for Damages and Injunctive Relief
Under Sherman and Clayton Anti-Trust Laws

For a third and separate claim against defendants, plaintiff alleges:

18.

This claim is for damages and injunctive relief under the anti-trust laws of the United States and this Court has jurisdiction thereof under Sections 15 and 26 of Title 15 U.S.C.A. being a part of the Act of Congress of July 2, 1890 c. 649, 26 Stat. 209 as amended entitled "An Act to Prevent Trade and Commerce Against Unlawful Restraints and Monopolies" commonly known as the Sherman Act and the Clayton Act.

19.

Plaintiff repleads and incorporates herein by reference Paragraphs 2 to 7 inclusive of its first cause of action.

20.

Plaintiff and defendants are engaged in the business of manufacturing, selling, and leasing equipment for the cleaning of tanks, and the sale of chemicals, that said business is a business in interstate commerce, and that plaintiff corporation and defendant corporation are engaged in interstate commerce.

21.

Defendants have been and are now engaged in a combination and conspiracy to restrain and monopolize the trade and commerce among the several states of the United States in the desealing of aircraft tanks and the sale of chemicals therefor and have attempted to restrain and monopolize the said trade in violation of Sections 1 and 2 of the Sherman Act and Section 3 of the Clayton Act. [11]

22.

In furtherance of said combination and conspiracy, defendants entered into an unlawful agreement to assert said patent No. 2,653,116 against plaintiff and the public at large when all of the defendants are fully aware and apprised of the unenforceability and invalidity of said patent for the reasons set forth in paragraph 6 of the first claim herein and paragraphs 12 through 14, inclusive, of the second claim herein.

23.

Defendants have and are using threats of enforcement of said patent No. 2,653,116 to control the sale of unpatented chemicals to contractors of the United States Air Force and to others.

24.

Defendants have threatened and coerced prospective customers of plaintiff with patent infringement suits without any intention to bring such suits, and for the purpose of monopolizing the aircraft tank desealing business and injuring the business and good will of plaintiff.

25.

Upon information and belief, it is alleged that defendants have agreed to fix prices for the sale and leasing of desealing equipment, and the sale of unpatented chemicals and have agreed to divide the trade between them.

26.

As a direct and intended result of the activities of defendants in restraint of trade and attempting to monopolize the business of aircraft tank desealing, plaintiff has been caused to lose contracts for the sale and leasing of desealing equipment and the sale of chemicals, and has lost valuable business, good will and property in the sum of one hundred thousand dollars (\$100,000.). [12]

Wherefore, plaintiff prays judgment as follows:

1. That patent 2,653,116 and each of the claims in suit be declared invalid and void.

2. That the use of plaintiff's apparatus be declared not to infringe upon said patent 2,653,116.

3. That a preliminary and permanent injunction be issued out of and under the seal of this Court restraining defendants, their agents, employees, officers and directors, and those acting in concert with defendants, from asserting to the trade or to plaintiff's customers that any use of apparatus sold or vended by plaintiff infringes upon said patent 2,653,116 or any claim thereof, or from threatening any of plaintiff's customers with suit for infringement of said patent 2,653,116 if said customers use plaintiff's said apparatus.

4. That plaintiff receive as damages for the injury to its business the sum of One Hundred Thousand Dollars (\$100,000), and that said sum be trebled to Three Hundred Thousand Dollars (\$300,-

000), and that the court award a reasonable attorney's fee in accordance with Section 4 of the Clayton Act (15 U.S.C.A. 15) in such cases made and provided.

5. That defendants, and each of them, be permanently enjoined and restrained from each and all of the unlawful practices alleged in plaintiff's complaint.

6. That the aforesaid combination and conspiracy, contracts, agreements, arrangements, and understandings in restraint of interstate trade and commerce, conspiracy to monopolize, attempts to monopolize and monopolization of interstate trade and commerce be adjudged and decreed to be unlawful, and that the contracts, agreements, arrangements and understandings and practices alleged in this complaint be adjudged and decreed to be in violation of Sections 1 and 2 of the Sherman Act and Section 3 of the Clayton Act. [13]

7. That the Court adjudge and decree that the defendants have combined and conspired to restrain unreasonably and have conspired to monopolize, attempted to monopolize and have monopolized the interstate trade and commerce and the business of aircraft tank desealing in violations of Sections 1 and 2 of the Sherman Act and Section 3 of the Clayton Act.

8. That the defendants and all of their subsidiaries or affiliated companies, their officers, directors, agents and employees and their respective suc-

cessors, assignees or transferees be enjoined from agreeing, combining, conspiring or contracting with each other or with any other person or corporation whatsoever to restrain, control or eliminate competition among themselves or with others, from restraining in any way the business of aircraft tank desealing, or from conspiring or attempting to monopolize or monopolizing the trade and commerce herein alleged.

9. That the Court issue a preliminary injunction prohibiting the defendants and each of them and their officers, directors, agents and employees from in any way restricting the plaintiff's business of aircraft tank desealing by agreement or concert of action or any other illegal means.

10. That the plaintiff recover its cost herein.

11. That the plaintiff have such other and further relief as the Court may deem proper.

FULWIDER, MATTINGLY &
HUNTLEY,

ROBERT W. FULWIDER,
WALTER P. HUNTLEY,
JOHN M. LEE,
JOHN A. WEYL,

/s/ By JOHN M. LEE,

Attorneys for Plaintiff. [14]

Duly Verified. [15]

[Endorsed]: Filed October 26, 1954.

[Title of District Court and Cause.]

AFFIDAVIT OF JOHN M. LEE

State of California,
County of Los Angeles—ss.

John M. Lee, being first duly sworn, deposes and says:

I am of counsel for Delco Chemicals, Inc., the plaintiff herein, and I have examined the record of Civil Action No. 16,103-C filed in the United States District Court, Southern District of California, Central Division, said action being for declaratory judgment of invalidity and non-infringement of patent No. 2,653,116 and unfair competition brought by Turco Products, Inc., against Cee-Bee Chemical Co., Inc. [16]

Annexed hereto and marked Exhibit 6, is a true copy of United States Patent No. 2,653,116 involved in the present action and the aforesaid action No. 16,103-C.

Annexed hereto and marked Exhibit 7, is a true copy of the affidavit of S. G. Thornbury, President of Turco Products, Inc., submitted with the Motion for Summary Judgment brought by the plaintiff Turco Products, Inc., in the aforesaid action No. 16,103-C.

Annexed hereto and marked Exhibit 8, is a true copy of the following prior patents which were submitted with the Motion for Summary Judgment in the aforesaid action No. 16,103-C:

| | |
|-------------------|-----------|
| Butterworth | 2,108,757 |
| Land | 1,666,015 |
| Robinson | 1,701,824 |
| Jenson | 1,730,658 |

Annexed hereto and marked Exhibit 9 is a true copy of excerpts from the Motion for Summary Judgment filed by plaintiff, Turco Products, Inc., in the aforesaid action No. 16,103-C.

Annexed hereto and marked Exhibit 10 is a true copy of excerpts from the brief in support of the Motion for Summary Judgment submitted by plaintiff Turco Products, Inc., in the aforesaid action No. 16,103-C.

Annexed hereto and marked Exhibit 11 is a true copy of excerpts from the Reporter's Transcript of Proceedings at the hearing on the Motion for Summary Judgment held before the Honorable James M. Carter on July 13, 1954. [17]

Annexed hereto and marked Exhibit 12 is a true copy of the Stipulation and Order For Dismissal filed in the aforesaid action No. 16,103-C on July 16, 1954, and entered by the Clerk on July 19, 1954.

/s/ JOHN M. LEE.

Subscribed and sworn to before me this 25th day of October, 1954.

[Seal] /s/ BETTY JONES,

Notary Public in and for said County and State.

My Commission Expires September 26, 1957.

[Exhibit No. 6—K. R. Whitcomb, et al., Patent No. 2,653,116. See Exhibit A at page 225 of the Book of Exhibits.]

EXHIBIT No. 7

In The United States District Court, Southern
District of California, Central Division

No. 16,103-C

TURCO PRODUCTS, INC., a corporation,
Plaintiff-Counterdefendant,

v.

CEE-BEE CHEMICAL CO., INC., a corporation,
Defendant-Counterclaimant.

AFFIDAVIT OF S. G. THORNBURY

State of California,
County of Los Angeles—ss.

S. G. Thornbury being first duly sworn deposes
and says:

I am President of Turco Products, Inc., (hereinafter referred to as Turco) and have been such for the past sixteen (16) years. Said Turco is a California corporation and it maintains its principal place of business in Los Angeles, County of Los Angeles, State of California.

The business of Turco is and has been the manufacture and sale of chemicals principally for commercial and industrial [20] cleaning operations which include, among various other types of cleaning operations, the cleaning of tanks, drums and radiators to remove various sorts of coatings and deposits therefrom.

Exhibit No. 7—(Continued)

While Turco does not itself carry out the said cleaning operations, it does make and sell chemicals therefor and does recommend to its customers various cleaning methods and does sometimes make available to its customers apparatus for conducting such cleaning operations.

Among the cleaning methods and apparatus recommended and made available by Turco have been the method and apparatus disclosed in United States Letters Patent to Land No. 1,666,015 issued in 1928, under which Turco acquired license rights in or about 1930.

In the cleaning of tanks since prior to 1930 it has been conventional practice to continuously spray a recirculated solvent against the tank walls and, wherever the coatings or deposits being removed contain any particles or scale which might clog the pumping and spray lines, it has been conventional practice to screen the solvent before recirculating it. It has also been conventional practice in connection with such cleaning operations to flush the tank with rinse water for the purpose of rinsing the solvent-cleaned surface and washing out of the tank any coating particles which may have failed to drain out by gravity, said rinsing operations having been usually carried on at a relatively high pressure to insure that any particles would be physically washed from the tank. Also, where a highly volatile solvent has been used it has been conventional practice to close the openings of the tank to prevent escape of solvent vapors. It

Exhibit No. 7—(Continued)

has also been conventional practice to apply a soapy or detergent solution to the tank before applying the rinse water wherever the desirability of a soap or detergent occurs, although many solvents are and have been of such character that it is unnecessary to apply a soap or detergent bath.

The only material difference between one cleaning operation and another is and has been that while one solvent is suitable for removing one type of coating, a different solvent may be required to remove another type of coating; and accordingly Turco has developed and made available to the trade over the years, in excess of seven hundred (700) different solvent compositions.

The need for cleaning sealant from the integral fuel tanks placed in airplane wings did not arise until sometime in 1944 and at that time Turco developed solvents suitable for removing such sealant materials and made them available to aircraft companies and also recommended for use in cleaning the sealant from said tanks not only the said method of said Land patent No. 1,666,015 but also such methods as filling the tank with the solvent and allowing it to stand until the coating was dissolved and the method which contemplated workmen entering the tank with hand sprays and spraying the solvent on localized parts of the tank walls, all of which methods have been and still are being used. As the need for portable equipment for carrying on such cleaning operations became desir-

Exhibit No. 7—(Continued)

able, Turco made such equipment available to its customers.

/s/ S. G. THORNBURY.

Subscribed and Sworn to Before Me this 25th day of May, 1954.

/s/ OPAL M. BURROWS,

Notary Public in and for said County and State.

[Exhibit No. 8—A. B. Butterworth Patent No. 2,018,757, see page 285 of Book of Exhibits. G. M. Land Patent No. 1,666,015, see page 292. J. M. Robinson Patent No. 1,701,724, see page 298. S. K. Jensen Patent No. 1,730,658, see page 288.]

EXHIBIT No. 9

Excerpt From The Motion For Summary Judgment—Civil Action No. 16,103-C.

Page 1, line 25, through page 2, line 9:

“The grounds for this motion are:

“1. The method claimed by the patent in suit is fully and clearly anticipated by prior patent art which was not cited or considered by the Commissioner of Patents while the application for the patent was pending and being prosecuted before the United States Patent Office;

“2. The method claimed by the patent in suit is devoid of patentable novelty;

“3. There does not exist any genuine issue as to material facts necessary to consideration and determination of this motion, since invalidity of the patent in suit is clearly apparent from a comparison of said patent in suit with said prior patents

Exhibit No. 9—(Continued)

which were not considered by the Patent Office but which are before the Court in this motion.” [22]

EXHIBIT No. 10

Excerpts From The Brief In Support of Motion
For Summary Judgment—Civil Action No.
16,103-C.

Page 1, lines 20-31:

“To determine this motion, it is not necessary to hear any testimony. The patent in suit, its file wrapper, and the prior art cited by the Patent Office are before the Court. The arguments used by the patentees of the patents in suit to persuade the Patent Office to grant the patent are before the Court as parts of the file wrapper Exhibit ‘B’. Also, the prior art which was not considered by the Patent Office, but which clearly anticipates the patent in suit, is before the Court as Exhibit ‘C’. It is only necessary, therefore, for the Court to compare this prior art with the patent in suit to determine that there is no genuine issue of fact and that the patent is clearly invalid.”

Page 2, lines 18-31:

“The Patent In Suit

“The Whitcomb et al. patent in suit relates to a method of cleaning tanks, its stated object being to clean or remove from aircraft fuel tanks the coatings of sealing materials which are applied to the tank joints to prevent leakage. [23]

“The method described by the patent consists of spraying a solvent solution against the tank walls

Exhibit No. 10—(Continued)

(no particular solvent being specified), draining the sprayed solvent out of the tank by gravity along with any coating particles which it removes, screening the drained solvent to separate from it any coating particles, and then recirculating the screened solvent to the sprays.”

Page 3, lines 1-6:

“The patent also mentions that, after the solvent cleaning is completed, it may be desirable to spray the tank with a soapy solution (the patent referring to this as a ‘water rinsable, emulsifying spray’), and then to rinse the tank with water. The patent also mentions that it may be desirable to heat the solvent solution before spraying it.”

Page 4, lines 19-29:

“The Tank Cleaning Art

“As will be shown by the prior art which will be discussed hereinafter, tank cleaning by continuously spraying solvents onto the tank walls is a very old art. For instance, it has been extensively used in the cleaning of railroad tank cars, ship tanks, large drums, and automobile radiators. Such new developments as there have been during the past two decades or more have been in the apparatus used in the cleaning jobs. Different jobs require different solvents, but the general procedure is the same insofar as method is concerned.”

Page 6, lines 13-32:

“The Prior Art Which Was Not Cited By The Patent Office Completely Anticipates The Patent In Suit.

Exhibit No. 10—(Continued)

“If the Patent Office Examiner had made a thorough search of the prior art, as he should have done, he would have found and cited prior patents which completely anticipate the method claimed by the patent in suit, even to the draining of the sprayed solvent from the tank by gravity and screening it before recirculating it. In fact, the method is found to be described so often in the prior art that it is probably unnecessary to mention specifically but a few of the prior art patents identified in the complaint and answer to the counter-claim herein. Those patents, included in Exhibit ‘D’ filed herewith are as follows:

| | |
|--------------------|------------|
| “Butterworth | 2,018,757 |
| “Butterworth | 2,045,752 |
| “Land | 1,666,015 |
| “Jensen | 1,730,658 |
| “Olsson | 2,065,462 |
| “Robinson | 1,701,824” |

Page 9, lines 17 - 32; and Page 10, lines 1 - 4:

“Therefore, it is obvious from a comparison of the above-discussed prior art, which was not considered by the Patent Office, that it anticipates everything that the patentees of the patent in suit urged as being novel in order to obtain allowance of the claims of the patent in suit.

“To Use an Old Method for an Analogous
Purpose Is Not Invention

“Since the precise method claimed in the patent in suit is shown to be old in the art of tank clean-

Exhibit No. 10—(Continued)

ing, Defendant-Counterclaimant cannot predicate patentability upon using this old method for the analogous purpose of cleaning airplane fuel tanks, which is part of the tank cleaning art.

“In the first place, Defendant-Counterclaimant is estopped to assert that the patent in suit is not within the art of tank cleaning, because the file wrapper, Exhibit ‘B’, shows that the Patent Office considered and treated the subject matter of the patent in suit to be within that art and the patentees acquiesced in that position.”

Page 16, lines 27-32; and Page 17, lines 1-4:

“The Patent in Suit Is Void for
Lack of Invention

“Even if we did not have in the prior art, as we do have, a full anticipation of the alleged invention of the patent in suit, still the patent lacks patentable invention, because all of the steps of the claimed method are old, and, in the aggregate of those steps set forth in the patent claims, each of those steps continues to perform its well-known old function in the same manner and nothing more. Nothing unexpected results from the aggregation of the steps.”

Page 20, lines 16 - 32, and Page 21, line 1:

“Analyzing the patent in suit in the light of this doctrine, we find that the patentees of said patent have done nothing more than use an old tank cleaning method for cleaning airplane fuel tanks and, as said in *Dow Chemical Co., v. Halliburton*, supra, ‘he who is merely the first to utilize the existing

Exhibit No. 10—(Continued)

fund of public knowledge for new and obvious purposes' is not entitled to a patent monopoly upon such a use.

"If the patentees of the patent in suit had discovered some new solvent, or if they had discovered that screening a solvent had some phenomenal or unexpected effect upon it, or if they had discovered that washing an airplane fuel tank with water after a solvent spray operation produced some unexpected phenomenal result, or if they had discovered that heating the solvent to 60° - 120° F. produced some strange result not produced by heating it to any other temperature, it may be that they could be said to have made a patentable discovery, but such is not the case."

Page 21, lines 27 - 31; Page 22, lines 1 - 10:

"Conclusion

"Wherefore, plaintiff-counterdefendant respectfully submits that the facts before the Court show that there is no genuine issue of material fact as to invalidity of the patent in suit, and that summary judgment should be granted declaring the patent in suit to be invalid.

"Respectfully submitted,

"MASON & GRAHAM,
COLLINS MASON,
WILLIAM R. GRAHAM,
/s/ By COLLINS MASON,
Attorneys for Plaintiff-
Counterdefendant."

EXHIBIT No. 11

Excerpts From Reporter's Transcript of Proceedings, Civil Action No. 16,103-C, Hearing on Motion for Summary Judgment, July 13, 1954, United States District Court, Southern District of California, Central Division. Honorable James M. Carter, Presiding.

Page 34, line 7, through page 36, line 17:

"The Court: Well, I will take the matter under submission. I will give a little thought to the question of whether there are any issues of fact to be tried.

"There is a possibility that I might deny this motion. I will probably grant it. But let me tell you about your patent.

"If you survive this motion you are in for trouble on this patent, because — this hasn't been argued, but I am almost convinced that apart from prior art, prior specific patents, just in the field of public domain there is almost sufficient to defeat this patent.

"The idea of hosing down the inside of a tank, every kid has used a hose on the inside of a five-gallon oil can, with pressure, to knock substances off. The idea of collecting the material and screening the sand or the scale or the muck out of it is as old as the first pump. The idea of putting a screen in ahead of the pump, the idea of recirculating fluids, particularly fluids that are costly, such as these solvents, is old. The automobile recirculates a fluid through the water pump into the radiator, and

Exhibit No. 11—(Continued)

it probably has a screen. These ideas out of which you have made this patent are so old that I have serious doubt whether there is any patentability here, even in the combination of them. [24]

“Then when you see the prior art, the thing that startles me is that the Patent Office would issue patents on these matters. The Patent Office has, of course, always granted patents where subsequently they might not be held to be valid. And there is some advantage to the invention in getting a patent with its *prima facie* presumption of validity even though it doesn’t hold up later on. But it is a pretty risky thing to bank on.

“I am not one of these judges that follow the idea of striking down all patents. In fact, you will recall one of the Justices of the Supreme Court said the only patents that are valid are the ones they don’t get their hands on.

“I think I have held as many or more patents that have come before me valid as I have invalid. I think I have probably held more valid than invalid. I believe it is a dangerous thing if we are going to strike down all patents. But this patent really gives me a lot of concern.

“You may get over the hump of this motion, but I think you ought to seriously analyze what you have got here. Probably the commercial success of this company, if there is commercial success, is based upon the solvent that is used, its ability to

Exhibit No. 11—(Continued)

cut this sealant, based upon its particular method of screening, none of which is claimed in the patent. You don't teach anything about screening. Nobody could take your patent and build the right kind of a screen, because all you say is screening.

"Maybe there is nothing to teach. Maybe it is, again, so old that it wouldn't be of any advantage to teach how you screen it. And it may be that the type of solvent that you use, the way you handle the work, and the way you screen the material out and recycle it has brought about this success. But to say that you are entitled to a patent on a system of hosing down walls, screening out the solvent and repumping it, causes me some concern.

"I will take the matter under submission to see if I can find a triable issue. If there is a triable issue, then you are entitled to have a trial on it. If not, I will grant the motion for summary judgment."

EXHIBIT No. 12

[Title of District Court and Cause No. 16103-C.]

STIPULATION AND ORDER FOR
DISMISSAL

It Is Hereby Stipulated by and between the parties to this action, through their respective attorneys, that plaintiff's complaint and defendant's counterclaim may be and the same are hereby dismissed without prejudice and without costs or attorneys fees to either party.

Dated at Los Angeles, California, this 16th day of July, 1954.

MASON & GRAHAM,
COLLINS MASON,
WILLIAM R. GRAHAM,
/s/ By COLLINS MASON,
Attorneys for Plaintiff-
Cross-defendant. [25]
C. G. STRATTON,
LOUIS M. WELSH,
Attorneys for Defendant-
Cross-complainant.

It Is So Ordered this 16th day of July, 1954.

/s/ JAMES M. CARTER,
United States District Judge.

[Endorsed]: Stipulation and Order for Dismissal. Filed July 16, 1954. Judgment Docketed and Entered July 19, 1954.

[Endorsed]: Affidavit of John M. Lee and Attachments. Filed October 26, 1954.

United States District Court, Southern District
of California, Central Division

No. 17,387-C Civil

[Title of Cause.]

MINUTES OF THE COURT

Date: Dec. 13, 1954, at Los Angeles, Calif.

Present: Hon. James M. Carter, District Judge.

Deputy Clerk: L. B. Figg. Reporter: Samuel
Goldstein.

Counsel for Plaintiff: No appearance.

Counsel for Defendants: C. G. Stratton for def't
Cee-Bee.

Proceedings: For hearing motion of def't Cee-
Bee Chemical Co., Inc., filed Dec. 2, 1954, for leave
to amend its answer and counterclaim.

It Is Ordered that said motion is granted, and
that the proposed amended answer and counter-
claim, lodged with the motion, be filed as the orig-
inal pleading, and that plaintiff may have twenty
(20) days from this date to respond to the counter-
claim.

EDMUND L. SMITH,

Clerk,

By L. B. FIGG,

Deputy Clerk. [26]

[Title of District Court and Cause.]

AMENDED ANSWER TO COMPLAINT
AND COUNTERCLAIM

Comes now the defendant, Cee-Bee Chemical Co., Inc., a corporation, and answering for itself alone plaintiff's complaint for declaratory judgment, unfair competition, and relief under the Sherman and Clayton Anti-Trust Laws, admits, denies and alleges as follows:

I.

That the defendant is without knowledge or information sufficient to form a belief as to the truth of the averments of Paragraphs 2 and 5 of the complaint.

II.

(a) Denies that this defendant as agent for defendant Turco Products, Inc., has contended or continues to contend those [27] matters set forth in Sub-paragraph (a) of Paragraph 6, of plaintiff's complaint, and further denies that this defendant has contended or is continuing to contend direct infringement of plaintiff upon said Letters Patent by reason of making or selling said apparatus.

(b) This defendant denies each and every allegation of Sub-paragraph (b) (1) to (7) of Paragraph 6 of said complaint.

III.

Denies each and every allegation of Paragraph 7 of plaintiff's complaint.

IV.

This defendant is without knowledge or information sufficient to form a belief as to whether the plaintiff owns or enjoys a valuable business or good will in the sale of tank cleaning apparatus for use by its customers or in the sale of chemicals for use by said customers. The defendant denies each and every other allegation contained in Paragraphs 8 through 11 and 14 through 17 in the alleged Second Cause of Action for Unfair Competition. Further answering said second cause of action this defendant denies that plaintiff has been damaged in the sum of Fifty Thousand Dollars (\$50,000.00), in the sum of Twenty-Five Thousand Dollars (\$25,000.00), or in any sum whatsoever by reason of any unlawful acts of this answering defendant.

V.

The defendant repleads and incorporates herein by reference its answers to Paragraphs 2, 5, 6, and 7 of plaintiff's First Cause of Action.

VI.

The defendant denies each and every other allegation in the alleged Third Cause of Action under the Sherman and Clayton Anti-Trust Laws. [28]

By Way of Counterclaim Against the Plaintiff, the Defendant Alleges:

VII.

That the defendant is a California corporation, having its principal place of business in the City of Downey, County of Los Angeles, State of California.

VIII.

That the defendant alleges that upon information and belief the plaintiff is a Delaware corporation, having its principal place of business in the County of Los Angeles, State of California.

IX.

That this action arises under the patent laws of the United States, more particularly R.S. § 4919 (35 U.S.C. § 67), as herein more fully appears. Jurisdiction is conferred in this court by 28 U.S.C. § 1338.

X.

That on September 22, 1953, United States Letters Patent No. 2,653,116 were duly and legally issued to defendant for an invention in Method of Removing Sealant from Fuel Tanks, and since that date defendant has been and still is the owner of said Letters Patent.

XI.

That ever since said date, plaintiff has been and still is infringing said Letters Patent by practicing said Method, and has been and still is contributing to the infringement of said Letters Patent by making, selling and using, apparatus adapted for, intended for and actually used for the purpose of practicing said Method, all of said acts being within the Southern District of California, and elsewhere in the United States, to the damage of the defendant in the sum of Twenty-Five Thousand Dollars (\$25,000.00). [29]

XII.

That the defendant has given written notice to plaintiff of its infringement.

Wherefore, defendant prays (a) that the plaintiff's Complaint be dismissed; (b) that judgment be granted against plaintiff in the sum of Twenty-Five Thousand Dollars (\$25,000.00); (c) reasonable attorney fees; and (d) an assessment of costs against plaintiff.

C. G. STRATTON,
LOUIS M. WELSH,

/s/ By C. G. STRATTON,
Attorneys for Defendant, Cee-
Bee Chemical Co., Inc.

Defendant, Cee-Bee Chemical Co., Inc., hereby demands a trial by Jury of all issues triable of right by a jury in this cause of action.

C. G. STRATTON,
LOUIS M. WELSH,

/s/ By C. G. STRATTON,
Attorneys for Defendant, Cee-
Bee Chemical Co., Inc. [30]

Affidavit of Service by Mail Attached. [31]

[Endorsed]: Filed Dec. 13, 1954.

[Title of District Court and Cause.]

ANSWER TO COUNTERCLAIM OF DEFENDANT CEE-BEE CHEMICAL CO., INC.

Comes now the plaintiff Delco Chemicals, Inc. and for answer to counterclaim of defendant Cee-Bee Chemical Co., Inc. admits, denies and alleges as follows:

I.

Admits the allegations contained in Paragraph VII.

II.

Answering Paragraph VIII, admits that plaintiff is a Delaware corporation having its principal place of business in the County of Los Angeles, State of California.

III.

Answering Paragraph IX, admits the allegations contained therein. [32]

IV.

Answering Paragraph X, admits that United States Letters Patent No. 2,653,116 were, on September 22, 1953, issued to the defendant Cee-Bee Chemical Co., Inc. and that it is the owner of said Letters Patent, but denies the balance of the allegations contained in said paragraph.

V.

Answering Paragraph XI, plaintiff denies generally and specifically each and every allegation contained in said paragraph and further denies that the defendant Cee-Bee Chemical Co., Inc. has been

damaged in the sum of \$25,000.00, or in any other sum, or at all.

VI.

Answering Paragraph XII, plaintiff admits the allegations contained therein.

As an Affirmative Defense to the Counterclaim of Defendant Cee-Bee Chemical Co. Inc. Plaintiff Alleges as Follows:

VII.

That United States Patent No. 6,253,116 issued on September 22, 1953 for an alleged invention of Keith R. Whitcomb and Eugene E. Finch, was not duly or legally issued, nor does said patent claim or cover that invention, or any inventions; that said patent, and each of the claims thereof, are invalid and void for all the reasons set out in plaintiff's counterclaim for declaratory judgment as fully alleged in Paragraph VI of plaintiff's complaint on file herein.

Wherefore, plaintiff prays judgment that the defendant Cee-Bee Chemical Co., Inc. take nothing by way of relief on its counterclaim against the plaintiff and that judgment be rendered in accordance with the prayer contained in plaintiff's complaint.

FULWIDER, MATTINGLY &
HUNTLEY & WEYL AND
WEYL,

/s/ By JOHN A. WEYL,

Attorneys for Plaintiff. [33]

Affidavit of Service by Mail Attached. [34]

[Endorsed]: Filed December 30, 1954.

[Title of District Court and Cause.]

STIPULATION AND ORDER FOR DISMISSAL WITHOUT PREJUDICE OF PLAINTIFF'S SECOND AND THIRD CAUSES OF ACTION

It Is Hereby Stipulated by and between the plaintiff, Delco Chemicals, Inc., and the defendants, Cee-Bee Chemical Co., Inc., and Turco Products, Inc., acting through their respective attorneys of record, that plaintiff may dismiss without prejudice its Second and Third Causes of Action in the above entitled action.

It Is Further Stipulated that an order of dismissal without prejudice may be made upon the basis of this stipulation.

Dated this 2nd day of February, 1955.

FULWIDER, MATTINGLY &
HUNTLEY AND WEYL AND
WEYL,

/s/ By JOHN A. WEYL,

Attorneys for Plaintiff.

C. G. STRATTON & LOUIS M.
WELSH,

/s/ By C. G. STRATTON,

Attorneys for Defendant Cee-Bee
Chemical Co., Inc. [35]

MASON & GRAHAM AND
PRESTON & FILES,

/s/ By COLLINS MASON,

Attorneys for Defendant Turco
Products, Inc.

Order

Upon reading the foregoing Stipulation and good cause appearing therefrom, it is hereby

Ordered that plaintiff's Second and Third Causes of Action be dismissed without prejudice.

Dated: February 7, 1955.

/s/ JAMES M. CARTER,

District Judge. [36]

[Endorsed]: Filed Feb. 8, 1955. Judgment Docketed and Entered Feb. 8, 1955.

[Title of District Court and Cause.]

NOTICE OF MOTION AND MOTION FOR
SUMMARY JUDGMENT

To Cee-Bee Chemical Co., Inc., Defendant Herein,
and to Its Attorneys C. G. Stratton and Louis
M. Welsh, Esquires:

You, and Each of You, Will Please Take Notice that on Monday, the 4th day of March, 1957, at the hour of 10:00 o'clock a.m., or as soon thereafter as the matter can be heard, before the above-entitled Court, in the Courthouse and Post Office Building at Spring and Temple Streets, Los Angeles, California, Plaintiff herein will move this Honorable Court for summary judgment, holding United States Letters Patent in suit No. 2,653,116, and all the claims thereof invalid and void.

The grounds for said motion are as follows: [37]

A. The method claimed by the patent in suit is fully and clearly anticipated by prior art which

was not cited or considered by the Commissioner of Patents while the application for the patent was pending and being prosecuted before the United States Patent Office;

B. The method claimed by the patent in suit is devoid of patentable novelty;

C. There does not exist any genuine issue as to material facts necessary to consideration and determination of this motion, since invalidity of the patent in suit is clearly apparent from a comparison of said patent in suit with said prior art which was not considered by the Patent Office but which is before the Court in this motion.

In support of this motion, Plaintiff will rely upon Rule 56 of Federal Rules of Civil Procedure; upon the annexed affidavits of Walter P. Huntley, William V. Koons, and George H. Boeck filed herewith; the affidavit of John M. Lee and attached Exhibits previously filed herein in support of Plaintiff's motion for a preliminary injunction; and upon the following points and authorities:

* * * * * [38]

Dated at Los Angeles, California, this 22nd day of February, 1957.

FULWIDER, MATTINGLY &
HUNTLEY,

ROBERT W. FULWIDER,
WALTER P. HUNTLEY,
JOHN M. LEE,
JOHN A. WEYL,

/s/ By JOHN A. WEYL,

Attorneys for Plaintiff. [41]

[Title of District Court and Cause.]

AFFIDAVIT OF WALTER P. HUNTLEY

State of California,
County of Los Angeles—ss.

I, Walter P. Huntley, being first duly sworn,
depose and say

That I am a member of the firm of Fulwider,
Mattingly & Huntley, attorneys for Plaintiff in the
above-identified action, and, as such, participated in
the preparation of the accompanying Motion for
Summary Judgment, and am familiar with said
Motion;

That Exhibit A annexed hereto, and by this ref-
erence made a part hereof, is a true copy of the
United States Letters Patent in suit No. 2,653,116;

That Exhibit B annexed hereto, and by this ref-
erence made a part hereof, is a certified copy of the
file wrapper and contents of said patent in
suit; [42]

That Exhibit C annexed hereto, and by this ref-
erence made a part hereof, constitutes true copies
of the prior patents cited by the United States Pat-
ent Office against the application for said patent in
suit, said prior patents being as follows:

| | |
|----------------|------------|
| Butterworth | Re. 19,374 |
| Foster | 1,141,243 |
| Gray | 1,628,141 |
| Haupt | 1,892,950 |
| McFadden | 2,092,321 |
| Paulson et al. | 2,123,434 |

| | |
|-------|-----------|
| Jaffa | 2,442,272 |
| Brady | 2,458,333 |

That attorneys for Plaintiff have caused to be made an independent search of the prior art relating to the subject matter of said patent in suit, and that, as a result of said search, found the following prior patents which are hereunto annexed as Exhibit D, and by this reference made a part hereof, which prior patents were not cited by the United States Patent Office against the application for said Letters Patent in suit:

| | |
|-------------|-----------|
| Butterworth | 2,018,757 |
| Butterworth | 2,045,752 |
| Land | 1,666,015 |
| Jensen | 1,730,658 |
| Olsson | 2,065,462 |
| Robinson | 1,701,824 |
| Court | 2,245,554 |

That attorneys for Plaintiff have caused to be made a further investigation and search for prior publications, other than United States patents, and that as a result of said further investigation, found the below listed documents which by this reference are made a part hereof: [43]

(1) Turco Products, Inc., drawing entitled "Turco Material and Methods for Cleaning Tank Cars" copyrighted 1930, and copyright registered under No. I Pub. 2502, a certified copy of said copyrighted drawing being hereunto annexed as Exhibit E,

(2) The four documents annexed to the affidavit

of William V. Koons as Exhibits F, G, H and I, said affidavit of William V. Koons being hereunto annexed as Exhibit J, and

(3) The three documents annexed to the affidavit of George H. Boeck as Exhibits K, L and M, said affidavit of George H. Boeck being annexed hereto as Exhibit N; and

That concurrently with the filing of this action on October 26, 1954, Plaintiff filed a Motion for a Preliminary Injunction, which motion was accompanied by an affidavit of John M. Lee, which affidavit and the exhibits annexed thereto are herein incorporated by this reference thereto.

/s/ WALTER P. HUNTLEY.

Subscribed and sworn to before me, this 20th day of February, 1957.

[Seal] /s/ MARY WESCOTT,

Notary Public in and for said County and State.

My Commission Expires Nov. 2, 1958. [44]

[Note: The following exhibits are set out in the Book of Exhibits:

Exhibit "A"—K. R. Whitcomb et al Patent 2,653,116 at page 225.

Exhibit "C"—Prior Art Patents Cited by U. S. Patent Office at page 230.

Exhibit "D"—Prior Art Patents Not Cited by U. S. Patent Office at page 271.

Exhibit "E"—Drawing Entitled, "Turco Material and Methods for Cleaning Tank Cars" at page 304.

Exhibit "F"—Certificate of Installation at page 305.]

EXHIBIT "G"

Lubrication and Maintenance of the Oakite Interior Tank Cleaning Unit, Model 324.

1. Weekly Lubrication:

Maintain the oil depth to the pet cock level in the speed reducer. Use 600 W oil or equivalent. It is important to check the oil level weekly.

2. Daily Lubrication:

Use waterproof pump grease for each of the six bearings which are indicated by Alemite fittings. Five of these Alemite fittings are at the lower end of the unit and the sixth fitting is situated under the 18" diameter dome plate.

3. Continual Lubrication:

The Gardner Denver L07 Line Oiler which is furnished with the 324 Unit must be kept filled with a motor oil which will be thin and flow freely at the existing atmospheric temperature. The flow from the oil may be adjusted by removing the top plug and using a special key which comes attached to the oiler. When in operation a slight movement of oil must be observed in the sight feed. Failure to follow these instructions will definitely result in a breakdown of the precision machined internal parts of the air motor.

The Air Motor shaft bearings are automatically lubricated by oil which is discharged from the Air Motor and which drains from a special oil receiver into two lines which feed the bearings.

Maintenance

When the unit is not to be used for several days discharge a few gallons of cleaning solution through

Exhibit "G"—(Continued)

it to remove salt or fresh rinse water, thus preventing corrosion.

Replacement Parts

All of the parts of the equipment have been made of the highest grade of materials obtainable. However, because of the nature of the work which is accomplished, lubrication of several bearing surfaces is dependent upon the cleaning solution. There will be some gradual wear, and replacement parts may be obtained by applying to Oakite Products, Inc., 22 Thames Street, New York, N. Y., or to the Oakite Representative located in the territory where the equipment is being used.

GG:LMD

Revised 12/18/45

A-5748 [51]

EXHIBIT "H"

Directions for the Installation and Operation of
the Oakite Interior Tank Cleaning Unit, Model
324.

Refer to Drawing No. D-463, Sheets 1 and 2.

General Description:

Sheets 1 and 2 of the Oakite Drawing D-463 show two typical installations of the Oakite Interior Tank Cleaning Unit, Model 324, the equipment having been especially designed for the interior cleaning of all types of tank cars. This work is done whenever it is necessary to change products or periodically to maintain cars which continuously transport the same product. The interior cleaning

Exhibit "H"—(Continued)

of tank cars is a problem confronted by every owner of this type of equipment and in most instances, the cost of the operation is very high because of the many hours required by laborers to produce satisfactory results by hand methods.

At most plants it is of importance to obtain a definite number of cleaned cars per day. When washed and scrubbed by hand, only a limited number of men can work at one time, resulting in almost daily holding over of cars which should be in service. Such delays are costly, but they can be avoided by the use of the Oakite Interior Tank Cleaning Unit which makes it possible to turn out Very Much Cleaner Cars in a fraction of the former time expended and at an unusually low cost.

In general, the Oakite system is one employing the constant circulation of a hot solution of a heavy duty Oakite cleaning material. This solution is discharged at high pressure from the nozzles of the Model 324 Unit in such a way that thorough cleaning of all interior surfaces is assured; the solution then returning to the heating tank for recirculation. Car cleaning is completed by fresh water rinsing.

The Oakite Interior Tank Cleaning Unit, Model 324, shown hanging over the tank car is operated by a small air motor which causes the nozzles to rotate simultaneously about a vertical and a horizontal axis. During operation the nozzles describe spirals, each turn being very close to the one preceding it and the high pressure stream of solution ejected remove oils and other accumulations, fore-

Exhibit "H"—(Continued)

ing these deposits away from the surfaces already cleaned. Each square inch of the plates receives the direct impact of one of the sprays every 15 minutes of operation.

We have illustrated two types of installations, the chief difference being in the number of solution and rinse tanks. The two tank system may be employed where a single class of oils is to be continuously removed from cars, whereas the four tank system is required where cars having carried various classes of oil are to be cleaned.

This is true particularly where units are installed by Railroads where both edible and mineral oil cars are maintained. Contamination with mineral oil of a cleaning solution used for cleaning edible oil carrying cars is not permitted and if only two tanks are installed, considerable cleaning solution would have to be discarded and new solutions constantly made up.

Oakite Cleaning Materials:

Many years of intensive research and innumerable field tests conducted by highly skilled Oakite chemists and engineers has resulted in the development of cleaning materials so compounded as to insure maximum efficiency at the lowest possible cost. A number of these materials, especially Oakite Composition No. 24 have been used daily over a period of over five years for the purpose of cleaning the interior of tank cars. The initial charge of the cleaner in a one thousand gallon tank will

Exhibit "H"—(Continued)

be from sixty to three hundred pounds, depending upon the type of oil to be removed from cars.

Furthermore, maintaining the proper strength of the solution is accomplished by the addition of only a few pounds of Oakite material per car cleaned and the entire charge, which gradually becomes contaminated, is discarded only after an appreciable number of cars have been cleaned.

It may be stated, without qualification, that the results obtained by the application of Oakite materials are outstanding both as to quality and economy.

Explanation of Drawing D-463, Sheets 1 and 2.

To show all of the details of construction and installation of equipment would involve many drawings and they would, in most instances, be of little value as local conditions vary so that no two assemblies can be identical. Therefore, the drawing indicates the general scheme, whereas the following description will enable an engineer to make his own detailed plan in accordance with the track and adjacent ground layout.

Sheet #1 indicates an installation comprising two tanks in a concrete lined pit. Other features are the working platform and the single bridge which permits the operator to go over to the car body at the dome where he stands while lowering and fastening the 324 Unit into the car. The drawing indicates a single drain line leading from

Exhibit "H"—(Continued)

a point directly under the car's correct washing position.

Sheet #2 indicates in installation comprising four solution and rinse tanks and it will be noted that there are two drain lines leading to these tanks. The latter make it possible to utilize two tank car cleaning locations, one on each side of the raised working platform. In this installation there are two bridges for access to car tops and the position of the boom is such that the 324 Unit may be located over either tank car.

Detailed Data On Auxiliary Equipment
Tank Pit:

We recommend the construction of a concrete lined pit for holding the Oakite cleaning solution and rinse tanks, the solution pump and the various necessary pipe lines. The pit should be of such size as to permit easy access by an operator to all sides of the tanks, and the depth of the pit must be such that the top of the tanks selected for the installation will be at least twenty-four inches below the track which is adjacent to the pit. The pit bottom should be pitched toward a small sump, in which a steam syphon is located. This syphon is used to empty the sump of accumulated water, etc. Convenient stairs or a ladder should extend from ground level down to the floor of the pit and all four sides of the pit should be fitted with a railing to prevent an accidental fall. At many locations, it is found advisable to erect a shed over the pit to exclude cinders, rain, snow, etc.

Exhibit "H"—(Continued)

Tanks:

1000 to 1500 gallon Oakite cleaning solution and rinse tanks are used. They may be either rectangular or cylindrical, and should be fitted with hinged covers. They should be constructed of hot rolled plate, all seams being welded. In cases where excessive steam is not available for rapid heating, a 1500 to 2000 gallon rinse tank is used. Then sufficient hot water may be prepared in advance when a car is to be hot rinsed.

In order to minimize the circulation of insoluble materials flushed from cars, each tank which will hold cleaning solution, is partitioned across the middle with a solid sheet steel overflow baffle. This baffle extends from the bottom to within 18 inches of the top of the tank. It is necessary to periodically discard used solution and manually remove accumulated sludge from the solution tank or tanks as the case may be. To accomplish this, there must be a 4" connecting line and valve leading from one side of the tank baffle to the other. This line should be installed about one foot up from the bottom of the compartment into which the solution and sludge first fall after draining from the tank cars. The line then leads into the other compartment at as low a point as possible. Under these conditions, one foot of liquid and insoluble sludge will remain in the first compartment, and the second compartment or half of the tank will be practically emptied when spent solution is pumped out to the sewer. Remaining liquid and sludge

Exhibit "H"—(Continued)

is then manually removed before recharging the tank with a new Oakite solution. The valve in the above by-pass line will, of course, be opened only when discarding used solution or rinse water.

Some installations will include a fresh hot water rinse tank. The water is not reclaimed for circulation and therefore this tank does not need a center overflow baffle as described above.

Each tank should be fitted with a suitable gauge glass, or if it is found desirable, a single gauge glass may be placed against one of the pit walls. Then lines will lead from the bottom of the gauge glass to each of the tanks and each line will be fitted with a valve. The valves may all be in one location so that the operator can easily note the level in any of the tanks.

Since the time required to clean cars depends a great deal upon the maintenance of proper cleaning solution and rinse water temperatures, it is recommended that each tank be fitted with a reliable boiler type thermometer. Also, and so that the operator can readily check temperatures while the unit is in operation, it is desirable to install a similar thermometer, at a most convenient location, in the discharge line leading up to the working platform.

Pump Equipment:

The capacity of the Oakite Interior Tank Cleaning Unit is approximately 100 gallons per minute at 100 lbs. pressure and we, therefore, recommend the use of a 9" x 5 $\frac{1}{4}$ " x 10" steam driven Duplex

Exhibit "H"—(Continued)

pump or an electrically operated centrifugal pump which has the capacity of 125 gallons per minute against a pressure of 125 lbs. per square inch. The pump obtained for the job should be situated as indicated on the drawing.

As an example of satisfactory pumps we suggest a type V C 9" x 5 $\frac{1}{4}$ " x 10" Worthington Duplex steam pump, which will operate at the desired capacity with a 60 lb. per square inch steam supply, or a #1 $\frac{1}{2}$ D D E 4 two stage close coupled Worthington Centrifugal pump operated by a 20 HP 3600 R.P.M. Motor.

Whether one of the above or a pump of equal capacity manufactured by some other reputable concern is purchased, the order should specify all iron construction, pump to be used for alkaline cleaning solution service and temperature 180° F.

Working Platform:

A working platform should be erected as shown and it is situated directly adjacent to the boom, the latter being exactly in line with the drain connections. The height of the platform should be the same as that of the top of the body of an average car and a suitable staircase should be erected so as to make it easy for operators to go up and down.

A bridge 24 or 30 inches wide is hinged to the edge of the platform and it should be counter-balanced so that it may be easily lowered toward or raised away from a car. The bridge, platform,

Exhibit "H"—(Continued)

and stairs should all be furnished with suitable railings so as to prevent accidental falls. The construction of the above equipment may vary considerably and will measurably depend upon local requirements. In most instances, the platform will be built of structural steel and it will be fitted with steel floor grating or wooden planks. Two bridges are erected if cleaning is accomplished on two tracks.

Boom and Hoist:

A boom and hoist are erected adjacent to the working platform. The outer end of the boom should be directly over the center of the track and approximately 10 feet higher than the top of the average tank car dome. This height permits ample space for the Model No. 324 Unit. As far as actual raising and lowering of the unit is concerned, we recommend the use of a $\frac{1}{2}$ ton electric hoist which is suspended from the end of the boom. Such a unit is very easily manipulated by means of two conventional pull lines. An alternate to this hoisting method is the use of a counter-balance which can be held within a length of 6 inch pipe. This 6 inch pipe, imbedded in concrete, can be the upright element about which the boom swings or pivots.

Cleaning Solution and Rinse Lines:

Each solution or rinse tank must be fitted internally at the bottom discharge opening with a large area fine mesh strainer. A cylindrical strainer

Exhibit "H"—(Continued)

may easily be made up which has an area of not less than 3 sq. ft. of 10 mesh wire. 5 inch suction lines lead from each tank to the intake opening of the pump and each must be fitted with a gate valve. The discharge of the pump is fitted with 3 inch pipe leading to a suitable point on the working platform where it is in turn fitted with a convenient length of 2 inch hose, the latter being attached at its outer end to the intake elbow of the Model 324 Unit.

In the above we stressed the importance of installing thermometers. Of equal importance is the installation of a high grade pressure gauge. This unit may be attached to the discharge line at the same location as the line thermometer. Then the operator will at all times readily know the true operating conditions.

A tee is located in the 3 inch discharge line near the pump and a 3 inch branch line is extended to the main return header. This line and the main solution line are fitted with gate valves. The branch line is utilized only when discarding dirty rinse water or cleaning solution which is of no further value or when transferring solution from one tank to another.

Oakite Products furnishes an easily cleaned large size strainer which must be fitted into the 3 inch solution line at any convenient point between the branch line leading to the sewer and the working platform. We suggest that this strainer be installed 3 or 4 feet above the ground at the

Exhibit "H"—(Continued)

point where the 3 inch line comes out of the ground and goes up to the platform. This is indicated on the drawings.

The solution hose mentioned above should be carefully fitted with "Boss" or similar couplings so as to prevent any possibility of couplings coming off due to the high pressure at which the solution is maintained in the discharge line. Recovery of the solution which accumulates in the bottom of the car during the operation of the equipment is as follows.

Using the recommended equipment it is necessary to place the car within 12 inches of a marked center line in order to make it easy to couple a length of 5 inch flexible metallic hose to the bottom drain of the car. The drawing shows a 14 foot length of this 5" hose. It is fitted at the pit end with a 5" elbow which points down and is connected loosely by means of a 5" nipple to the top opening of a 6" cross which has been bushed down to 5". The other end of the hose is fitted with a 5" elbow which points up and which is in turn fitted with a 5" x 4" bushing, a close nipple, and a 4" union which has the proper threaded opening for attachment to the drain opening of a car. The union should have two 8 inch long handles welded to it so that it will not be necessary for the operator to use a large wrench in making up the fitting.

Note that we have recommended a 14 ft. length of the 5" metallic hose. The actual straight line distance between the center of the cross and the

Exhibit "H"—(Continued)

center of the track below the drain opening of the car is 12 feet. Thus the hose will be curved, but at the same time it may be flexed one way or another in order to enable the operator to attach the union to the car. The 6" cross mentioned above is located in the main 6 inch drain line which leads in one direction to the sewer, and to each tank where a 6 inch line continues down to within 2 feet of the bottom of the tank.

During the operation of the equipment, it is often necessary to note the cleanliness of rinse water which is returning from the bottom of the tank car. However, since solid lines lead directly from the bottom of the car down into the tank we recommend that a 1 inch pipe nipple be welded into the 5 inch nipple adjacent to the flexible metallic hose. This nipple is in turn fitted with a 1 inch valve which may be opened from time to time to observe the condition of the returning water.

Water Lines:

Fresh water rinsing of cleaned cars is accomplished at a pressure of no less than 100 lbs. per square inch and at the rate of about 100 gallons per minute. Therefore a 3" water supply line is preferred. The line may lead directly into a tee situated in the 3 inch solution line which leads from the pump to the working platform. On the other hand, if the water pressure is relatively low, the water line should be led into the suction line of the pump and the latter will then function as a booster. In either case suitable valves must be in-

Exhibit "H"—(Continued)

stalled so as to permit the circulation of rinse water or cleaning solution, as the case may be. Branch water lines lead to each of the tanks for the purpose of filling them, and another water line leads up to the platform where it is fitted with a 40 ft. length of $\frac{3}{4}$ inch hose and nozzle which is utilized for hand rinsing of cars which have been cleaned and from which it was necessary to manually remove inert deposits.

Steam lines:

It is of utmost importance that the Oakite cleaning solution be maintained at a temperature of no less than 180° while it is being circulated. In order to maintain this temperature, a suitable coil is fitted into each Oakite solution tank. The size of the coil, of course, depends upon the quality and temperature of the steam available and upon the reduction in temperature of the solution due to its being circulated. As a basis for calculating the size of the coil to be used, we suggest that under normal conditions the temperature drop of the solution from the time it leaves the solution tank to the time it again returns to this tank is 20° F. Therefore, approximately 100 gallons or 833 lbs. of solution will be heated 20° F. per minute.

The steam coil should be compact; its top pipes being no higher than half the height of the tank and its bottom pipes no lower than 6" from the tank bottom. The steam coil should be contained in the tank compartment from which the solution is drawn by the pump.

Exhibit "H"—(Continued)

Low pressure steam and condensate discharged from solution heating coils can be led directly into the water contained in the rinse tank. The open end of a second steam line should run down into the rinse water tank. Steam from this line is discharged into the tank to maintain the rinse water temperature at 180°. Additional steam for heating rinse water may be obtained by utilizing the exhaust steam from the pump.

The above mentioned steam lines are not shown on the drawing.

At some points steam may not be available for heating solutions, rinse water or even for operating a duplex pump. Highly efficient oil, or natural or manufactured gas burning equipment may then be obtained. Immersion type burners and automatic thermal control instruments would be installed. Further information on the above may be obtained upon application to the Service Department of Oakite Products, Inc.

Under the above conditions, an electrically operated centrifugal pump such as that recommended under the heading "pumps" would be utilized. Also the pit sump may be fitted with a small electrically operated sump pump.

Air Lines:

In order to insure rapid draining of solution from cars, we recommend the use of high pressure air which should be conducted by means of a 1 inch

Exhibit "H"—(Continued)

pipe terminating at a 1" Globe valve. This Globe valve is located at one side of the overhead platform and is connected by means of hose which extends to the $\frac{3}{4}$ " pipe outlet which is situated on the top of the 324 Unit. Utilizing compressed air eliminates also the development of a vacuum when a heated car is rinsed with cold water. At the platform location, a branch line is extended from the above 1" air line. This branch is fitted with a pressure regulating valve which is adjusted for correct motor speed, a Globe valve, the LO7 Gardner-Denver Oiler and the special brass oil sight feed. The latter is fitted with a convenient length of $\frac{1}{2}$ " hose which leads to the air motor. The oiler and the sight feed are furnished by Oakite Products and their continued use and careful maintenance is imperative. If a small amount of oil is not constantly carried along with the air, the very finely machined surfaces within the air motor will immediately score and the motor will cease to function.

A 15 H.P. compressor such as the Ingersoll Rand Unit #15 B Type 40 complete with Belt, Base and Receiver, will furnish sufficient high pressure air to operate the motor of the Model 324 Unit and to maintain the pressure with a car being cleaned at 5 lbs.

Drain Lines to Sewer:

Each solution and rinse tank should be fitted with a 6 inch overflow line leading from a point approximately 6 inches below the top to the sewer.

The main solution return line was described in

Exhibit "H"—(Continued)

the above, and we mentioned the use of a 6 inch cross. A 6 inch drain line fitted with a gate valve leads from this cross to the sewer. Another line which leads to the sewer, and which has also been mentioned in the above, is that which carries rinse water or cleaning solution to be discarded from the discharge line which extends from the pump.

Another line which may lead to the sewer is that which extends out of the pit and which starts down at the pit sump, steam syphon or sump pump.

Warning—Safety Device:

To Avoid Any Possibility of the Development of Static Electricity We Recommend the Use of a Flexible Ground Cable Which Can Be Obtained Locally. One End of the Cable Should Be Permanently Fastened to a Clean Metal Surface of the 324 Unit. It Is of Greatest Importance That the Other End of the Above Cable Be Perfectly Grounded, Before Solution or Water Is Pumped. The Above Cable and Fittings Are to Be Furnished by the Customers.

Directions For Cleaning Cars

General:

While the procedure of cleaning tank cars varies somewhat depending upon the type of oil to be removed, there are several operations which are carried out on all cars. These are presented before taking up the details of the removal of several operations which are carried out on all cars. These

Exhibit "H"—(Continued)

pipe terminating at a 1" Globe valve. This Globe valve is located at one side of the overhead platform and is connected by means of hose which extends to the $\frac{3}{4}$ " pipe outlet which is situated on the top of the 324 Unit. Utilizing compressed air eliminates also the development of a vacuum when a heated car is rinsed with cold water. At the platform location, a branch line is extended from the above 1" air line. This branch is fitted with a pressure regulating valve which is adjusted for correct motor speed, a Globe valve, the LO7 Gardner-Denver Oiler and the special brass oil sight feed. The latter is fitted with a convenient length of $\frac{1}{2}$ " hose which leads to the air motor. The oiler and the sight feed are furnished by Oakite Products and their continued use and careful maintenance is imperative. If a small amount of oil is not constantly carried along with the air, the very finely machined surfaces within the air motor will immediately score and the motor will cease to function.

A 15 H.P. compressor such as the Ingersoll Rand Unit #15 B Type 40 complete with Belt, Base and Receiver, will furnish sufficient high pressure air to operate the motor of the Model 324 Unit and to maintain the pressure with a car being cleaned at 5 lbs.

Drain Lines to Sewer:

Each solution and rinse tank should be fitted with a 6 inch overflow line leading from a point approximately 6 inches below the top to the sewer.

The main solution return line was described in

Exhibit "H"—(Continued)

the above, and we mentioned the use of a 6 inch cross. A 6 inch drain line fitted with a gate valve leads from this cross to the sewer. Another line which leads to the sewer, and which has also been mentioned in the above, is that which carries rinse water or cleaning solution to be discarded from the discharge line which extends from the pump.

Another line which may lead to the sewer is that which extends out of the pit and which starts down at the pit sump, steam syphon or sump pump.

Warning—Safety Device:

To Avoid Any Possibility of the Development of Static Electricity We Recommend the Use of a Flexible Ground Cable Which Can Be Obtained Locally. One End of the Cable Should Be Permanently Fastened to a Clean Metal Surface of the 324 Unit. It Is of Greatest Importance That the Other End of the Above Cable Be Perfectly Grounded, Before Solution or Water Is Pumped. The Above Cable and Fittings Are to Be Furnished by the Customers.

Directions For Cleaning Cars

General:

While the procedure of cleaning tank cars varies somewhat depending upon the type of oil to be removed, there are several operations which are carried out on all cars. These are presented before taking up the details of the removal of several operations which are carried out on all cars. These

Exhibit "H"—(Continued)

are presented before taking up the details of several kinds of oils.

After the car to be cleaned has been placed in the proper position, the dome cover is removed and the Model 324 Unit lowered into position. The hand clamps are turned to the proper angle and tightened to prevent any leakage of solution. The copper ground cable should now be fastened to the car by means of a hand clamp.

Then the 5" flexible steel pipe which has been resting alongside of the track is swung into position and coupled to the car within.

The Red Rubber Indicator Located On Top of the Speed Reducer Should Not be Permitted to Turn More Than 30 R.P.M. At this speed every internal surface of the car will receive the direct impact of a stream of solution during a 15 minute run. If when air is admitted to the air motor and the latter does not turn, revolve the hand wheel a half turn by hand. Occasionally the motor will stop on a dead center.

It is of utmost importance to maintain the solution pressure and temperature to the degree required to obtain best results. We usually recommend an operating pressure of 100 lbs. and solution temperatures of 180° F. Under these conditions approximately 100 gallons of solution are circulated per minute.

High pressure air is admitted into the car dur-

Exhibit "H"—(Continued)

ing the cleaning and rinsing operations to hasten draining and to minimize the depth of the solution or water on the car bottom. Thus the bottom plates will be properly cleaned by the action of the high pressure streams discharged from the nozzles, except as described hereafter. If too high an air pressure is built up within the car the air will blow down through the drain opening. Therefore, we recommend that the depth of the solution be maintained at approximately 4". After initial trial this depth can be ascertained by examining the drop in solution level in the solution heating tank.

A gauge made of a piece of 2" x 3" timber may be clamped to the tank so that it extends in a vertical position a foot or so above the solution level. The wood is graduated with deep notches to show the depth of the Oakite solution in the car. If desired, float gauges may be installed.

Cold water rinsing of a heated car creates a partial vacuum. High pressure air, admitted during this operation, breaks the vacuum and makes it possible for the rinse water to drain properly.

While hot water rinsing may be carried out for any length of time, it is important not to rinse very long with cold water. All that is required of this operation is to lower the car temperature to a degree where it is possible for an operator to enter the car. If cooled too much with cold water, the subsequent drying of the car interior will take considerably longer than otherwise necessary.

Exhibit "H"—(Continued)

After cars have been cleaned with the Model 324 Unit, a small amount of residue may remain at the ends. This deposit is removed manually in a short time after which the operator utilizes the hand rinse hose for a final flushing out.

When it is desired to clean the interior of the tank car coils proceed as follows. A one inch hose is led from a fitting on the pump discharge line to the intake of the tank car coil. The solution should be circulated through the coils and returned to the Oakite tank. It is important that no more than 10 G.P.M. be circulated through the coils, otherwise too much solution will be diverted from the unit resulting in decreased pressure and less effective cleaning.

Charging The Solution Tank:

Admit water to one-third of the normal working level and while this water is being heated, slowly add the charge of Oakite material which will result in the correct concentration of the full amount of solution. Boil thoroughly for several hours before adding the balance of the water.

Upkeeping The Solution Strength:

Keep strength of the Oakite solution up to the required concentration at all times. This is done by adding the proper amount of Oakite to each tank at the end of each day.

Charging The Hot Rinse Tank:

Fill to operating level with fresh water and keep at 180° F. or higher during rinsing operation.

Exhibit "H"—(Continued)

As mentioned above, the cleaning method varies somewhat depending upon the type of oil carried. The following gives a general idea of the time intervals and sequence of operations when cleaning cars having held various kinds of oils.

Gasoline Cars:

1. Hot water rinse 180° F. (not circulated, but run to sewer) to remove gasoline from car bottom, for 10 minutes.
2. Circulate Oakite Composition No. 24 solution, 2 to 5 oz./gal. at 200° F. and 100 lbs. pressure, for 1 hour.
3. Hot water (circulating) rinse at 180° F. and 100 lbs. pressure for 15 minutes.
4. Cold water rinse until car may be entered by an operator who will remove insoluble soils and rust. Car must remain as hot as possible so as to facilitate final drying.

Lubricating and Light Oil Cars:

1. Circulate Oakite Composition No. 24 solution, 5 ounces per gallon at 200° F. 100 lbs. pressure, for from 1/2 to 1 hour.
2. Hot water (circulating) rinse at 180° F. and 100 lbs. pressure for 15 minutes.
3. Cold water rinse as above.

Fuel Oil Cars:

1. Hot water (circulating) rinse at 180° F. and 100 lbs. pressure to remove excess oil. This oil will

Exhibit "H"—(Continued)

float on top of the rinse water in the hot rinse tank, and is removed by overflowing into the sewer.

2. Circulate Oakite Composition No. 24 solution, 5 ounces per gallon at 200° F. and 100 lbs. pressure, for from 1 to 3 hours depending upon the grade of oil.

3. Hot water (circulating) rinse at 180° F. and 100 lbs. pressure for 15 minutes.

4. Cold water rinse as above.

Crude Oil Cars:

1. Steam cars as long as expedient to condition car for second operation.

2. Hot water (circulating) rinse at 200° F. and 100 lbs. pressure until oil no longer drains from car.

3. Circulate Oakite Composition No. 24 solution, 5 ounces per gallon at 200° F. and 100 lbs. pressure, for from 2 to 4 hours.

4. Hot water (circulating) rinse at 200° F. and 100 lbs. pressure for 30 minutes.

5. Cold water rinse as above.

Asphalt Cars:

1. Steam cars for 20 to 24 hours prior to the following operations.

2. Hot water (circulating) rinse at at least 180° F., preferably 200° F. and 100 lbs. pressure until asphalt no longer drains from car.

3. Circulate Oakite Composition No. 24 solution, 5 ounces per gallon at 200° F. and 100 lbs. pressure from 5 to 10 hours.

Exhibit "H"—(Continued)

4. Hot water (circulating) rinse at 200° F. and 100 lbs. pressure for 30 minutes.
5. Cold water rinse as above.

Fish and Edible Oil Cars:

1. Hot water rinse 180° F. (circulated) continue until all excess oil is removed from the bottom of the car.
2. Circulate Oakite Composition No. 24 solution, 1 to 2 ounces per gallon, at 200° F. and 100 lbs. pressure, for from 1½ to 1½ hours.
3. Hot water (circulating) rinse at 180° F. and 100 lbs. pressure for 15 minutes.
4. Cold water rinse as above.

Important Information Regarding Lubrication and Maintenance:

Directions in duplicate entitled Lubrication and Maintenance of the Oakite Interior Tank Cleaning Unit, Model 324 are attached. It is suggested that one set be framed and mounted in a conspicuous position at the car cleaning installation. Oakite Products, Inc., assumes no responsibility should a motor be destroyed due to lack of lubrication. Like any other machine failure to lubricate the moving parts as set forth in the directions for oiling and greasing, will surely result in very greatly lessening the life of the Model 324 Unit.

Name Plate:

We have had an attractive porcelain enamel sign 10" x 15" made up which reads as follows:

Exhibit "H"—(Continued)

OAKITE

INTERIOR TANK

CLEANING SYSTEM

Designed and Serviced By

Oakite Products, Inc.

22 Thames St., New York, N. Y.

One of these signs is included in the shipment of each 324 Unit and we will appreciate its being mounted in a conspicuous place such as one of the columns which support the overhead working platform.

All of the above data regarding the Oakite Interior Tank Cleaning Unit, its installation, maintenance and operation is necessarily general. Further and more detailed information will be presented by the Oakite Representative who will be at hand to give his personal attention to the installation and initial cleaning of cars.

Before the customer starts actual construction, we strongly recommend that preliminary pencil sketches or blueprints of tanks, steam coil construction, etc. be forwarded to the Service Dept. of Oakite Products, Inc., in New York. These prints will be checked and returned to the customer with any suggested changes clearly marked on the print.

Oakite Products, Inc.

General Offices

22 Thames Street, New York 6, New York

GG:MGH

Revised 4/3/46

A-5921 [52]

[Exhibit I—Drawing entitled “Oakite Interior Tank Cleaning—Unit Model 324—4 Tank Installation” is set out in the Book of Exhibits at page 306.]

EXHIBIT “J”

[Title of District Court and Cause.]

AFFIDAVIT OF WILLIAM V. KOONS

State of California,
County of Los Angeles—ss.

I, William V. Koons, being first duly sworn and testifying to facts within my own personal knowledge, depose and say:

That I am a private investigator, and was, prior to November 28, 1956, engaged by Fulwider, Mattingly & Huntley, attorneys for Plaintiff herein, to investigate the Oakite Interior Tank Cleaning System used by the Southern Pacific Company in Los Angeles;

That on November 28, 1956, with the consent and permission of the Southern Pacific Company, I obtained from the files of the Chief Draftsman at the general shops, 1800 Alhambra Avenue, the following documents:

(a) One-page document dated February 5, 1948, entitled “Certificate of Installation”, a copy of [54] which is hereunto annexed as Exhibit F, and by this reference made a part hereof,

(b) One-page document dated “Revised 12/18/45” entitled “Lubrication and Maintenance of the

Exhibit "J"—(Continued)

Oakite Interior Tank Cleaning Unit, Model 324", a copy of which is hereunto annexed as Exhibit G, and by this reference made a part hereof,

(c) Eleven-page document dated "Revised 4/3/46" entitled "Directions for the Installation and Operation of the Oakite Interior Tank Cleaning Unit, Model 324", a copy of which is hereunto annexed as Exhibit H, and by this reference made a part hereof, and

(d) Drawing dated March 25, 1945, entitled "Oakite Interior Tank Cleaning—Unit Model 324—4 Tank Installation" and bearing the designation "Drawing No. D463-S2", an enlarged copy of which is hereunto annexed as Exhibit I, and by this reference made a part hereof;

That I caused photostatic reproductions to be made of said documents, and then returned the original documents to the Southern Pacific Company;

That Exhibits F, G, and H are true and correct copies of the original documents aforesaid; and

That Exhibit I is a true and correct copy of the drawing which I obtained from the Southern Pacific Company, as aforesaid, but differs therefrom in the single respect that it is an enlargement of the original.

/s/ WILLIAM V. KOONS.

Subscribed and sworn to before me this 20th day of February, 1957.

[Seal] /s/ MARY WESCOTT,

Notary Public in and for said County and State.

My Commission Expires Nov. 2, 1958.

[Exhibit "K"—Drawing No. D-463-S1 set out at page 307. Exhibit "L"—Drawing No. D463-S2 set out at page 308, and Exhibit "M"—Drawing No. C-222 set out at page 309 of the Book of Exhibits.]

EXHIBIT "N"

[Title of District Court and Cause.]

AFFIDAVIT OF GEORGE H. BOECK

State of California,
County of Los Angeles—ss.

I, the undersigned, George H. Boeck, being first duly sworn and testifying to facts within my own personal knowledge, depose and say:

I am 56 years of age and have been employed by Oakite Products, Inc., of New York (hereinafter referred to as "Oakite") continuously since 1924, and I am presently employed by Oakite as Technical Service Representative, which position I have held since 1924;

That Oakite Drawings Nos. D463-S1 and D463-S2, copies of which are attached hereto as Exhibits K and L, respectively, and by this reference made a part hereof, were prepared by an Oakite [58] draftsman in 1945, on or before the dates appearing on said Exhibits, (to-wit: September 4, 1945 and March 25, 1945), Exhibit L was based upon and reproduced original design sketches which I made in 1944;

That said drawings, Exhibits K and L, were re-

Exhibit "N"—(Continued)

produced by Oakite in quantity and furnished to me and to other Oakite representatives and were, by me and by said other representative, prior to March 16, 1948, given to many customers and prospective customers of Oakite throughout the United States who were using or who were interested in the Interior Tank Cleaning System illustrated thereby;

That I have read the affidavit of William V. Koons executed February 20, 1957, relating to the captioned matter and have carefully examined the exhibits thereunto annexed;

That I recognized Exhibits G and H annexed to said affidavit of William V. Koons as copies of lubrication and maintenance instructions and installation and operating directions which I had delivered to Southern Pacific Company in Los Angeles prior to March 16, 1948;

That between the dates which said Exhibits G and H bear, (to-wit: December 18, 1945, and April 3, 1946) and March 16, 1948, copies of said Exhibits G and H were, by me and by other Oakite representatives, distributed to many customers and prospective customers of Oakite throughout the United States who were using or were interested in the Oakite Interior Tank Cleaning Unit Model 324;

That I recognize Exhibit I annexed to said affidavit of William V. Koons as an enlarged copy of Oakite Drawing No. D463-S2, (another copy of which is hereunto annexed as Exhibit L, as afore-

Exhibit "N"—(Continued)

said) which I delivered to the Southern Pacific Company in Los Angeles, prior to March 16, 1948; and

That Oakite Drawing No. C222, a copy of which is attached hereto as Exhibit M, and by this reference made a part hereof, was reproduced by Oakite in quantity and furnished to me and to other Oakite representatives and were, by me and by said other representatives long prior to March 16, 1948, given to many customers and prospective customers of Oakite throughout the United States who were using or who were interested in the Inside Drum Cleaning Equipment illustrated thereby.

/s/ GEORGE H. BOECK.

Subscribed and sworn to before me this 20th day of February, 1957.

[Seal] /s/ HELEN J. SULLIVAN,
Notary Public in and for said County and State.

My Commission Expires Sept. 6, 1960.

[Endorsed]: Filed February 25, 1957.

[Title of District Court and Cause.]

DEFENDANT'S NOTICE RE PLAINTIFF'S
MOTION FOR SUMMARY JUDGMENT

To the above-named plaintiff, and to Fulwider,
Mattingly & Huntley, Esqs., and John A. Weyl,
Esq., its attorneys, Greetings:

Please Take Notice that at the hearing on the

plaintiff's Motion for Summary Judgment in the above case, the defendant will rely upon the annexed affidavits of Edward W. Giddings, Keith R. Whitecomb, William Douglas Sellers, James L. Jackson, Claud D. Black and Vesta M. Nelson, upon the annexed Certificate of Arthur Fisher, Register of Copyrights, upon the depositions of Robert C. Baer, Charles R. Ursell, Thomas H. Edgin, Sydney G. Thornbury and Archy F. Slover, filed herein, upon the annexed Reporter's Transcript of [96] Proceedings in the case of Taylor v. Keuffel & Esser Co., No. 15,820-WM, and upon the Complaint, Answer and Counterclaim, and Answer to Counterclaim, in the above case.

Dated at Los Angeles, California, this 1st day of April, 1957.

C. G. STRATTON,
LOUIS M. WELSH,

/s/ By C. G. STRATTON,
Attorneys for Defendant. [97]

AFFIDAVIT OF EDWARD W. GIDDINGS

State of California,
County of Los Angeles—ss.

Edward W. Giddings, of the aforesaid County and State, being first duly sworn, on oath deposes and says that he is Vice President in Charge of Sales and Engineering of the Cee-Bee Chemical Co., Inc., which is the defendant in the case of Delco Chemicals, Inc. v. Cee-Bee Chemical Co., Inc., No. 17,387-WM, in the District Court of the

United States, for the Southern District of California, Central Division, involving United States Letters Patent No. 2,653,116, hereinafter called the patent in suit, and he gives the following affidavit from his own personal knowledge:

That affiant has been in charge of sales and engineering of said defendant for fifteen (15) years, and in such capacity has traveled many times to airports in all parts of the United States, where desealing of aircraft fuel tanks is carried on. Part of his job is to study the different methods of desealing such tanks and learn the results thereof. Affiant also has personal knowledge of the developments in the aircraft desealing field, which led up to the method covered by the patent in suit.

That a C-54 or a DC-4 airplane costs in the neighborhood of one-half to three quarters of a million dollars (\$500,000 to \$750,000), and a DC-6 or a Constellation costs one and one-half to two million dollars (\$1,500,000 to \$2,000,000), so that they are very valuable mechanisms. All such aircraft are so built that the tips of the wings flex several feet under stresses of landing, taking off and flying under stormy conditions. When the sealant in the integral fuel tanks in the wings of such aircraft gets older and hardens, such flexing cracks the hardened sealant and/or breaks it away from the seams, rivets, bolts or nuts inside the metal fuel tank. Then the sealant has to be removed and fresh sealant placed over all seams and completely cover [98] all rivets, nuts and bolts within the fuel tank.

The first method of removing the sealant was by

“hand picking.” The workmen had to be dressed in “Men-from-Mars” suits and had to be supplied with oxygen through hoses, in order to protect them from the gasoline fumes and scarcity of oxygen in the tanks. In these cumbersome suits, they crawled into the cramped quarters of the wing tanks of aircraft, often only ten or eleven inches high, and while lying down laboriously chiseled out the hardened synthetic-rubber-compound sealant, fragment by fragment. This took weeks of time because only one workman could reach a given area at one time, or only one workman could be in the relatively small tank at one time. This was not only expensive for workmen’s time, but ground time for the average plane is considered as costing about \$4,000.00 per day.

Because of the difficulties of working under such adverse conditions, and because of the great expense of this method, a new desealing method was sought. That I was constantly in touch with engineers in charge of such desealing operations in all parts of the United States throughout the period that such hand-picking method was being generally used. That although the patents, cited by the plaintiff in said suit, describing the cleaning of tank cars and ships, were on file in the Patent Office during the period that the aircraft industry was experiencing such difficulties with the said hand-picking method, the problem remained unsolved until the method of the patent in suit was invented.

That I believe such tank car and ship cleaning methods did not suggest themselves to the engineers

skilled in the desealing art for several reasons. In the first place, removing oil or asphalt from a tank car or scale from the hull of a ship is a conventional cleaning operation. The oil, asphalt or scale were not intended to be and were not normally part of the tank or ship, and [99] they are removed as foreign substances as soon as possible. Sealant is a normal, permanent part that is built right into the aircraft, and removing it is a step in a repairing method, for new sealant is replaced in the fuel tank as soon as the old sealant is removed. In a sense, the methods are exactly opposite. An aircraft cannot be flown without the sealant; it is an integral part of the aircraft. The oily or asphalt residue or scale are detriments to the tank car or ship and should be removed, the sooner the better.

Secondly, and probably more important, no tank car or ship had to have a synthetic-rubber compound removed, which is in the nature of aircraft fuel tank sealants. The solvent used to remove same dissolves the sealant in time, except that the cover coat normally remains a sticky, gummy substance when swollen with the solvent and has almost the same specific gravity as the desealing material. That because of the relative rapid flow of the desealing material and the lightness in weight of such sticky, gummy, swollen sealant cover coat, the latter will not settle behind a weir and will not settle in the solvent reservoir used by either party to said action. That, therefore, a reservoir such as used by the parties hereto cannot and does not act as a settling or clarifying chamber. Since neither the tank car nor

ship cleaning processes would be operative for removing sealant, it is no wonder that such processes offered no suggestion to those in the industry trying to solve the aircraft sealant-removing problem.

The next method tried was the fill-soak-and-drain method, whereby the aircraft fuel tank was filled to the top with the desealing material, permitting the sealant to soak for weeks and then the solvent was drained out with most of the sealant. Then the workmen had to crawl in, dressed in "Men-from-Mars" suits, and supplied with air hoses in order to protect them from the highly toxic and often inflammable desealing fumes, and chisel out what always remained after such soaking. Such a "Man-from-Mars" suit [100] is shown in annexed Exhibit 1. The material used in many desealing processes is inflammable; in fact, one workman on a Capitol Airlines plane in Washington, D. C., was burned to death when such desealing material caught fire. That often desealing material is highly acidic and can cause third-degree burns and can put out an eye by direct contact.

The fill-soak-and-drain method was also time-consuming and very expensive. The fill-soak-and-drain method took 1200 man hours, about two weeks of ground time, and 3,000 gallons of expensive solvent costing about \$3.00 per gallon, for a C-54 or DC-4 plane.

With the industry in this condition, the method of the patent in suit was invented. By it, a direct spray of strong desealing material is directed against the sealant. The tank is at all time filled

with the volatile vapors from the solvent. These fine vapors penetrate pores of the sealant that are too small for the spray to enter. This process, as well as the problems which it solved, is different from those involved in cleaning the residue of cargoes or scale that remains on the walls of tank cars or ship tanks. The solvent is a strong, toxic material that is injurious to personnel. By long, continued spraying the sealant is dissolved except for the sealant cover coat, which is not normally dissolved but becomes a sticky, gummy substance in the liquid solvent. This gradual dissolution of the body of the sealant and washing away of the sealant cover coat in gummy pieces, strips or chunks take many hours. In neither a tank car nor a ship is there anything known to affiant that is comparable to the mixture of the toxic solvent and the non-dissolved sealant cover coat of synthetic-rubber compound that is a sticky, gummy substance. As a great improvement over previous processes used in this field, water can be substituted for the desealing material, before the fuel tank is opened, to wash away the volatile, toxic, acidic fumes.

That affiant is familiar with the method of the patent in [101] suit since it is his business to sell chemicals for use in said method, and to supervise actual desealing operations employing the patented method. That the method of the patent in suit is quicker and far less expensive in man hours, gallons of solvent and ground time than the next best fill-soak-and-drain method. Said patented method will desal a C-54 or DC-4 plane with 500 man

hours of labor, 600 gallons of solvent and five days' ground time. In other words, the saving effected by the patented method in an average desealing job on a C-54 or DC-4, as compared with any previous fill-and-soak-and-drain method, is about \$18,700.00, and the total saving to the United States Government by reason of the use of the patented method, over the said previous method, conservatively averages \$2,000,000.00 per year, making a total saving to the government beginning in 1950, by the use of the patented method, of conservatively over \$12,000,000.00!

That prior to the commercial introduction of the method of the patent in suit, it was not commercially feasible to desal an airplane, because of the expense hereinbefore related. When the fill-soak-and-drain method was being used generally, practically the only desealing that was done was by the government, which did not need to be too concerned with expense. The only commercial aircraft that were desealed during the fill-soak-and-drain period were those that would have had to have been abandoned if they had not been desealed. In such days, commercial planes often flew that were not safe. Today, because of the patented method, desealing is required and is commercial practical.

That the method of the patent in suit has a great military advantage. The loss of ground time for desealing military aircraft is not so much a matter of loss of money as it is exposure to danger in time of national peril. At such time, it is of extreme importance to get the planes back in the air in the

least possible time. The patented process does this. [102]

That for the reasons given herein the method of the patent in suit filled a long-felt need in the industry for a process that would be quicker, less expensive and less hazardous to personnel.

Even though Land Patent No. 1,666,015 was issued by the Patent Office almost 29 years ago, and the Turco Products, Inc. drawing (plaintiff's Exhibit B herein) was copyrighted in 1930, it apparently took more than the skill of the thousands of mechanics skilled in this industry to attempt to apply them to the present problem.

In fact, the first reaction stated to the undersigned by mechanics in the field, upon hearing of the method now covered by the patent in suit, was that the relatively hard, synthetic-rubber-compound sealant could not be removed by a mere spray, because it took a week or two of constant soaking to loosen and remove it. Another objection, heard by affiant, to the patented method when first introduced by the defendant was that it would be more injurious to personnel than the previous fill-soak-and-drain method because of the spraying of the solvent. These objections proved incorrect, but they were given as reasons why it was thought the recirculating spray method would not operate satisfactorily.

However, the patented method has been or is now in use in Pan American Airways, Brownsville, Texas, and Miami, Florida; United Airlines, South San Francisco, California; American Airlines,

Tulsa, Oklahoma; Capitol Airlines, Washington, D. C.; Twentieth Century Airlines, Burbank, California; Slick Airways, Burbank, California; Flying Tigers, Burbank, California; Colonial Airlines, New York, New York; Long Beach Airmotive, Long Beach, California; Douglas Aircraft Co., Long Beach and Santa Monica Division; United States Naval Air Stations at Sand Point, Seattle, Washington, and Pensacola, Florida; Civil Aeronautics [103] Authority, Oklahoma City, Oklahoma; Kelly Air Force Base, San Antonio, Texas; Pacific Airmotive Corp., Chino, California; and Norton Air Force Base, San Bernardino, California.

While it is believed that this list of the users of the patented process is quite persuasive that invention is involved in the patented method, it is thought that it is also very striking to note that Turco Products, Inc. had said copyright from 1930 on, and was licensee under the said Land patent for many years, and practically up to the time that the defendant introduced the patented method in the industry, but Turco Products, Inc., one of the leaders in the chemical industry, not only did not make any use of the Land patent whatever in the desealing of aircraft, until after they saw the defendant's use of the method of the patent in suit, but prior thereto representatives of said Turco Products, Inc. stated that the patented process would not work, and that if the patented process were any good, "Turco would come out with it." Now Turco Products, Inc. is a licensee under the patent in suit.

That the annexed Exhibit 2 is a photograph showing one of the plaintiff's desealing machines when connected and ready for operation.

That the annexed Exhibit 3 is a print of a photo showing one of the defendant's desealing units connected and in the act of desealing an integral aircraft fuel tank.

That Exhibit 4 is a close-up view of the defendant's desealing unit underneath an aircraft wing showing the spray pipe with its spray nozzles underneath the wing, and with hatches removed from the underside of the aircraft wing, showing the inside of the wing tank.

That Exhibit 5 is a photo print showing defendant's desealing unit connected to an integral aircraft fuel tank during the desealing operation thereof.

That Exhibit 6 shows a panel upon which mounds of sealants [104] of different kinds have been placed.

That Exhibit 7 is a jar of solvent, such as used in removing sealants from integral aircraft fuel tanks.

That Exhibit 8 is a jar of dried sealant which originally was in an integral aircraft fuel tank but which has been removed by the patented process, and dried.

That in 1952, Air Force personnel at the Tinker Air Force Base, Oklahoma City, Oklahoma, published an evaluation report giving advantages (among others not pertinent to the present case) of the method described in the patent in suit, over the

previously used fill-soak-and-drain method, to wit:
Automatic filtering unit incorporated in machine.
Spray nozzles concentrated at corners and fittings.

Positive check on all spray nozzles during operation.

Absence of fumes in whole hangar.

Toxicity and hazards are minimized.

No need for transferring large quantities of material.

No need for large storage and inventory.

Workmen do not come in direct contact with stripper [solvent].

Desealing machine is portable and self contained.
Actual stripping time is reduced.

The need for spray or stripper on brush is minimized.

No need for fill and drain.

With present facilities, twice as many tanks can be stripped with one unit. [105]

Permits inspection of stripper process during operation.

Less damage to tank due to hand picking.

Small quantity of material required for operation.

High-pressure rinse can be done simultaneously with desealing operation.

That the above list of advantages was compiled from tests made on a C-54 aircraft in which the patented method was compared with the fill-soak-and-drain method. That the above list correctly states advantages of the patented method over the

previous fill-soak-and-drain method, although the above list included technical advantages only; the cost advantages of the recirculating spray method over the fill-soak-and-drain method were separately noted.

/s/ EDWARD W. GIDDINGS.

Subscribed and sworn to before me this 29th day of March, 1957.

[Seal] W. W. DUFRESNE,
Notary Public in and for the County of Los Angeles, State of California. My Commission expires May 6, 1960. [106]

AFFIDAVIT OF KEITH R. WHITCOMB

State of California,
County of Los Angeles—ss.

Keith R. Whitcomb, of the aforesaid County and State, being first duly sworn, on oath deposes and says that he is one of the inventors named in United States Letters Patent No. 2,653,116, the patent in suit in the case of Delco Chemicals, Inc. v. Cee-Bee Chemical Co., Inc., No. 17,387-WM, in the District Court of the United States, for the Southern District of California, Central Division, and he gives the following affidavit from his personal knowledge:

That affiant is a research chemist in the employ of the above-named defendant, and has been continuously so employed since September, 1946, and since 1948 has been Technical Director for said defendant; and in such capacity has been in charge

of the chemical and testing laboratory of the said defendant ever since its beginning in September, 1946. At the present time, affiant has five other employees of said defendant under his supervision in said laboratory. That affiant is a graduate of San Diego State College in the year 1940, with the degree of A.B. with chemistry major, and received a degree of M.A. with a chemistry major in 1942 from Claremont College, the graduate school of Pomona College.

That affiant has been continuously employed as a chemist ever since receiving his Master's degree in June, 1942. That he was employed by Ryan Aeronautical Co., San Diego, in their chemical laboratory from June, 1942, to November, 1944, and was in charge of production research for that company for almost two years of that period. Also during that period, affiant developed and invented a welding flux for stainless steel that is still being used by that company. He also developed and invented a salt-bath heat treating process for stainless steel that was in use by that company for about two years, and developed and invented a [112] brazing alloy for brazing stainless steel to provide a high temperature surface, which was patented. From November, 1944, to April, 1946, affiant was Laboratory Officer in Charge of Materiels (Chemical) Laboratory at El Toro Marine Base, Santa Ana, California. From April to September, 1946, he was again employed by Ryan Aeronautical Co., and then came to the defendant.

That the suggestion for using the spaces in the

wings of aircraft for integral fuel tanks first occurred at least as early as 1937 or 1938. However, in order to use these spaces as fuel tanks, it was necessary to put some type of sealant within the tank to cover the seams, joints, rivets, bolt-heads and nuts within the tank, so that gasoline stored in such wing spaces would not leak out.

That several types of synthetic rubber compounds, known in the trade as "sealants," have been developed for this purpose, none of which is completely satisfactory, for the reason that they either do not continue to adhere completely to the metal during all stresses, or for the reason that the curing of the sealant causes it to become brittle and crack after it has dried. Since no sealant has been discovered to date that will both completely adhere to the metal and remain resilient and stay in place as long as the aircraft is used, it is necessary from time to time to remove the sealant from the fuel tanks and to replace the sealant, in order to prevent leaks developing therein.

That the need for removing the sealant from the integral fuel tanks of aircraft first became apparent about 1940. That in taking off, flying and especially when landing an aircraft, there is considerable flexing of the wings, caused by stresses. It has been found that for these reasons and because of cracking of the sealant or its not staying in place, the sealant develops dangerous leaks.

That during World War II the military services were the [113] principal users of the wing spaces as integral fuel tanks. However, after said war, the

commercial aircraft companies also began using the wing spaces as integral fuel tanks, and about 1946 the commercial need for "desealing", or removing the sealant, developed.

That the first method used for desealing was purely a manual method, to wit, a person had to crawl into the tank and endeavor to work in cramped, darkened quarters, e.g., a space of only ten inches high in which to do the work in some aircraft wing tanks, and the workman had to have an artificial light. This method was slow, arduous, expensive and unsatisfactory. That all the old sealant had to be removed, for in case some of the old sealant were left therein, it was disposed to crack or to pull away from the metal and cause leaks in the new sealant that would be applied over the old sealant.

That the next method tried was known as the "fill-soak-and-drain method." This method comprised filling the integral fuel tank with a liquid solvent that attacked the sealant. The solvent was allowed to remain in the tank and soak the sealant for a number of days. Then, the solvent and any loosened sealant were drained out of the tank. Thereafter, a person had to crawl into the tank in a protective suit, which has been termed in the industry a "Man from Mars" suit, which fully covered and protected the workman. An air hose, of course, was necessary since the solvent was volatile and highly toxic. The workman would receive burns if he came in direct contact with the solvent or stripper.

That objections to the fill-soak-and-drain method are that it is expensive, dangerous and very time-consuming. That, by way of analysis, it took 3,000 gallons of said solvent to fill the integral fuel tank of a Douglas DC-4 model aircraft, the cost of which solvent amounted to \$9,000.00. That the time consumed for carrying out this fill-soak-and-drain method in said model aircraft ran about two weeks, and took approximately 1,200 man [114] hours. The large amount of expensive solvent that was required and the length of time it was necessary to keep the airplane out of service during the operation, made the cost of such descaling operation so expensive that the commercial aircraft companies could not afford to clean the wing tanks of their aircraft, except on a few jobs of exceptional necessity.

That up until the time of the method of the patent in suit, no one had discovered any effective solution to the problem. Up to that time, about the only attempts in solving the problem had taken the form of developing new solvents for use in carrying out the old fill-soak-and-drain method.

That when the method of the patent in suit was first disclosed to the technical men in the aircraft industry, they expressed to me the view that, due to the peculiar problems attending the removal of sealant compositions from integral aircraft tanks, the method would not work. For instance, they called attention to the fact that the way in which the solvent compounds were located in the joints, they would not be sufficiently exposed to a sprayed solvent as to react sufficiently with it and be re-

moved by such spray. They also called attention to the danger that the breaking up of the solvents into a continuous spray in the tank would increase the toxic and poisonous fumes which would render the procedure too dangerous to workmen.

However, after observing commercial demonstration of the patented method by the defendant, they expressed the view to me that not only did the patented method remove all the solvent compounds from the tank, but that it did so in a more complete and effective manner. For instance, instead of the solvent vapors created by the spray producing a hazard, as they had feared, it was found that, by sealing the wing tank during the operation, those vapors performed the entirely unexpected result of themselves attacking the sealant compounds which were located in [115] portions of the joints which could not be effectively or directly reached by liquid solvents. That result was not foreseen!

Another unexpected advantage of the patented method was that there was a heat generated by impingement of the spray on the sealant which caused volatilization of the solvent at the very point where needed. This appeared very effective in the solvent attacking the sealant.

Furthermore, it was found that, by use of the patented method, it was possible to clean portions which had theretofore been impossible to clean by any previously known method. That is, for instance, it enabled the cleaning of "stringers". Stringers are narrow, hollow, longitudinal strengthening elements which extend from the fuselage throughout

the length of the wings, and in order to seal the integral wing tanks it is necessary to put sealant compound within those long, narrow hollow stringers. For instance, the Wyandotte Chemical Company made a study and report, at a cost of \$150,000.00, for the United States Air Force in connection with this problem of cleaning the stringers, and after said study concluded that it would not be possible to clean them without rebuilding both wings of the aircraft. However, in my presence it was demonstrated that the patented method would successfully and easily clean such stringers and as a consequence the United States Air Force has now issued technical order No. 1C-54-88 requiring that the stringers be cleaned when desealing an aircraft and, by reason thereof, the standards for desealing jobs done for the United States Government have been materially raised, because of the patented process.

That, as compared with the substantially larger cost of desealing by the fill-soak-and-drain method above described, the patented method when desealing, for instance, a Douglas DC-4 model aircraft takes only 600 gallons of material costing \$1,800.00, and the cleaning operation is completed in approximately five days' [116] time, involving 500 man hours. (That these figures could be compared with the figures given above for desealing the same model aircraft by the fill-soak-and-drain method.) That, in addition to the direct cost of material and labor, there is the indirect cost caused by the loss of flying time of the plane while it is being de-

sealed. This has been calculated to amount to about \$4,000.00 per day per plane. Thus, with a reduction in the time on the ground, there is a great saving indirectly by the use of the patented method.

That an additional advantage of the patented method over the fill-soak-and-drain method is that the progress of the sealant-demoving job can be observed by merely shutting down the pump, removing the hatch and looking inside the tank; whereas to observe progress of the fill-soak-and-drain method, it would have been necessary to have removed all the fluid from the tank before a person could look inside.

That a still further advantage of the patented method is that a rinse may be sprayed in the tank, while it is still sealed shut, in order to wash toxic solvent materials from the atmosphere within the tank, and to prevent their escape into the atmosphere around the aircraft where the workmen are. This was not possible with the fill-soak-and-drain method, since the hatch had to be opened, permitting escape of the toxic and very volatile fumes into the atmosphere around the plane, before any rinse could be sprayed inside.

That by continuous spraying of the sealant in an integral aircraft wing tank, strips or pieces of the sealant are removed. These strips or pieces are lightweight, slimy, gooey, jelly-like or sponge-like masses that are substantially the same specific gravity as the solvent, so that such pieces of swollen sealant are substantially held in suspension by the flowing solvent; that is, the spongy, jelly-like, light-

weight sealant neither descends [117] nor rises in the flowing solvent but is carried along by the solvent. Such sealant is, therefore, very difficult to separate from the solvent. That unless this jelly-like material is removed from the solvent, two bad effects will result: (1) the pump will become clogged; (2) fine particles of the jelly-like mass which would be chopped up by the pump before it is clogged, would clog the spray openings inside the fuel tank. When in full operation, this clogging would take place in minutes, say in the order of two, three or four minutes, and thus the system would become inoperative upon removal of the first pieces of sealant.

That the defendant's apparatus, employing the patented method, utilizes a 300-gallon tank or reservoir for the solvent, and the solvent circulates at the rate of 150 gallons per minute, which rapid flow prevents any settling of the spongy, jelly-like pieces of swollen sealant. That such a rapid rate of flow would render an overflow outlet or weir valueless for separating jelly-like, swollen sealant from the solvent, since the swollen sealant material would largely flow over the overflow or weir along with the rapidly moving solvent and clog up the pump and sprays, as stated.

That the "fine mesh strainer" of Oakite (Exhibit H, p. 4), which is "cylindrical" and "has an area of not less than three square feet of ten mesh wire", and is in every suction line that leads "from each tank to the intake opening of the pump", is to remove metal scale that is displaced from the interior

of the tank car, and would not screen out "sealant from the solvent" as specifically covered in most of the claims of the patent in suit. A three square foot—ten mesh fine strainer would be clogged by the swollen, spongy sealant in about two minutes if used to try to remove such sealant in the patented process.

The synthetic rubber compound that is used for a sealant [118] is water-insoluble and water-repellent. On the contrary, the solvent used to spray on the sealant is of such nature that it is absorbed by the sealant, which becomes swollen with the solvent. This swelling causes the sealant to release itself from the wall of the aircraft tank. The solvent is a highly volatile material, so that if the tank were opened at this point and the solvent allowed to evaporate, the sealant would again form hardened, water-insoluble deposits within the fuel tank.

Applying water to the sealant at this point, while the sealant is thus swollen with solvent, would cause the sealant to re-set. As one means of avoiding these difficulties of the solvent evaporating or re-setting, the patented method, *inter alia*, contemplates the use of a spray of a material that is both miscible with the solvent and is water-rinsable. This spray may be separate from the solvent spray or they may be simultaneously sprayed according to the patent in suit. Soap or a soapy solution is not solvent-miscible and would not prevent the solvent from evaporating, and would not prevent the sealant from returning either to a hardened material or to a water-insoluble material. In fact, soap or a

soapy solution would wash away the solvent and definitely cause the sealant to re-set as a hardened rubber compound, so soap or a soapy solution would be inoperative and produce just the opposite results from those desired.

That a "cleansing liquid such as water, salt water, caustic solution or the like" (referred to in Butterworth patent No. 2,018, 757, p. 1, col. 1, ll. 19-20) would not be solvent-miscible, and instead of removing sealant that is saturated with solvent, such "cleansing liquid" would wash out the solvent and tend to re-set the sealant against the wall of the fuel tank in hardened masses.

Having the solvent 60° F. to 100° F. (see claim 3 of the patent in suit) is not an arbitrary range. Heating the solvent [119] to "150° F. to 180° F. or higher", as done in Butterworth patent No. 2,018, 757 (p. 1, col. 1, ll. 37-38), would not be satisfactory. It would tend to volatilize the solvent too quickly—before it could impinge strongly, in a full liquid state, upon the sealant. It is best to create the heat by the impingement, at the time of impact—not ahead of time, which would reduce the force of the liquid spray by tending to vaporize it.

That, as a consequence of the use of the patented method, not only has the United States Government, and others, been saved a great deal of money in desealing aircraft wing tanks, but at the same time the convenience, speed, safety and standards of desealing have been substantially advanced.

That it is believed clear from the foregoing why the method covered by the patent in suit is used

almost universally in the industry today — to the almost entire exclusion of the old fill-soak-and-drain method.

That the plaintiff is a relative newcomer in the desealing industry, compared to the defendant or Turco Products, Inc., and had not theretofore engaged in the desealing business, did not have any part in initiating the recirculating spray method, and did not do any of the pioneering work to make it practical.

/s/ KEITH R. WHITCOMB.

Subscribed and sworn to before me this 28th day of March, 1957.

[Seal] W. W. DUFRESNE,
Notary Public in and for the County of Los Angeles, State of California. My Commission expires May 6, 1960. [120]

[Title of District Court and Cause.]

AFFIDAVIT OF WILLIAM DOUGLAS
SELLERS

State of California,
County of Los Angeles—ss.

William Douglas Sellers, of the aforesaid County and State, being first duly sworn, on oath deposes and says that he is an attorney at law admitted to practice before the Supreme Court of the State of California, and has specialized in patent law for thirty years. That in the year 1925 he graduated from the California Institute of Technology and holds other degrees. As a part of his work as a

patent lawyer, he has engaged in the prosecution of thousands of patent applications, both as an Examiner in the Patent Office and as an attorney before the bar of the Patent Office. That he has also handled the litigation of patent cases in the Ninth Circuit, the Seventh Circuit, in the District of [121] Columbia, and before the United States Supreme Court.

That affiant has examined United States Letters Patent No. 2,653,116 issued to Cee-Bee Chemical Co., Inc., on a Method of Removing Sealant from Fuel Tanks, on September 22, 1953, invented by Keith R. Whitcomb and Eugene E. Finch and which is hereafter referred to as the patent in suit.

That the method covered by said patent in suit is a closed-circuit method, which includes, inter alia, (a) spraying a volatile, toxic solvent within an integral fuel tank in an aircraft to remove and loosen sealant therein, (b) gravitationally draining the mixture of solvent and removed sealant material from the tank, (c) screening the sealant from the solvent, (d) returning the solvent to the said fuel tank under pressure for respraying against remaining sealant in the interior of the fuel tank, and (e) applying water under substantially higher pressure to remove further sealant that is loosened but not removed by the solvent spray, and draining the water, loosened sealant and rinsed solvent from the tank.

That the following eight prior patents were cited by the Patent Office Examiner during the prosecution through the Patent Office of the patent in suit

(which prior patents are also listed at the end of the patent in suit):

| | |
|----------------|------------|
| Butterworth | Re. 19,374 |
| Foster | 1,141,243 |
| Gray | 1,628,141 |
| Haupt | 1,892,950 |
| McFadden | 2,092,321 |
| Paulson et al. | 2,123,434 |
| Jaffa | 2,442,272 |
| Brady | 2,458,333 |

That the plaintiff is relying upon certain patents not cited by the Examiner in the Patent Office, but which are no more [122] relevant or persuasive of non-invention in the Whitcomb et al. patent 2,653,-116, than the above patents cited by the Examiner. This additional art comprises:

| | |
|-------------|-----------|
| Butterworth | 2,018,757 |
| Butterworth | 2,045,752 |
| Land | 1,666,015 |
| Jensen | 1,730,658 |
| Olsson | 2,065,462 |
| Robinson | 1,701,824 |
| Court | 2,245,554 |

Of these patents the plaintiff apparently feels Butterworth 2,018,757 (Fig. 3) and Land 1,666,015 to be of greatest interest, and I will discuss these first.

Annexed here to is "Exhibit 9" which consists of a copy of the drawing of the patent in suit, of claim 6 thereof in which numbers "(1)" to "(8)" have been inserted to define the parts thereof, and

of an enlarged copy of Fig. 3 of the Butterworth patent No. 2,018,757. That said parts of said claim 6 have lines drawn therefrom to respective parts of the patented structure which carry out the respective steps of claim 6, except clause (7) which refers to column 4, lines 59-64 of the patent in suit. That said "Exhibit 9" indicates, by the repeated use of the word "None," the steps and parts of claim 6 of the patent in suit which are not found in said Butterworth patent and which steps, being directed to the removal of a sealant, are not suggested or anticipated in said Butterworth patent.

Also annexed hereto is "Exhibit 10", which is a copy of a claim 3 of the patent in suit, except that numbers "(1)" to "(8)" have been added, and an enlarged copy of Fig. 3 of said Butterworth patent No. 2,018,757. Also lines have been drawn from the clauses in said claim 3, and under a heading "Anticipated?" are listed "No," "No time nor spray material mentioned," "No pressure [123] mentioned," or "?," which legends indicate which parts of said claim are not found in said Butterworth patent. The question mark, "?," indicates that the temperature limitations of 60° F. to 120° F. cannot be found in said Butterworth patent.

It should be noticed that claim 3, like all of the claims of the patent in suit, is a method claim, and not an apparatus claim.

Said Butterworth patent does not remove sealant, as explained; does not remove it from an integral aircraft wing fuel tank, which is irregularly shaped, but from a smooth, cylindrical interior of a

tank car; does not use a volatile solvent, or use it for two to eight hours. In Butterworth, the cleaning liquid is heated "150° to 180° F. or higher" and would probably quickly mix with and remove the oil in a few minutes, since it states that the cleaning is "efficient," and that, "The hot water * * * washes the oil and other formed material from the walls" (emphasis added, since a "washing" operation is generally considered a process that is not prolonged). Dealing with an aircraft sealant, or anything comparable, was not suggested by Butterworth. The pressure of thirty to ninety pounds per square inch is also not mentioned in that prior patent; merely enough pressure needs to be used for the hot sprays 30 of Butterworth to reach the walls in the tank and wash down the oil, etc. The pressure of the patent in suit is not taught by this prior patent.

A feature of claim 3 of the patent in suit, that is in no way suggested by the Butterworth patent, is the additional step of a second and different spray, to wit, "a substantially less volatile * * * spray to the solvent." One and only one spray is suggested by Butterworth for any single washing operation. The patent in suit, however, teaches not only that this second and different spray is to remove the first spray, but that this second spray is (1) water-rinsable and (2) at the same time solvent miscible. No second and different spray to wash out an [124] initial spray material is even remotely hinted at in Butterworth.

Additionally, Butterworth does not then show

water being applied at a very much higher pressure, to wit, three hundred pounds per square inch, which is the last element of claim 3 of the patent in suit.

In short, Butterworth falls far short of showing the different elements of claim 3 of the patent in suit, as stated.

That in my opinion the Butterworth patent No. 2,018,757 does not show or describe the process of the said patent in suit. Butterworth is directed to removing a residual oil film and not to the problem of separating from a tank a sealant that is essentially an integral part of the tank in normal operation, and without which sealant the tank is inoperative for fuel storage.

Butterworth in the use of his said patented structures endeavors to clean "oil encrusted tanks." In doing so, he has to separate oil from water. He does this by letting the "oil and water stratify." In his tank car cleaner (Figs. 2 and 3), he has two separating means, to wit, oil is allowed to drain off "through a line 39 to a ditch 40," which acts as a weir overflow, and he has a weir 38 in basin 35 behind which "scale or other solid material" will settle. The Butterworth patent does not teach that this would be operative for separating jelly-like pieces of sealant from a liquid having substantially the same specific gravity, in a comparatively rapid flow.

I have also carefully examined the Butterworth patent Re. 19,374, cited by the Examiner in the prosecution of the patent in suit through the Patent Office, and have found that it is generally the same

as Butterworth patent 2,018,757 now relied upon by plaintiff. The said reissue patent Re. 19,374 has a settling chamber 7 in which the "sediment will settle out" and the "same cleaning liquid [is] used over again." This patent has a recirculating pump 9 fed by an inlet pipe 10 whose inlet is above [125] the settled sediment in chamber 7, whereby it acts as a weir the same as the overflow weirs of the first-mentioned Butterworth patent.

The Land patent No. 1,666,015, also relied on by the plaintiff, has been carefully considered by affiant. This patent obviously contemplates only the cleaning of tank cars which contained something miscible with cleaning fluid (such as gasoline, oil, milk, etc.) or soluble in the cleaning liquid (such as molasses). No separating means of any kind is provided. In other words, Land is not intended nor adaptable to cleaning out tank cars in which there is a substance that will clog the pump (such as the present sealant). In this respect, the Land patent is even more remote than Butterworth Re. 19,374 (cited by the Examiner), or Butterworth 2,018,757 (which at least has overflow weirs, even though they would not be operative for the present purposes).

The Patent to Jensen 1,730,658 teaches no filter as the plaintiff contends. The pipe and its connection are described on page 1 of the specification at lines 56 to 59, inclusive, and no mention is made of a filter. As a matter of fact, the draftsman simply was not careful and he forgot to leave the top of the pipe 5 open. At the place where the plaintiff

says there is a screen, the draftsman indicates a solid wall. The accepted cross hatching indication for a screen is a wavy line with dots in the valleys upon both sides. No such indication is shown in the Jensen patent.

None of the prior patents cited by the plaintiff teaches (1) removing sealant from an integral fuel tank of an aircraft; nor (2) removing sealant from multiple cells of an aircraft fuel tank "divided by at least one bulkhead"; nor (3) impinging volatile solvent "upon opposite sides of the bulkhead"; nor (4) draining solvent and its carried sealant by gravitation "from one cell to another"; nor (5) screening "pieces of sealant" from the solvent. [126] (The foregoing, *inter alia*, are all in claim 4 of the patent in suit.)

The remaining patents called to attention by the plaintiff are of less relevancy than those referred to above.

Robinson 1,701,824 relates to the flushing out of automobile radiators. The radiator is turned upside down and flushed out. Collected sediment is removed. Turning an airplane upside down is rather impractical, and in any event, aircraft sealant could not be removed without any spray, merely by a reverse flow. This is a far cry from a method of rebuilding the sealed fuel tanks of aircraft by removing an integral lining, a task previously so difficult that men actually climbed inside and did the work by hand.

Butterworth 2,045,752 is directed to an entirely different problem, to-wit, the washing and in effect

sweeping of a residual deposit along the bottom only of a tank car, toward a central outlet, by the use of jets of steam. This patent employs a settling tank. A settling tank is only of use if a large volume of inexpensive solvent is to be used. The use by Whitecomb et al. of a screen makes possible the use of a relatively small volume of fluid moving at a relatively great velocity and so reduces cost. Again nothing is taught in the field of aircraft fuel tank reconstruction.

Olsson 2,065,462 is directed to removing an oily viscous film, and does not circulate the fluid after spraying it out once. It is a batch process, requiring the material that collects at the bottom of the boat to be pumped out "by the ship pumps" (page 2, column 1, lines 32-37). This patent is even less relevant than 1,701,724. It teaches nothing to the field of fuel tank rebuilding.

Court 2,245,554, entitled "Hydraulic Disruption of Solids," is directed to the removal of carbonized deposits in a coking [127] chamber, by what is in effect drilling by powerful jets of water only (up to 1200 pounds per square inch) and making successively larger holes in a bed of coke or the like. An expert in the field of aircraft fuel tanks could not be expected to know about coking chambers. If the methods used were identical (which they are not), there still would be invention in going from one of those remote fields to the other. This Court patent does not use a volatile solvent (only water), does not use a less volatile solvent-miscible spray to rinse out the first solvent, and

then remove both of such materials by a much higher rinse. In other words, this patent does not teach such steps of the method of the patent in suit.

None of the prior patents relied on by the plaintiff in the present motion, nor any of plaintiff's Exhibits G, H, K, L or M, teaches the use of a "less volatile" emulsifier that is "solvent-miscible," between the use of a volatile solvent and just water, as specifically called for in claims 2 and 3 of the patent in suit. As stated in claim 1, this second spray is emulsifying "to the sealant." None of such prior art, relied on by the plaintiff, has or suggests such a three-step method.

None of the prior patents relied on by the plaintiff describes a method that includes spraying with a toxic material that is injuries to personnel, and then removing the injurious fumes by a water spray, before they can escape into the air, by means of a closed, recirculating system.

Also appearing to be new in the art of removing sealants over the art relied upon by the plaintiff is the subject matter of claims 6 and 7 of the patent in suit, which claims not only cover the process discussed hereinbefore, but also cover (1) loosening (but not removing) portions of the sealant with a spray of solvent under a pressure of approximately thirty to ninety pounds per square inch, which saturates and softens the sealant and removes [128] some of the sealant, and (2) then applying water under substantially higher pressure (e.g., pressure of at least approximately three hundred pounds per square inch) "to remove further

portions of the sealant that are loosened but not removed by the solvent spray.”

The alleged prior art patents, relied on by the plaintiff, in fact come from non-analogous arts spaced from the field in which the invention of the patent in suit lies, and it is a question of fact of great doubt that the relationship is sufficiently close that those arts may be called analogous. This is a question of fact which can be decided only upon consideration of expert testimony.

The invention of the patent in suit relates to the field of rebuilding sealed fuel tanks in aircraft. More specifically it relates to the removal of a sealant intentionally secured on the interior of the tanks and having a thickness up to one and one-half inches. Here is no question of washing oil, milk or scum undesirably adhering to a tank surface. Here is the matter of removing not “dirt” but a permanent part of the tank, and more specifically by the use of a relatively small quantity of expensive solvent in the absence of a settling tank or tanks.

The field of the removal of the normally permanent sealant from the interior of an aircraft-wing fuel tank relates to the field of washing adherent milk or oil from the tank wall in about the same way that removing the permanent stucco exterior of a house relates to washing dirt from the side of a house with a stream of water from a hose. Possibly the stucco could be removed in the same way the dirt is washed off, that is, by a stream of water. The fact is, however, that the two fields

are distinct, one does not suggest the other, and the first to discover that the hose washing technique is suitable for removing otherwise permanent stucco that would not appear to be so removable, should be [129] entitled to protection.

The prior art patents relied upon by the plaintiff relate with few exceptions to the field of washing or cleaning. This is true of the Butterworth patents. It is true of Land 1,666,015. The patent to Court 2,245,554 relates to an entirely non-analogous field in which the problem is the emptying of a coking chamber packed solid with coke. The patent art appears to be principally concerned with washing and cleaning the interior of ships and tank cars. It is not clear why the builders and rebuilders of aircraft should be at all familiar with the cleaning technique used in such fields, particularly where their own problem was not one of cleaning.

The patent in suit is directed to a method. The prior art does not teach that method. It teaches other methods, in other fields. The apparatus may be similar but until the concept that the old apparatus is usable in the new field is taught, it cannot be said that invention was not present in the concept of so using it. At the very least, it is a question of fact requiring expert opinion of the relative relationship of the fields and the problems involved.

A weir is not a screen, according to the dictionary and according to known engineering principles. With a screen, foreign particles are removed by

not passing through the screen, while the remainder of the material passes through the screen. A weir more nearly approaches a dam. With a weir, any separating function results from the settling of the foreign substances from the liquid on the high side. A weir requires a settling tank and a relatively large body of quiescent liquid, in order to permit such settling. A body of solvent that would be large enough to permit settling of a material that has nearly the same specific gravity would be excessively costly.

In connection with the drawings, plaintiff's Exhibits E, K, [130] L and M, which bear notations indicating that they were copyrighted, the fact is that a copyright notice on a paper is not proof of actual publication. A copyright notice is required by copyright law to be placed upon a document which is to be published, but the document may be filed away and never published. The notice is necessary if copyright protection is to be obtained, but since the notice must be placed on the work before publication, the existence of such notice is not of itself proof of publication.

In conclusion, the defendant is not, in affiant's opinion, estopped to contend that prior art patents teaching cleaning operations do not anticipate the Whitcomb et al. patent. Patents in that field were cited by the Examiner and it was at all times contended by the attorney of record that they did not anticipate the claims now in the patent in suit, and the Examiner impliedly admitted the soundness of such argument by allowing the patent in

suit despite such prior patented cleaning apparatus.

Further affiant saith not.

/s/ W. D. SELLERS.

Subscribed and sworn to before me this 11th day of March, 1957.

[Seal] /s/ DOROTHY E. KLIPPERT,
Notary Public in and for the County of Los Angeles, State of California. My Commission Expires Feb. 13, 1958. [131]

[Exhibit No. 9—Copy of Drawing of the Patent in Suit No. 2,653,116 of Claim 6 is set out at page 310 and Exhibit No. 10—Copy of Drawing of Claim 3 is set out at page 311 of the Book of Exhibits.]

[Title of District Court and Cause.]

AFFIDAVIT OF JAMES L. JACKSON

State of California,

County of San Bernardino—ss.

James L. Jackson, being first duly sworn, on oath deposes and says:

That he is a Brigadier General in the United States Air Force, presently assigned as Deputy Commander of the San Bernardino Air Material Area, Norton Air Force Base, California. The statements contained in this affidavit are made on affiant's personal knowledge.

Between 1924 and 1927, affiant studied mechanical engineering at the University of Arkansas. In

1928 he became a flying cadet in the United States Army Air Corps. After receiving his wings and commission as a second lieutenant, affiant served as a [134] pilot in the Army Air Corps for two years on squadron duty. In the years 1930 and 1931, affiant studied a course in aircraft maintenance engineering, and graduated from the Air Force Technical School at Chanute Field with the degree of maintenance engineer. Since then, affiant's duties have been almost exclusively devoted to aircraft maintenance for the United States Air Force, or its predecessor, the United States Army Air Force.

During World War II, affiant's commands, among others, included the Air Base at Abadan on the Persian Gulf, where it was affiant's responsibility to assemble aircraft for delivery to Russia. Thereafter affiant was transferred to China, where it was his responsibility to maintain, repair and service all United States Army aircraft in that area; to support their operations and to keep them in condition for the service they were required to render. In 1946, affiant was transferred to Dayton, Ohio, as Chief of the Technical Section, United States Army Air Force. He later became Deputy Chief of all maintenance for the United States Army Air Force throughout the world. This position he occupied until 1949.

In 1949, affiant took a post graduate course at the Industrial College of the Armed Forces, and thereafter was transferred to the San Antonio Air Material Area as Chief of Maintenance Engineer-

ing. At that time, the San Antonio area included the states of Texas, New Mexico, Arizona and Louisiana. The shops under affiant's command employed 12,000 persons, and we were then primarily engaged in repairing and servicing aircraft for the Korean operation. In 1953, affiant was transferred to Africa, and was placed in command of the Southern Air Material Area, (Europe), until the fall of 1955. Since that time he has occupied his present position as Deputy Commander, San Bernardino Air Material Area. This area includes Arizona, the Southern County of Nevada, and half of California. [135]

Affiant first became aware of the problems connected with the leakage of gasoline from aircraft integral fuel tanks in 1940 or 1941, in connection with the P-35 and BT8 (Seversky) Aircraft, while he was stationed at Dayton, Ohio. To affiant's knowledge, these planes were the first that had integral fuel tanks, and it was discovered that in spite of the sealants which were then in use, fuel would leak from the tanks when the planes went through rough air, or upon being jostled due to landing. Again, in 1946, after his return to the United States, one of the first problems with which affiant was confronted was the leaking of fuel from C-54 aircraft (DC-4) which had operated in Alaska. From 1946 forward, the Air Force was greatly concerned with the problem of sealing and de-sealing integral fuel tanks. Many methods were tried, and the vendors and mechanics in the trade worked upon the problems and suggested various methods

whereby the operations could be done more efficiently, more economically and more effectively. Among the problems in this field was that of removing old sealant in order to prepare the surface of the wing for the application of new sealants. To obtain a tight bond between the sealant and the aluminum surface of the wing, it is necessary to have the wing surface "surgically" clean before apply a new sealant. The methods in use between 1946 and 1949 were principally the hand scraping method and the fill, soak and drain method. Both of these operations were inefficient, dangerous to personnel, and extremely costly. In an effort to solve these problems, chemical suppliers suggested the use of different chemicals, and variations on the methods of de-sealing or stripping the sealants that were then in use.

None of the methods suggested proved to be satisfactory, and they were all extraordinarily expensive. We found a particularly critical problem in connection with the B-36 aircraft. The wings of that aircraft contained a "sandwich" of a gummy [136] material, which was designed to immediately seal up bullet holes and prevent the leakage of fuel from the wing tanks. The tanks of these aircraft were so large that men could stand and walk in them, and the pressure of the chemicals within the tanks through the use of the fill, soak and drain method caused the chemical to leak into the "sandwich" and destroy this gummy material. Convair, the manufacturer of that aircraft, was most anxious concerning this problem, and no solution was found

until the Cee-Bee Chemical Company demonstrated the operation of its recirculating spray method during the latter part of 1951.

This was the first time that either I, or anyone who worked under me at our shops, had heard of such a system in connection with the stripping of sealant from integral fuel tanks. When this method was first brought to my attention, I was skeptical of it, and did not believe that it would be workable. It did not seem to me that the mere spraying of the chemical through small apertures would sufficiently concentrate upon the sealant to perform the job effectively, and, in addition thereto, I considered that it might be more dangerous than previous methods then in use. However, my skepticism was dissipated upon observing the operation of the recirculating spray system and calculating its beneficial results.

This system saved hundreds of man hours, and did not destroy the B-36 "sandwich." Prior to the use of the Cee-Bee method of de-sealing, the B-36 has constant leakage problems, but after the de-sealing with the Cee-Bee method and the application of new sealant, the aircraft worked satisfactorily.

I have examined a soft copy of the patent in suit, namely, Whitcomb 2,653,116, and find that the recirculating system which I observed demonstrated by the Cee-Bee Chemical Company was the same as that disclosed in the patent in suit. To my knowledge, no one in the Air Force, or in the industries who served the Air [137] Force, con-

ceived of using this recirculating method to strip sealant from the inside of integral fuel tanks prior to the Cee-Bee Chemical Company, although a pressing need for an improved method of de-sealing integral fuel tanks had existed for several years. I attribute the increased efficiency, lower cost, and greater effectiveness of the recirculating spray method to the method itself, and not the chemicals which are presently used. We have found that it is far less expensive for the Government to pay the fees of the Cee-Bee Chemical Company for performing the stripping operation than it is to employ our own men and use one of the other methods of performing this task.

/s/ JAMES L. JACKSON.

Subscribed and sworn to before me this 25th day of March, 1957. [138]

[Seal] /s/ WALTER F. HANSEN.

Notary Public in and for the County of San Bernardino, State of California. My Commission Expires June 24, 1958. [138]

AFFIDAVIT OF CLAUD D. BLACK

State of California,
County of Los Angeles—ss.

Claud D. Black, of the aforesaid County and State, being first duly sworn, on oath deposes and says: that he is the President of Cee-Bee Chemical Co., Inc., defendant in the case of Delco Chemicals, Inc. v. Cee-Bee Chemical Co., Inc., No. 17,387-WM, in the United States District Court, for

the Southern District of California, Central Division; that on the 16th day of July, 1954, the said Cee-Bee Chemical Co., Inc., entered into a License Agreement with Turco Products, Inc.; that the annexed Exhibit 11 is a true copy of said License Agreement which was signed by representatives of said parties; that affiant is the person who signed for the said Cee-Bee Chemical Co., Inc.

Further affiant sayeth not.

/s/ CLAUD D. BLACK.

Subscribed and sworn to before me this 1st day of April, 1957.

[Seal] /s/ W. W. DUFRESNE,
Notary Public in and for said County and State.
My Commission Expires May 6, 1960. [139]

EXHIBIT No. 11

LICENSE AGREEMENT

This Agreement made and entered into this 16th day of July, 1954, by and between Cee-Bee Chemical Co., Inc., a California corporation, having its principal place of business in the County of Los Angeles, State of California, hereinafter called Licensor, and Turco Products, Inc., a California corporation, having its principal place of business in the County of Los Angeles, State of California, hereinafter called Licensee.

Witnesseth, That

Whereas, Licensor warrants that it owns and

Exhibit No. 11—(Continued)

controls United States letters patent No. 2,653,116, and has the right to grant this license, and

Whereas, Licensee is desirous of acquiring and Licensor is desirous of granting the license rights hereinafter set forth under said patent.

Now, Therefore, in consideration of the premises and the mutual covenants of the parties herein contained, the parties have agreed and do hereby agree as follows:

1. Licensor grants unto Licensee a license in the United States and throughout the world, to use the methods of said patent and to make and vend apparatus and solvents for use in accordance with said methods. [140]

2. Licensee agrees to pay to Licensor as royalty the total sum of \$2,000 per year commencing on even date herewith, and receipt of the first year's said royalty is hereby acknowledged by Licensor. Future said royalties shall be due and payable on or before the first day of August of each year.

3. It is agreed that this license is exclusive excepting only that Licensor reserves a like right in the United States throughout the world to use the methods of said patent and to make and vend apparatus and solvents for use in accordance with said methods.

4. Licensor hereby waives and releases and acknowledges full satisfaction and settlement of any and all claims for past infringement upon said pat-

Exhibit No. 11—(Continued)

ent which Licensor may have against Licensee for infringement of said patent or against any customer of Licensee for past use of apparatus vended by Licensee for using solvents in the cleaning of airplane fuel tanks.

5. Licensee hereby waives, releases and acknowledges full satisfaction and settlement of any and all claims which it may have against Licensor for past alleged acts of unfair competition.

6. If Licensee shall default in payment of royalty hereunder when due Licensor may cancel and terminate this license by giving to Licensee written notice thereof provided, however, that if Licensee shall cure said default within 30 days after receipt of said written notice, this license shall remain in full force and effect.

7. At any time after ten (10) years from date hereof, Licensee may cancel and terminate this license agreement by giving to Licensor sixty (60) days written notice of its election so to do. However, if said patent shall at any time be declared invalid by a final judgment of a Court of competent jurisdiction this license agreement shall, at the option of Licensee, become ipso facto terminated.

8. If any third party or parties shall infringe said letters patent and Licensor shall fail to institute suit against said infringer or infringers for said infringement within sixty (60) days after Licensee shall notify Licensor thereof in writing, Licensee shall then have the right to sue said in-

Exhibit No. 11—(Continued)

fringer or infringers and join Licensor as party plaintiff in such suit, provided Licensee shall pay all costs and attorneys fees incurred or awarded by the Court in said suit and shall receive any recoveries therein.

9. Unless sooner terminated as hereinabove specifically set forth, this agreement and license shall endure and bind and benefit the parties hereto, their successors and assigns until said letters patent shall expire.

10. It is mutually agreed that the parties shall, through their respective attorneys, concurrently with the execution hereof, sign and promptly file a stipulation for a Court order dismissing, without prejudice and without costs, the complaint and counterclaim in that certain action now pending in the United States District Court for the Southern District of California, Central Division, No. 16,-103-C, entitled Turco Products, Inc., Plaintiff-Counterdefendant vs. Cee-Bee Chemical Co., Inc., Defendant-Counterclaimant.

In Witness Whereof the parties have executed this license agreement on the day and year first hereinabove written.

CEE-BEE CHEMICAL CO., INC.,
By C. D. BLACK,
Licensor.

TURCO PRODUCTS, INC.,
By DALE M. LeVASSEUR,
Licensee.

Duly Verified.

AFFIDAVIT OF VESTA M. NELSON

State of California,

County of Los Angeles—ss.

Vesta M. Nelson, of the aforesaid County and State, being first duly sworn, on oath deposes and says: that she is employed by C. G. Stratton, Patent Lawyer, of Los Angeles, California; that on the morning of the 1st day of March, 1957, she looked in the Central telephone directory of the city of Los Angeles for the telephone number of Oakite Products, Inc., and found the number to be MAdison 5-1544; that she then called that number by dialing it in the usual and customary manner and the operator at the other end answered, stating it was Oakite Products; that affiant then asked to speak to Mr. George H. Boeck and the operator informed affiant that Mr. Boeck was not in the office but that he could be reached by calling the number "TEexas 0-2039", whereupon affiant called TEexas 0-2039 in the usual and customary manner by dialing it on the telephone and an individual answered said number and, upon inquiry, identified himself as George H. Boeck, the person of that name who made an affidavit designated "Exhibit H" and attached to Plaintiff's Motion for Summary Judgment in the action of Delco Chemicals, Inc. v. Cee-Bee Chemical Co., Inc., No. 17-387-WM, in the United States District Court, for the Southern District of California, Central Division; that the said C. G. Stratton then talked to the said George H. Boeck, hereinafter referred to as Mr.

Boeck, and, at the outset, explained to Mr. Boeck that affiant was sitting in on said conversation, which affiant did.

That in the course of said conversation, Mr. Boeck stated that his duties as an employee of the said Oakite Products, Inc. caused him to be in the field; that he did not work in the offices of said company. That as a field man, he had no personal knowledge of what the said Oakite Products, Inc. sent out to its [141] different field men, except what he personally received from the company by mail. That he was not present when any copies of Exhibits G, H, K, L or M, attached to said Motion for Summary Judgment, were mailed out or distributed by said Oakite Products, Inc.; that he only knows what he himself received by mail.

That he was not present when the drawings, Exhibits K, L and M, or the typewritten pages, Exhibits G and H, were produced, and he does not know of his own knowledge how many of same were produced. That the said Mr. Boeck was not present when any of the other representatives of said company purportedly gave out copies thereof, and does not have any personal knowledge as to what was given out by said other representatives, or to whom.

That Exhibit M bears the statement, "Redrawn 1/9/48," and Mr. Boeck stated that he did not have the slightest idea what part of 1948 they were produced, and did not know what part of that year he gave out the first copy of same.

That down to 1956, the said Mr. Boeck had only given to customers or prospective customers about

ten to fifteen of the Exhibits G, H, K, L, and with few exceptions, they had been given to customers or prospective customers in Los Angeles County, California.

That the said Mr. Boeck stated he had only given out a half dozen copies of Exhibit M down to 1953, and that Exhibits G and H were never given out by him except when they were attached to the drawings K, L or M, so no more copies of G and H were given out than said drawings. That he had only given out Exhibits G, H, K, L or M to customers or prospective customers of Oakite Products, Inc., with whom he had gone over the whole thing personally, because they were too highly involved for general distribution. That said exhibits were kept by him for his own customers and his own prospective customers.

That Exhibits G, H, K, L and M were only given by Mr. [142] Boeck to his customers and prospective customers to guide them in maintaining the efficient use of equipment which they had purchased from or were believed to be in the market to purchase from Oakite Products, Inc.

That both Mr. Boeck and Oakite Products, Inc. restrict the use of copies of said exhibits by the parties hereto, to use thereof in this action, and that they were not produced in this action for the general use thereof by the plaintiff or defendant, who are competitors of the said Oakite Products, Inc. That the latter company spent years developing the subject matter of these drawings, Exhibits K, L and M, and these typewritten pages, Exhibits

G and H, and that they have not been disclosed to the parties hereto for their use or distribution by them in the industry, for Oakite Products, Inc. does not want to encourage competition.

/s/ VESTA M. NELSON.

Subscribed and sworn to before me this 1st day of April, 1957.

[Seal] /s/ ESTHER DONNELLAN,
Notary Public in and for said County and State.
My Commission Expires July 8, 1958.

Copyright Office of the United States of America,
The Library of Congress, Washington.

This Is to Certify that a careful search in the General Indexes and Copyright Office Card Catalog covering the period from 1938 through January 2, 1957 under the names Oakite Products, Inc., Gene Get and the titles Oakite Interior Tank Cleaning Unit Model 324, Two Tank Installation Drawing D-463-S1, Oakite Interior Tank Cleaning Unit Model 324, Four Tank Installation Drawing No. D 463-S2, Oakite Inside Drum Cleaning Equipment Drawing No. C-222, 1947; failed to disclose any separate registrations for works identified under these names and these specific titles.

In Witness Whereof, the seal of this Office has been affixed hereto this thirteenth day of March 1957.

[Seal] ARTHUR FISHER,

Register of Copyrights,

/s/ By WILLIAM P. SIEGFRIED,
Assistant Register of Copy-
rights. [144]

In the United States District Court, Southern
District of California, Central Division

No. 15,820-WM

CLARENCE P. TAYLOR, Plaintiff,

vs.

KEUFFEL and ESSER COMPANY OF NEW
YORK, a corporation, et al., Defendants.

REPORTER'S TRANSCRIPT OF
PROCEEDINGS

Los Angeles, California
Monday, September 13, 1954

Honorable William C. Mathes, Judge Presiding.

Appearances: For the Plaintiff: C. G. Stratton,
Esq. and Louis M. Welsh, Esq., 210 West 7th
Street, Los Angeles 14, California. For the Defend-
ants: Harris, Kiech, Foster & Harris, by Warren
L. Kern, Esq., 417 South Hill Street, Los Angeles
13, California. [146]

Monday, September 13, 1954; 11:05 a.m.

(Other court matters.)

Mr. Welsh: Your Honor, may I have permission
to address the court? I would like to inform the
court that Mr. Kern is here. That is in the case that
is No. 81½ on your civil calendar, sir.

The Court: I take it that means Case No. 15,820,
Taylor against Keuffel and others.

Mr. Kern: Yes, your Honor.

The Court: Is there anything to be said in oppo-

sition to this motion that isn't said in the memorandum, Mr. Kern?

Mr. Kern: Well, actually, of course, this started with a motion to strike a jury demand, and they made a motion to amend——

The Court: They both mean the same, you know.

Mr. Kern: Yes. I think the sole question for the court to determine is whether it should exercise its discretion to order a jury trial in this type of case. The court has wide discretion in the matter.

The Court: I am favorably disposed to grant a jury trial to anyone who wants a trial by jury, even in a patent case. Some day the courts will have to make up their minds whether invention is a question of fact or a question of law.

You can probably submit that issue to the court in advance of the trial, if you like, upon motion for summary [147] judgment, if you feel so advised.

Mr. Kern: I feel that it is a little difficult to make my argument here because, in effect, it may sound as if I am arguing against the jury system, which I am not against at all. But I have been involved in more than one patent jury case, and I can suggest to your Honor that these cases are not of the type that are peculiarly suitable for the jury.

The Court: I will tell you, Mr. Kern, that I agree wholeheartedly with the remarks of Judge Learned Hand with respect to the elusiveness of the non-existent standard for the determination of what is invention.

Now, I daresay that most juries know just about as much about it as most judges.

Mr. Kern: Well, your Honor, I think that most laymen don't even know that a patent can be declared invalid by the courts, and a jury sits there and sees this document with the beautiful seal and the ribbon and most of them aren't aware that there could be any question of that.

The Court: The court of appeals will set it aside, usually set it aside when I declare them invalid, so it's just as well.

Mr. Kern: But, your Honor, there is so much work.

The Court: I never get over the case where the Schick Razor Company, one of the leaders of the industry, offered [148] Jones \$50,000 for his patent. Your office was in that case.

Mr. Kern: That's correct. I was here at the time.

The Court: Here is a leader of the industry who presumably knows all the prior art and offers \$50,000 for this thing and he turns it down. I thought that that was pretty good evidence that he might have something. But the Court of Appeals—I don't know whether they knew better—said it wasn't anything at all and Schick didn't know what he was talking about when he offered this man \$50,000; it wasn't worth a penny, not an invention at all. And then the Supreme Court says, too—well, it takes 13 guesses to determine whether or not a patent is any good—one from the district judge, three from the Court of Appeals and nine from the Supreme Court. And with all due deference, as far as I am concerned, I think 13 people sitting over

there in the box know just about as much about it as I do.

If you want me to decide, bring it up on a motion for summary judgment, give me all the prior art and give me the file, your accused device, and present it all in a motion for summary judgment and I'll take my guess at it in advance of the jury, if you wish to present it that way.

Mr. Kern: Most of the judges here don't feel that they can decide these patent cases on a question of validity on a motion for summary judgment, unless it is very obvious from the prior art to be clear-cut. [149]

It seems to me that your Honor's feeling on the matter is very logical, but I have made several motions for summary judgment in patent cases, and in one or two cases the prior art was very clear and in my opinion I didn't feel there could possibly be any question of a patent being upheld if it ever got to the Court of Appeals.

The Court: I am very fresh on this. I just spent Saturday and Sunday working on a case involving four patents. So I am ready to entertain a motion for summary judgment on the issue of validity in any patent case. After thousands of pages and testimony and hundreds of pages of argument, it would have been just as clear to me if you had just handed me the book with the prior art, the accused device and a copy of the patent and let me study it.

Mr. Kern: I certainly agree with your Honor because we do dispose of a lot of these patent cases a lot more easily that way.

Would your Honor, on such a motion then, consider deposition testimony and read it? Because this invalidity is largely a matter of alleged anticipation by virtue of prior uses, which are set up in depositions.

The Court: Of course, if you get into an issue of fact then it is another problem. If you say there was a prior use and the plaintiff denies it, then you have a genuine issue of fact and a summary judgment would not lie. [150]

I am referring to the question of just anticipation from prior art.

Mr. Kern: If we have prior use testimony by deposition, we are going to have to read that to the jury.

The Court: But if it's disputed the issue will have to be tried. If the prior use is admitted, why, of course, that's another matter.

I will grant the motion for plaintiff to serve and file an amended complaint, and deny the motion to strike the jury demand.

The plaintiff will prepare and settle under Local Rule No. 7 within five days the formal order embodying these rulings.

Mr. Welsh: And I would like, if I may, your Honor, to file a motion to produce documents, which has been served upon counsel.

The Court: You may.

(Other court matters.) [151]

Certificate of Reporter Attached. [152]

[Endorsed]: Filed April 2, 1957.

[Title of District Court and Cause.]

MEMORANDUM OF DECISION

Appearances: Messrs. Fulwider, Mattingly & Huntley, Robert W. Fulwider, Walter P. Huntley, John M. Lee, 5225 Wilshire Boulevard, Los Angeles 36, California, and John A. Weyl, 6331 Hollywood Boulevard, Hollywood 28, California, Attorneys for Plaintiff. Messrs. Carlos G. Stratton and Louis M. Welsh, 210 West Seventh Street, Los Angeles 14, California, Attorneys for Defendant. [153]

Mathes, District Judge:

Plaintiff brought this action for a declaration of invalidity and non-infringement as to United States Letters Patent No. 2,653,116. [28 U.S.C. §§ 1338(a), 2201.] Defendant answered with a counterclaim for damages for alleged infringement. Plaintiff now moves for a summary judgment declaring the patent invalid. [Fed. R. Civ. P., Rule 56.]

The motion is based upon the pleadings, various affidavits, a copy of the patent in suit, the "file wrapper", and copies of various prior-art patents. Affidavits have been filed in opposition to the motion.

There is no issue of fact, "genuine" or otherwise, as to the contents of the patent in suit, the contents of the file-wrapper record of Patent Office proceedings leading to the issuance thereof, or the contents of the various prior-art patents.

The patent in suit—Letters Patent No. 2,653,116, covering a "Method of Removing Sealant from

Fuel Tanks”—issued September 22, 1953, upon an application filed March 16, 1949 for a patent on both “Method and Apparatus for Removing Sealant from Fuel Tanks.” The file wrapper discloses that the first action of the Patent Office was to declare that “The method and the apparatus are distinct, each from the other * * * [154] and all claims are rejected on the ground of misjoinder.”

Next, claims limited to the method were rejected as unpatentable over the prior art cited. Further method claims were then filed, then amended, then rewritten; personal interviews with the examiner were had; associate counsel appeared; and at length, the Patent Office examiner allowed the eight claims appearing in the letters as issued.

Interestingly enough, the specifications and drawings of patent No. 2,653,116, issued for the “method” alone, are the same as those in the original application for both “method and apparatus.” Indeed, the opening words of the specifications in the letters issued for the method alone are: “This invention relates to a method and apparatus for removing the sealant that lines the interiors of integral fuel tanks, particularly of aircraft.” [Patent 2,653,116, col. 1, ll. 1-5.]

In the language of the defendant’s brief in opposition to the motion for summary judgment, the patented process is a “three-way method, including, first, spraying a volatile solvent against the sealant in an aircraft tank; secondly, spraying the solvent with a ‘water-rinsable, solvent-miscible’ material; and thirdly, applying a water spray of a higher

pressure. The second and third sprays may be applied successively or simultaneously." [155]

Thus, defendant's fuel-tank cleaning process can be envisioned as embracing either two or three steps, depending on whether the water rinsing accompanies or follows the "water-rinsable, solvent-miscible" spray.

Plaintiff's motion for summary declaration of invalidity is made upon the grounds that: "The method claimed by the patent in suit is fully and clearly anticipated by prior art which was not cited or considered by the Commissioner of Patents while the application for the patent was pending * * * The method claimed by the patent in suit is devoid of patentable novelty * * * There does not exist any genuine issue as to material facts necessary to consideration and determination of this motion, since invalidity of the patent in suit is clearly apparent from a comparison of said patent in suit with said prior art which was not considered by the Patent Office but * * * is before the Court in this motion."

It is often declared generally that validity of a patent is a question of fact. [United States v. Esnault-Pelterie, 299 U.S. 201, 205 (1936); *Faulkner v. Gibbs*, 170 F. 2d 34, 37 (9th Cir. 1948), *aff'd per curiam* 338 U.S. 267 (1949).] But the broad question of validity may encompass a variety of issues, both factual and legal. [35 U.S.C. § 102.]

Whether a method or "process" upon which letters patent have issued is "new and useful", and

whether first “invented or discovered” by the patentee, are questions of fact. [35 U.S.C. §§ 100, 101; *Oriental Foods v. Chun King Sales*, 244 F. 2d 909, 913-914 (9th Cir. 1957); *Hall v. Wright*, 240 F. 2d 787, 790 (9th Cir. 1957); *Hansen v. Safeway Stores, Inc.*, 238 F. 2d 336, 339 (9th Cir. 1956).]

In the case at bar, the specific question whether “the invention was patented * * * in this country, more than one year prior to the date of the application for patent in the United States * * *” [35 U.S.C. § 102(b)] is one of fact.

The burden of proof necessary to establish invalidity for anticipation, or for other want of invention, rests of course upon the party asserting it. [*Marconi Wireless Tel. Co. v. United States*, 320 U. S. 1, 34 (1943); *Smith v. Hall*, 301 U.S. 216, 222, 232-233 (1937); *Radio Corp. of America v. Radio Eng. Lab.*, 293 U.S. 1, 7-8 (1934); *Eibel Process Co. v. Minnesota & Ontario Paper Co.*, 261 U.S. 45, 60 (1923); *The Barbed Wire Patent*, 143 U.S. 275, 284-285 (1892); *Schmeiser v. Thomasian*, 227 F. 2d 875, 876 (9th Cir. 1955); *Whiteman v. Matthews*, 216 F. 2d 712, 716 (9th Cir. 1954).]

But, as the Court said in *Bates v. Coe*, 98 U.S. 31 (1878), “the patent offered in evidence * * * will be held [157] to be prior, if it is of prior date to the patent in suit, unless the patent in suit is accompanied by the application for the same, or unless the complainant introduces parol proof to show that his invention was actually made prior to the date of the [earlier] patent, or prior to the time the

[earlier] application was filed.” [98 U.S. at p. 33; See *Alexander Milburn Co. v. Davis-Bournonville Co.*, 270 U.S. 390, 399-400 (1926).]

Questions as to validity, such as anticipation or other want of invention, as a rule present “genuine” issues of fact which must be litigated and adjudicated by plenary trial so long as the presumption of validity is available to the defender of the patent. [See: *Radio Corp. of America v. Radio Eng. Lab.*, supra, 293 U.S. at 9; *Hycon Mfg. Co. v. H. Koch & Sons*, 219 F. 2d 353, 356 (9th Cir.), cert. denied, 349 U.S. 953 (1955).] For, although disputable, the presumption of validity cannot be dispelled without an evaluation of the evidence to the contrary. Such an evaluation necessitates the consideration or weighing of all opposing evidence, the drawing of inferences, and the choice of opposing inferences; usually this can be done only after a plenary trial. [See: *Sartor v. Arkansas Natural Gas Corp.*, 321 U.S. 620, 628 (1944); *Hansen v. Safeway Stores, Inc.*, supra, 238 F. 2d at 340; *Hycon Mfg. Co. v. H. Koch & Sons*, supra, 219 F. 2d 353; cf: *Great [158] Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 153-154 (1950); *Muench-Kreuzer Candle Co., Inc. v. Wilson*, 246 F. 2d 624 (9th Cir.), cert. denied, 26 U.S. L. Week 3164, 3166 (U.S. Nov. 25, 1957); *Oriental Foods v. Chun King Sales*, supra, 244 F. 2d at 913; *Kwikset Locks, Inc. v. Hillgren*, 210 F. 2d 483, 486 (9th Cir.), cert. denied, 347 U. S. 989, 348 U.S. 855 (1954).]

Since there is no rational basis upon which to

rest it, the presumption of validity cannot extend beyond the scope of the administrative record—the file wrapper of the patent as issued. So the presumption that a patent is valid, as embodying an invention over the prior art, does not subsist as to pertinent prior art not cited or considered by the Patent Office in passing on the application for the patent. [*Jacuzzi Bros., Inc. v. Berkeley Pump Co.*, 191 F. 2d 632, 634 & n.4, 637 (9th Cir. 1951); *Gomez v. Granat Bros.*, 177 F. 2d 266, 268 (9th Cir. 1949), cert. denied, 338 U.S. 937 (1950); *Mettler v. Peabody Engineering Corp.*, 77 F. 2d 56, 58 (9th Cir. 1935); and see *Syracuse v. Paris*, 234 F. 2d 65 (9th Cir. 1956); see, also: *Fritz W. Glitsch & Sons, Inc. v. Wyatt Metal & Boiler Works*, 224 F. 2d 331, 335 (5th Cir. 1955); *Royal Patent Corp. v. Monarch Tool & Mfg. Co.*, 203 F. 2d 299, 300 (6th Cir. 1953); *O’Leary v. [159] Liggett Drug Co.*, 150 F. 2d 656, 664 (6th Cir.), cert. denied, 326 U.S. 773 (1945); *Himmel Bros. Co. v. Serrick Corp.*, 122 F. 2d 740, 745 (7th Cir. 1941); *Nordell v. International Filter Co.*, 119 F. 2d 948, 950 (7th Cir. 1941); *National Elec. Products Corp. v. Grossman*, 70 F. 2d 257, 258 (2d Cir. 1934); *R. Hoe & Co. v. Goss Printing Press Co.*, 30 F. 2d 271, 274 (2d Cir. 1929); *American Soda Fountain Co. v. Sample*, 130 Fed. 145, 149-150 (3rd Cir.), cert. denied, 195 U.S. 634 (1904).]

Such uncited prior art is as if unknown to the Commissioner and, being unknown, could not possibly have influenced his administrative finding of invention. [*Himmel Bros. Co. v. Serrick Corp.*,

supra, 122 F. 2d at 745; Nordell v. International Filter Co., supra, 119 F. 2d at 950.]

One has only to examine the admitted copy of the letters, and of the file wrapper of the patent in suit, to learn there can be no issue of fact, "genuine" or otherwise, that the following pertinent prior-art patents were not cited or considered in connection with the application for the patent at bar:

No. 2,018,757 issued 1935 to Butterworth for "Apparatus for Cleaning Tanks"; [160]

No. 2,045,752 issued 1936 to Butterworth for "Method for Freeing a Container of Asphaltic and Oil Materials";

No. 1,666,015 issued 1928 to Land for "Tank Cleaning Apparatus";

No. 1,730,658 issued 1929 to Jensen for "Can Washing Apparatus";

No. 2,065,462 issued 1936 to Olsson for "Oil Tank Cleaning Apparatus";

No. 1,701,824 issued 1929 to Robinson for "Process and Apparatus for Cleaning Radiators"; and

No. 2,245,554 issued 1941 to Court for Method of "Hydraulic Disruption of Solids."

It will be noted that the "apparatus" patents also describe the claimed inventor's recommended "method" of making use of the cleaning device. In the fuel-tank cleaning art, and analogous arts, the essential steps of the method or process are easily understood from a reading of the claims of the patent in conjunction with the specifications and drawings. [See 35 U.S.C. §§ 111, 112, 113.]

And it is settled that where "it appears that no

substantial dispute of fact is presented, and that the case may be determined by a mere comparison of * * * [processes] and extrinsic evidence is not needed for purposes of explanation, or evaluation of prior art, or to resolve questions of the application of descriptions to subject matter, the questions [161] of invention and infringement may be determined as questions of law." [United States v. Esnault-Pelterie, 303 U.S. 26, 30 (1938); see: Sanitary Refrigerator Co. v. Winters, 280 U.S. 30, 36 (1929); Singer Mfg. Co. v. Cramer, 192 U.S. 265, 275 (1904); Black-Diamond Coal Mining Co. v. Excelsior Coal Co., 156 U.S. 611, 618 (1895); Market St. Cable Ry. v. Rowley, 155 U.S. 621, 625 (1895); Heald v. Rice, 104 U.S. 737, 749 (1881).]

Defendant admits that the above-listed patents were not cited or considered by the Patent Office in passing on the application for the patent in suit. However, defendant denies that the non-cited patents anticipate the claimed invention of the fuel-tank cleaning method described in the patent in suit. As to the non-cited Butterworth patent No. 2,018,757, defendant questions whether any "screen" means is shown "for collecting material dispersed by the solvent and yet permitting drainage there-through of the solvent for re-circulation * * *"[See patent 2,653,116, col. 3, ll. 45-50.]

The specifications in non-cited Butterworth patent No. 2,018,757 describe: "A line 36 connects basin 35 with chamber 24 to introduce the oil contaminated wash water into the chamber. A weir 38 is provided in basin 35 in position to prevent the

passage of scale or other solid material into line 36.” [162] [Butterworth patent 2,018,757, p. 2, col. 2, ll. 25-35.]

Defendant argues that “a weir is in the nature of a dam”; that “Material flows over the top of a weir and not ‘through’ it.” But this is not the teaching of non-cited Butterworth patent No. 2,018,757, as clearly appears from an examination of the drawing of the “weir”, 38 of Fig 2, in the light of the above-quoted specifications.

Moreover, as the examiner observed upon rejecting certain claims during the course of the proceedings in the Patent Office: “A pump drain for the tank is considered the full patentable equivalent of applicant’s gravitational drain, and the separation by settling is considered the full patentable equivalent of * * * screens. Both * * * are considered well within the purview of one skilled in the art, and hence devoid of invention.” [File wrapper pp. 37, 41.]

It is true of course that “a process patent can only be anticipated by a similar process.” [Carnegie Steel Co. v. Cambria Iron Co., 185 U.S. 403, 424-425 (1902).]

It is also true that in a process or method patent, the important thing is a method of procedure, not the particular means by which the method shall be practiced. [Expanded Metal Co. v. Bradford. 214 U.S. 366, 384 (1909); see: Dow Chemical Co. v. Halliburton Oil Well Cementing Co., [163] 324 U.S. 320, 329 (1945); International Steel Wool Corp. v. Williams Co., 137 F. 2d 342, 346 (6th Cir.

1943); *Slayter & Co. v. Stebbins-Anderson Co., Inc.*, 117 F. 2d 848, 851 (4th Cir. 1941).] "The test of the identity of processes is not the apparatus used for carrying them out but whether they involve identical or equivalent steps." [*Celite Corp. v. Dicalite Co.*, 96 F. 2d 242, 248 (9th Cir.), cert. denied, 305 U.S. 633 (1938); see: *Kemart Corp. v. Printing Arts Research Laboratories, Inc.*, 201 F. 2d 624, 629 (9th Cir. 1953); *Craftint Mfg. Co. v. Baker*, 94 F. 2d 369, 373 (9th Cir. 1938).]

So in determining whether a patented method was anticipated by the prior art, it is immaterial that the apparatus employed in the earlier use was neither as skillfully designed or used, nor as efficient in operation or results as that later devised by the patentee. [*Smith v. Hall*, *supra*, 301 U.S. at 216, n. 8, 232.]

Moreover, as pointed out in *Welsh Mfg. Co. v. Sunware Products Co.*, 236 F. 2d 225 (2d Cir. 1956): "It is proper for the Court to take judicial notice of matters of general knowledge which indicate that a * * * [method] is not new." [236 F. 2d at 226; *Slawson v. Grand St. R. R.*, 107 U.S. 649, 654 (1882).] [164]

It would serve no useful purpose to labor here the detail of a comparison of the essential steps embraced by the cleaning methods disclosed in the prior-art patents involved here, both cited and uncited. Plainly, the patents not cited by the examiner are decidedly more pertinent to the precise art of the claimed invention than those which were cited.

One reads the file wrapper and wonders upon what possible ground the letters in suit issued, even over the prior art cited.

In the language of the Court of Appeals for the Ninth Circuit in *Mettler v. Peabody Eng. Corp.*, supra, 77 F. 2d 56: "The presumption of validity which attends the issuance of letters patent by the patent office is overcome in this case by the clear [undisputed] evidence of anticipation in the prior art which was not cited or considered by the Patent Office when the application for * * * [the] patent was passed on." [77 F. 2d at 58.]

Being anticipated by prior-art patents which were not cited or considered by the patent office in passing on the application for the patent in suit, Letters Patent No. 2,653,116 are invalid; and no fact finder could, within the bounds of reasonableness, find validity here. [See: *Muench-Kreuzer Candle Co., Inc. v. Wilson*, supra, 246 F. 2d [165] 624; *Oriental Foods v. Chun King Sales*, supra, 244 F. 2d 909; *Kwikset Locks, Inc. v. Hillgren*, supra, 210 F. 2d 483; cf. *Syracuse v. Paris*, supra, 234 F. 2d 65.]

Even if it be said that there appears no "strict anticipation" of the patent in suit, and that the method involves some novelty, it nonetheless lacks invention. As Judge Fee stated for the Court in *Stauffer v. Slenderella Systems of California, Inc.*, F. 2d (9th Cir. Nov. 15, 1957): "The advances in the prior art may be such that, although there is no strict anticipation and even though the * * * [methods] involved may not be similar, a trained

mechanic would, if presented with the problem, solve it without difficulty.”

The statute provides that: “A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” [35 U.S.C. § 103.]

Where, as here, use of a cleaning process or method is common to many fields, “its application to a new field ordinarily involves no more than ordinary mechanical skill.” [166] [*Welsh Mfg. Co. v. Sunware Products Co.*, *supra*, 236 F. 2d at 226; *Concrete Appliances Co. v. Gomery*, 269 U. S. 177, 185 (1925); *Vandeburgh v. Truscon Steel Co.*, 261 U. S. 6, 15 (1923); *Lovell Mfg. Co. v. Cary*, 147 U. S. 623, 633-634 (1893).]

Nor is invention ordinarily involved “even though changes or modifications are essential to the practical application of the method * * * to the new use * * *” [*International Steel Wool Corp. v. Williams Co.*, *supra*, 137 F. 2d at 346; cf: Reviser’s note to 35 U.S.C. § 101 (1952); *Jungersen v. Ostby & Barton Co.*, 335 U.S. 560 (1949); *Mandel Bros., Inc. v. Wallace*, 335 U.S. 291 (1948); *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327 (1945); *Honolulu Oil Corp. v. Halliburton*, 306 U.S. 550 (1939).]

Clearly, no fact finder could reasonably conclude that patentable novelty subsists in the discovery that an old method used in cleaning railroad tank cars, ship tanks, drums, and radiators can be adapted to the cleaning of airplane fuel tanks.

Here, as in *Dow Chemical Co. v. Halliburton Oil Well Cementing Co.*, supra, 324 U.S. 320: "He who is merely the first to utilize the existing fund of public knowledge for new and obvious purposes must be satisfied with whatever fame, personal satisfaction or commercial success he may be able to [167] achieve. Patent monopolies, with all their significant economic and social consequences, are not reserved for those who contribute so insubstantially to that fund of public knowledge." [324 U.S. at 328.]

The most that can be said of the patent in suit is that the method claimed to constitute invention is but a mere aggregation of steps long known and employed in the fuel-tank cleaning art. It may well be that use of the patentee's method increases efficiency both in labor expended and results obtained. "But perfection of workmanship, however useful or convenient, does not constitute invention." [*Photochart v. Photo Patrol, Inc.*, 189 F. 2d 625, 628 (9th Cir.), cert. denied, 342 U.S. 867 (1951); see *Toledo Pressed Steel Co. v. Standard Parts, Inc.*, 307 U.S. 350, 356 (1939).]

The conjunction or concert of known steps in the fuel-tank cleaning process must contribute something; only when the whole in some way exceeds the sum of its parts is the accumulation of

old methods patentable. [Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp., *supra*, 340 U.S. at 152; and see: *Jungersen v. Ostby & Barton Co.*, *supra*, 335 U.S. at 566-567; *Muench-Kreuzer Candle Co. v. Wilson*, *supra*, 246 F. 2d 624; *Oriental Foods v. Chun King Sales*, [168] *supra*, 244 F. 2d at 913; *Schmeiser v. Thomasian*, *supra*, 227 F. 2d at 877; *Kwikset Locks, Inc. v. Hillgren*, *supra*, 210 F. 2d at 486-487.]

To paraphrase the language of *Market St. Cable Ry. v. Rowley*, *supra*, 155 U.S. at 625: If, upon the state of the art as shown to exist by the prior patents, and upon a comparison of the older processes with the method described in the patent in suit, it should appear that the patent claims are not novel, or that the claimed invention is anticipated by the prior art, it becomes the duty of the court to grant summary judgment on the issue of validity. [See *Vermont Structural Slate Co. v. Tatko Bros. Slate Co.*, 233 F. 2d 9 (2d Cir.), cert. denied, 352 U.S. 917 (1956); *Syracuse v. Paris*, *supra*, 234 F. 2d 65; *Bobertz v. General Motors Corp.*, 228 F. 2d 94, 99-100 (6th Cir. 1955), cert. denied, 352 U.S. 824 (1956); *Park-In Theaters, Inc. v. Perkins*, 190 F. 2d 137, 142 (9th Cir. 1951); *Davison Chemical Corp. v. Joliet Chemicals, Inc.*, 179 F. 2d 793 (7th Cir.), cert. denied, 340 U.S. 816 (1950); *Steigleder v. Eberhard Faber Pencil Co.*, 176 F. 2d 604 (1st Cir.), cert. denied, 338 U.S. 893 (1949); *Smith v. General Foundry Mach. Co.*, 174 F. 2d 147, 151 (4th Cir.), cert. denied, 338 U.S. 869 (1949); cf: *Leishman v. Radio Condenser Co.*,

167 F. 2d 890 (9th Cir.), cert. denied, 335 U.S. 891 (1948); *Stuart Oxygen Co. [169] v. Josephian*, 162 F. 2d 857, 859 (9th Cir. 1947).]

Here, it appears as a matter of law from undisputed facts disclosed by the letters and the file wrapper of patent 2,653,116, and the prior-art patents, both cited and non-cited, that the patent in suit is invalid because of "strict anticipation" [35 U.S.C. § 102(b)] or, in any event, for want of patentable novelty. [Id. § 103.]

As Judge Pope observed for the Court in *Leishman v. General Motors Corp.*, 191 F. 2d 522 (9th Cir. 1951), cert. denied, 342 U.S. 943 (1952): "Even if the disclosures of the prior art had fallen short of complete anticipation, yet invention may be negated by such disclosures." [191 F. 2d at 530.] So in the case at bar, even if the disclosures of the non-cited-prior-art patents be said to fall short of complete anticipation, they still serve upon the motion for summary judgment to negative invention, and thus to render invalid the patent in suit since, as has been shown, no presumption of validity can subsist as to the non-cited-prior-art patents.

This alone is sufficient to dispose of the case on the merits. For when, on a motion for summary judgment, "there is no genuine issue as to any material fact" involved in the adjudication of a single issue which is dispositive of [170] the case, "and * * * the moving party is entitled to a judgment as a matter of law" on that single issue, all other issues of fact raised by the parties, however

genuine—such as prior publication, infringement and the like—become as a matter of law immaterial. [See: *McComb v. Southern Weighing & Inspection Bureau*, 170 F. 2d 526, 530 (4th Cir. 1948); *Keehn v. Brady Transfer & Storage Co.*, 159 F. 2d 383, 385 (7th Cir.), cert. denied, 331 U.S. 844 (1947); cf: *Dolgoff v. Kaynar Co.*, 18 F.R.D. 424 (S.D. Cal. 1955).]

For the reasons stated, plaintiff's motion for summary judgment on the issue of validity of the patent in suit will be granted; and the attorneys for plaintiff may lodge with the Clerk within five days findings of fact, conclusions of law and judgment accordingly, to be settled pursuant to local rule 7. [171]

[Endorsed]: Filed December 11, 1957.

In The United States District Court, Southern
District of California, Central Division

Civil Action No. 17,387-WM

DELCO CHEMICALS, INC., a corporation,
Plaintiff,

vs.

CEE-BEE CHEMICAL CO., INC., a corporation;
et al., Defendants.

FINDINGS OF FACT, CONCLUSIONS OF LAW AND SUMMARY JUDGMENT

The motion of Plaintiff herein for summary judgment having been heard, the Court, being fully

advised and having filed its Memorandum of Decision on December 11, 1957, makes the following findings of fact and conclusions of law:

Findings of Fact

1. Plaintiff, Delco Chemicals, Inc., is a Delaware corporation having its principal place of business in the County of Los Angeles, State of California.

2. Defendant, Cee-Bee Chemical Co., Inc., is a California corporation having a regular and established place of business in the City of Los Angeles, County of Los Angeles, State of California, within the Southern District of California, Central Division. [172]

3. This Court has jurisdiction of the parties and of the subject matter of this action.

4. United States letters patent in suit No. 2,653,116 was issued by the Commissioner of Patents of the United States on September 23, 1953, to Defendant Cee-Bee Chemical Co., Inc., as assignee.

5. A bonafide dispute exists between Plaintiff Delco Chemicals, Inc., and Defendant Cee-Bee Chemical Co., Inc., as to the validity of United States Letters Patent in suit No. 2,653,116.

6. There is no genuine issue as to any material fact necessary to the consideration and determination of said motion for summary judgment.

7. United States Letters Patent in suit No. 2,653,116 relates to the cleaning of tanks, its stated object being to remove coatings of sealant material from airplane fuel tanks by the claimed method

or procedure of spraying a suitable solvent against the upper parts of the tank walls, allowing the sprayed solvent and any loosened sealant particles to drain out of the tank by gravity, screening the drained solvent to separate from it any sealant particles and then recirculating the screen solvent to the sprays, after which a water rinse is applied to the tank as is customary in cleaning operations.

8. The file wrapper of the patent in suit discloses that, during prosecution of the application for the patent in suit before the Commissioner of Patents, its subject matter was treated and considered by both the Commissioner of Patents and the applicants for the patent as being within and analogous to the general art of tank cleaning, it being an old practice to remove various sorts of coatings from tanks, such as tank cars and ship tanks, by continuously spraying a recirculated solvent against the tank walls while draining sprayed solvent from the tank along with removed coating particles.

9. The file wrapper of the patent in suit discloses that, of the prior patents cited by the Commissioner of Patents against the application for the patent in suit, the patent directed particularly to tank cleaning which was treated as being the most pertinent was Butterworth Re. 19,374, which discloses the cleaning of ship cargo tanks by continuously spraying solvent against the tank walls, allowing the sprayed solvent and any loosened coating particles to drain by gravity to the bottom of the tank from which point the solvent is picked up by a pump and returned to the sprays after being

passed through a settling tank to separate the particles from the solvent.

10. United States Letters Patent to Foster, No. 1,141,243, cited by the Patent Office against the application for the patent in suit, discloses that it is old to apply soapy or water-rinsable emulsifying solution to any surface being cleaned.

11. The patent in suit contains eight claims, of which Claim 5 reads as follows:

“The method of removing the sealant from within an aircraft integral fuel tank, which comprises impinging a spray of solvent against the sealant to remove same, washing free sealant from the tank by free solvent, screening out sealant from the solvent, [174] recirculating the latter as a spray against remaining sealant, and, when the sealant is substantially removed, applying rinse water to remove solvent and loosened sealant remaining in the tank.”

Claim 1 of the patent differs from Claim 5 in that it specifies that the tank is sealed while being cleaned, specifies that the tank is given a soapy spray before being rinsed and specifies that the rinse water is sprayed at a “higher pressure. Claim 2 of the patent in suit is substantially the same as Claim 1 except that it does not specify that the tank is sealed while being cleaned. Claim 3 of the patent in suit is substantially like Claim 2 except that it specifies that the solvent is sprayed at a pressure of 30 to 90 pounds, that the solvent is heated 60° to 120° F., and that the rinse water

is applied at approximately 300 pounds per square inch. Claim 4 of the patent in suit is substantially like Claim 5 except that it specifies that the solvent is sprayed against the bulkheads in the tank and omits reference to any rinsing operation. Claim 6 is substantially like Claim 5 except that it calls for rinsing at a higher pressure. Claim 7 of the patent in suit is substantially like Claim 6 except that it specifies that rinse water is applied at approximately 300 pounds per square inch. Claim 8 of the patent in suit is substantially the same as Claim 6 except that it omits reference to any rinsing operation. However, the specification of the patent in suit fails to attribute any unconventional or unexpected significance to sealing the tank while it is being cleaned, or to heating the solvent to any particular temperature, or to spraying the solvent or rinse water at any particular pressure, or to spraying the bulkheads of the tank, or to applying soap before rinsing and such details add nothing of patentable significance.

12. The Commissioner of Patents failed to cite against the application for the patent in suit the most pertinent prior art, [175] including the following prior United States patents:

| | |
|-------------------|-----------|
| Butterworth | 2,018,757 |
| Butterworth | 2,045,752 |
| Land | 1,666,015 |
| Jensen | 1,730,656 |
| Olsson | 2,065,462 |
| Robinson | 1,701,824 |
| Court | 2,245,554 |

which show the method of the patent in suit to be old, including the draining of the sprayed solvent from the tank and screening it before recirculating it.

13. Said prior Butterworth 2,018,757 discloses, in Fig. 3 of its drawing, the cleaning of railroad tank cars by continuously pumping heated solvent from a supply tank to sprays in the upper part of the tank car, allowing the sprayed solvent and all removed coating particles to drain by gravity over the lower parts of the walls and from the bottom of the tank car, from whence it is passed through a weir or screen back into the supply tank from which it is recirculated.

14. Said Land 1,666,015 discloses the cleaning of a tank car by spraying solvent into the upper part of the tank car, draining the sprayed solvent and any removed coating particles through the bottom of the tank, recirculating the drained solvent and applying a water rinse to the tank car. The tank is shown as being sealed while the solvent is being sprayed.

15. Said Butterworth 2,045,752 discloses the cleaning of a tank by spraying heated solvent into the tank, draining the sprayed solvent and any removed coating particles through the bottom of the tank, passing the drained solvent and its coating particles through a "settling tank or clarifier" and then recirculating it to the sprays. The patent also discloses giving the tank a steam bath, and shows the tank as being sealed. [176]

16. Said Olsson 2,065,462 discloses spraying the

solvent against the bulkheads of the tank being cleaned, as specified in Claim 4 of the patent in suit.

17. Said Jensen 1,730,658 discloses the cleaning of drums by spraying solvent from a supply tank into the inverted drums, draining the sprayed solvent and any removed coating back into the supply tank by gravity, and then recirculating the solvent to the sprays.

18. Said Robinson 1,701,824 shows the cleaning of radiators by forcing heated solvent from a supply tank through the radiator, and back into the supply tank through a screen, and then recirculating the screened solvent.

19. Said Court 2,245,554 discloses a method and apparatus for clearing coke deposits from the reaction chambers of petroleum cracking plants utilizing high-pressure water sprays directed against the walls of the chamber to dislodge the solid materials, the water and dislodged solid material draining gravitationally from the chamber into a separator which utilizes a screen and a settling basin to separate out solid materials, the water, after passing through the separator, being pumped to the spray heads in the chamber, the water thus being recirculated and all solid particles being removed.

20. Extrinsic evidence is not needed to explain or evaluate the aforesaid most pertinent prior art and its applicability to the subject matter of the patent in suit.

21. In the patent in suit, the various steps or procedures set forth as constituting the patented

method do not produce any result which they do not produce in the prior art, or any unexpected result, and do not produce, in their aggregation, any result greater than the sum of their separate results, or any result patentably different from the result which, in their aggregation, they produce in the prior art. [177]

22. There is no patentable novelty in the discovery that an old method used in cleaning railroad tank cars, ship tanks, drums and radiators, can be used to clean airplane fuel tanks.

23. The patent in suit and each of its claims are completely anticipated by the prior art.

24. The patent in suit and each of its claims are lacking in invention over the prior art.

25. The patent in suit and each of its claims are devoid of patentable novelty.

26. The "Memorandum of Decision" filed December 11, 1957 is hereby incorporated by reference herein.

Conclusions of Law

1. The patent in suit is owned by Defendant Cee-Bee Chemical Co., Inc.

2. Any presumption that the patent in suit is valid does not subsist as to the pertinent prior art which was not cited nor considered by the Patent Office.

3. There being no substantial dispute of fact as to the contents of the patent in suit, or the file wrapper, or the prior art patents, both cited and uncited; and no subsisting presumption of validity as to the pertinent prior art which was not cited

by the Patent Office; and extrinsic evidence not being required for the purposes of explanation, the questions of anticipation and want of invention, and hence of validity, are questions of law.

4. The patent in suit, and each of its claims, are invalid and void, for want of invention over the prior art.

5. Plaintiff is entitled to judgment declaring United States Letters Patent in suit No. 2,653,116 invalid and void, dismissing the counterclaim of Defendant, and for Plaintiff's taxable costs.

Judgment

In accordance with the foregoing Findings of Fact and Conclusions of Law, it is Ordered, Adjudged and Decreed:

1. Defendant Cee-Bee Chemical Co., Inc., is the owner of United States Letters Patent No. 2,653,116. [178]

2. United States Letters Patent in suit No. 2,653,116 and each of the claims thereof are invalid and void.

3. The counterclaim of defendant Cee-Bee Chemical Co., Inc., is hereby dismissed.

4. Plaintiff shall recover its taxable costs herein in the amount of \$169.25.

Dated at Los Angeles, California, this 27th day of December, 1957.

/s/ WM. C. MATHES,

United States District Judge.

Acknowledgment of Service Attached. [179]

[Endorsed]: Filed Dec. 27, 1957. Entered Dec. 30, 1957.

[Title of District Court and Cause.]

NOTICE OF APPEAL

Notice is hereby given that Cee-Bee Chemical Co., Inc., the defendant above-named, hereby appeals to the United States Court of Appeals for the Ninth Circuit from the Summary Judgment entered in this action on December 11, 1957.

Los Angeles 14, California.

C. G. STRATTON,
LOUIS M. WELSH,

/s/ By C. G. STRATTON,
Attorneys for Cee-Bee
Chemical Co., Inc. [180]

Affidavit of Service by Mail Attached. [181]

[Endorsed]: Filed Jan. 8, 1958.

[Title of District Court and Cause.]

DESIGNATION BY APPELLANT CEE-BEE CHEMICAL CO., INC., OF CONTENTS OF RECORD ON APPEAL [182]

Appellant Cee-Bee Chemical Co., Inc., designates the following portions of the record to be contained in the Record on Appeal in this action:

(1) Complaint for Declaratory Judgment of Patent Invalidity and Non-Infringement, Unfair Competition, and Damages and Injunctive Relief Under Sherman and Clayton Anti-Trust Laws.

(2) Amended Answer to Complaint and Counterclaim.

(3) Minute Order of December 13, 1954, granting Motion to Serve Amended Answer to Complaint and Counterclaim.

(4) Answer to Counterclaim of Defendant Cee-Bee Chemical Co., Inc.

(5) Stipulation and Order for Dismissal Without Prejudice of Plaintiff's Second and Third Causes of Action.

(6) Notice of Motion and Motion for Summary Judgment, page 1; page 2, lines 1 to 20, inclusive. Indicate that legal argument, page 2, lines 22 to 32, inclusive; and pages 3 and 4, omitted.

(7) Affidavit of George H. Boeck, dated [183] February 20, 1957.

(8) Exhibit "K" attached to said Boeck affidavit.

(9) Exhibit "L" attached to said Boeck affidavit.

(10) Exhibit "M" attached to said Boeck affidavit.

(11) Defendant's Notice re Plaintiff's Motion for Summary Judgment.

(12) Copyright Office Certificate dated March 13, 1957.

(13) Reporter's Transcript of Proceedings in this case, dated February 11, 1957.

(14) Reporter's Transcript of Proceedings of September 13, 1954 in the case of Clarence P. Taylor, plaintiff, vs. Keuffel & Esser Co., of N. Y., a corporation, et al., defendants, Civil No. 15,820 WM

in the United States District Court, Southern District of California, Central Division.

(15) Affidavit of Vesta M. Nelson, dated April 1, 1957.

(16) Affidavit of Claud D. Black, dated April 1, 1957.

(17) Exhibit 11 attached to said Black affidavit.

(18) Affidavit of James L. Jackson, dated March 25, 1957.

(19) Affidavit of William Douglas Sellers, dated March 11, 1957.

(20) Exhibits 9 and 10 attached to said Sellers affidavit.

(21) Affidavit of Keith R. Whitcomb, dated March 28, 1957.

(22) Affidavit of Edward W. Giddings, dated March 29, 1957 (without exhibits).

(23) Memorandum of Decision filed December 11, 1957.

(24) Findings of Fact, Conclusions of Law, and Summary Judgment, dated December 30, 1957.

(25) Notice of Appeal.

(26) Statement of Points on which appellant intends to rely on appeal, served herewith.

(27) This Designation.

(28) Soft copy of the patent in suit.

(29) The following parts of the file wrapper of the patent in suit: all correspondence between the Patent Office and the attorney for the applicant from July 12, 1950 to July 22, 1954, including all affidavits filed therein.

(30) Soft copies of the following patents cited

by the Examiner during the prosecution of the patent in suit through the Patent Office: [185]

| Name | Number | Issue Date |
|-------------------|------------|---------------|
| (a) Butterworth | Re. 19,374 | Nov. 21, 1934 |
| (b) Foster | 1,141,243 | June 1, 1915 |
| (c) Gray | 1,628,141 | May 10, 1927 |
| (d) Houpt | 1,892,950 | Jan. 3, 1933 |
| (e) McFadden | 2,092,321 | Sept. 7, 1937 |
| (f) Paulson et al | 2,123,434 | July 12, 1938 |
| (g) Jaffa | 2,442,272 | May 25, 1948 |
| (h) Brady | 2,458,333 | Jan. 4, 1949 |

(31) Soft copies of the following patents not cited by the Examiner during the prosecution of the patent in suit through the Patent Office:

| Name | Number | Issue Date |
|-----------------|-----------|---------------|
| (a) Butterworth | 2,018,757 | Oct. 29, 1935 |
| (b) Butterworth | 2,045,752 | June 30, 1936 |
| (c) Land | 1,666,015 | Apr. 10, 1928 |
| (d) Jensen | 1,730,658 | Oct. 8, 1929 |
| (e) Olsson | 2,065,462 | Dec. 22, 1936 |
| (f) Robinson | 1,701,824 | Feb. 12, 1929 |
| (g) Court | 2,245,554 | June 17, 1941 |

(32) The following portions of the deposition of Sydney G. Thornbury, taken March 7, 1957:

(a) Page 2, lines 1-3, inclusive; lines 13-24, inclusive;

(b) Page 3, lines 12-20, inclusive;

(c) Page 4, lines 4-8, inclusive; lines 12-18, inclusive; [186]

- (d) Page 5, line 5 to the period in line 17;
- (e) Page 6, lines 16-26, inclusive;
- (f) Page 7, lines 7-13, inclusive;
- (g) Page 7, line 17 to page 8, line 3 (to the period);
- (h) Page 8, line 10, starting with "It seemed to me" to the period in line 16;
- (i) Page 9, line 20 to page 10, line 12, inclusive;
- (j) Page 11, lines 6-15, inclusive; line 19 to the period in line 24;
- (k) Page 12, line 2, starting with "I have never" to line 4, inclusive;
- (l) Page 13, lines 6-13, inclusive; lines 17-19, inclusive;
- (m) Page 13, line 23 to the period in line 8, page 14;
- (n) Page 14, line 15 to page 15, line 20;
- (o) Page 16, lines 17-21, inclusive;
- (p) Page 22, line 26 to page 23, line 25;
- (q) Page 26, lines 10-15, inclusive;
- (r) Page 27, lines 3-4, inclusive; lines 9-11, inclusive; lines 16-20, inclusive; lines 24-26, inclusive;
- (s) Page 28, lines 1-22, inclusive;
- (t) Page 29, lines 3-12, inclusive;
- (u) Page 35, line 19 to page 36, line 11, inclusive.

(33) The following portions of the deposition of Robert C. Bear, taken September 12, 1955: [187]

- (a) Page 2, 8th line, to page 3, 17th line, inclusive;
- (b) Page 11, last line, to page 12, 7th line, inclusive;

- (c) Page 14, 8th to 14th lines, inclusive;
- (d) Page 15, first to 16th lines, inclusive;
- (e) Page 19, 12th to 23rd lines, inclusive;
- (f) Page 20, 10th to 25th lines, inclusive;
- (g) Page 21, 5th to 14th lines, inclusive;
- (h) Page 25, 20th line (commencing "Q. First, I shall ask you,"), to page 26, 19th line, inclusive;
- (i) Page 37, 13th line, to page 38, 10th line.

(34) The following portions of the deposition of Thomas H. Edgin, taken September 17, 1955:

- (a) Page 3, first to 18th lines, inclusive;
- (b) Page 11, next to last line, to page 12, 19th line, inclusive;
- (c) Page 13, 15th line, to page 14, 21st line, inclusive;
- (d) Page 15, 9th to 25th lines, inclusive;
- (e) Page 16, 20th line, to page 17, 11th line, inclusive;
- (f) Page 17, 23rd line, to page 18, 8th line, inclusive;
- (g) Page 18, 15th to 24th lines, inclusive (and including Defendants' Exhibit A therein identified);
- (h) Page 25, 5th to 20th lines, inclusive; [188]
- (i) Page 27, 10th to 22nd lines, inclusive.

(35) The following portions of the deposition of Charles R. Ursell, taken January 29, 1957:

- (a) Page 4, lines 1 to 25, inclusive;
- (b) Page 6, lines 9 to 15, inclusive;
- (c) Page 7, lines 14 to 18, inclusive;
- (d) Page 8, lines 1 to 5, inclusive;
- (e) Page 11, lines 8 to 12, inclusive;
- (f) Page 12, lines 20 to 24, inclusive;

- (g) Page 15, line 23, to page 16, line 2, inclusive;
- (h) Page 17, lines 2 to 8, inclusive;
- (i) Page 17, line 22, to page 18, line 1 inclusive;
- (j) Page 18, lines 5 to 10, inclusive;
- (k) Page 18, line 20, to page 19, line 2, inclusive;
- (l) Page 19, lines 6 to 10, inclusive;
- (m) Page 19, line 15, to page 20, line 2, inclusive;
- (n) Page 20, lines 11 to 19, inclusive;
- (o) Page 21, lines 2 to 11, inclusive;
- (p) Page 22, lines 6 to 12, inclusive;
- (q) Page 25, line 9, to page 26, line 13, inclusive;
- (r) Page 26, line 22, to page 27, line 5, inclusive;
- (s) Page 27, line 14, to page 28, line 3, inclusive.

Dated at Los Angeles, California, this 28th day of January, 1958.

/s/ C. G. STRATTON,

Of Counsel for Appellant. [189]

Affidavit of Service by Mail Attached. [190]

[Endorsed]: Filed Jan. 30, 1958.

[Title of District Court and Cause.]

STATEMENT BY APPELLANT CEE-BEE
CHEMICAL CO., INC. OF POINTS ON
APPEAL [191]

The points upon which appellant intends to rely on this appeal are as follows:

1.

The Court erred in not dismissing the plaintiff's complaint.

2.

The Court erred in not entering judgment in favor of defendant upon its counterclaim.

3.

The Court erred in granting plaintiff's Motion for Summary Judgment.

4.

The Court erred in entering judgment that the patent in suit, No. 2,653,116, is, and each of the claims thereof are, invalid and void.

5.

The Court erred in dismissing defendant's counterclaim.

6.

The Court erred in entering judgment for plaintiff's [192] taxable costs herein.

7.

The Court erred in finding that no genuine issue as to any material fact existed in connection with the determination of plaintiff's Motion for Summary Judgment.

8.

The Court erred in finding that a soapy solution and a water-rinsable, solvent-miscible material are equivalent.

9.

The Court erred in finding that claims 1 to 3, inclusive, of the patent in suit specify a "soapy spray" for a tank before being rinsed, and that "soap" was applied before rinsing.

10.

The Court erred in finding that the Commissioner of Patents failed to cite against the application for the patent in suit, the most pertinent prior art.

11.

The Court erred in finding that the prior art which the Commissioner of Patents failed to cite against [193] the application for the patent in suit shows the method of the patent in suit to be old.

12.

The Court erred in finding that in Fig. 3 of Butterworth 2,018,757 the material is passed "through" a weir "or screen."

13.

The Court erred in not applying said prior art specifically to the claims of the patent in suit.

14.

The Court erred in finding that Court patent 2,245,554 has any bearing upon the patent in suit.

15.

The Court erred in finding that extrinsic evidence is not needed to explain or evaluate the prior art

cited by the plaintiff-appellee in this case, and its applicability to the subject matter of the patent in suit.

16.

The Court erred in finding that the patent in suit (a) does not produce any result not found in the prior art; (b) does not produce any unexpected result; and (c) [194] does not produce any result greater or patentably different than the sum of the various steps or procedures of the prior art.

17.

The Court erred in finding that the patent in suit merely covered an old method of cleaning railroad tank cars, ship tanks, drums, or radiators.

18.

The Court erred in finding that the patent in suit, and each of its claims, is anticipated by the prior art, "completely" or otherwise.

19.

The Court erred in finding that the patent in suit, and each of its claims, lacks invention over the prior art, and is devoid of patentable novelty.

20.

The Court erred in concluding that there was no substantial dispute of fact as to any of the prior art patents.

21.

The Court erred in concluding that questions of [195] anticipation are questions of law.

22.

The Court erred in concluding that questions of want of invention are questions of law.

23.

The Court erred in concluding that questions of validity are questions of law.

24.

The Court erred in not holding that the depositions of Sydney G. Thornbury, Robert C. Baer, Thomas Edgin and C. R. Wisell raise issues of fact as to plaintiff-appellee's Motion for Summary Judgment.

25.

The Court erred in its interpretation of the file wrapper of the patent in suit.

26.

The Court erred in not holding that the prior art cited in paragraph 12 of the Findings herein is no closer than, if as close as, the prior art cited by the Examiner during the prosecution of the application for the present patent through the Patent Office.

27.

The Court erred in not holding that there is a presumption of validity of the patent in suit over said prior art because it is no closer than that cited by said Examiner.

28.

The Court erred in not holding that the prior art

fails to show the step in the present patented method of applying a water-rinsable, solvent-miscible material.

29.

The Court erred in deciding on a Motion for Summary Judgment a disputed question of fact in connection with the nature, construction and operation of the weir shown and described in Butterworth patent 2,018,757.

30.

The Court erred in holding that the weir of Butterworth patent 2,018,757 is the equivalent of a screen, in the face of the issue of fact raised by defendant-appellant, to wit, that the nature and speed of travel of the solvent-soaked sealant would cause it to pass over a weir but be caught by a screen. [197]

31.

The Court erred in taking "judicial notice of matters of general knowledge" without stating or showing what such matters were.

32.

The Court erred in holding that "no fact finder could, within the bounds of reasonableness, find validity" in the Letters Patent No. 2,653,116, in suit here.

33.

In apparently recognizing that there is "no 'strict anticipation' " of the patent in suit, and that there is "some novelty" in same, the Court erred in deciding on a Motion for Summary Judgment the dis-

puted question of fact of whether “a trained mechanic” would have solved the present problem “without difficulty” “at the time the invention was made.”

34.

The Court erred in holding that the present patented “cleaning process or method is common to many fields.”

35.

The Court erred in holding that the present patented method was “obvious” to one skilled in the art. [198]

36.

The Court erred in holding that the patented method “is but a mere aggregation of steps long known and employed in the fuel-tank cleaning art.”

37.

The Court erred in holding that all the steps of the patented method are “known steps.”

38.

The Court erred in not holding that the patent in suit covers an unobvious method that produces a new and useful result over the prior art cited.

C. G. STRATTON,
LOUIS M. WELSH,

/s/ By C. G. STRATTON,

Attorneys for Appellant Cee-
Bee Chemical Co., Inc. [199]

Affidavit of Service by Mail Attached. [200]

[Endorsed]: Filed Jan. 30, 1958.

[Title of District Court and Cause.]

COUNTER-DESIGNATION BY APPELLEE,
DELCO CHEMICALS, INC., OF ADDI-
TIONAL CONTENTS OF RECORD ON
APPEAL

Appellee, Delco Chemicals, Inc., under and pursuant to Rule 75(a) F.R.C.P., hereby designates the following additional portions of the record for inclusion in the record on appeal in this action.

1.

The affidavit of Walter P. Huntley, dated February 20, 1957, attached to Plaintiff's Motion for Summary Judgment, together with Exhibits B, E, F, G, H, I, and J, attached thereto, and including also the annexed affidavit of John M. Lee dated October 25, 1954, together with the exhibits thereto annexed, numbered 6 through 12. [201]

2.

The following portions of the deposition of Sidney G. Thornbury, taken March 7, 1957:

- (a) Page 4, line 19, to page 5, line 4.
- (b) Page 7, lines 1 to 6, inclusive.
- (c) Page 11, lines 16 to 18, inclusive.
- (d) Page 11, line 25, to page 12, line 2.
- (e) Page 12, lines 12 to 15, inclusive.
- (f) Page 13, lines 1 to 5, inclusive.
- (g) Page 16, lines 8 to 16, inclusive.
- (h) Page 18, line 15, to page 19, line 6.
- (i) All of page 20.

- (j) All of page 21.
- (k) Page 22, lines 1 to 7, inclusive.
- (l) Page 24, lines 13 to 22, inclusive.
- (m) Page 28, line 23 to page 29, line 2.
- (n) Page 30, line 19, to page 31, line 7.
- (o) Page 31, lines 17 to 25, inclusive.
- (p) Page 32, lines 2 to 18, inclusive.
- (q) Page 33, line 12, to page 34, line 6.
- (r) Page 37, line 18, to page 38, line 2.

3.

The following portions of the deposition of Charles R. Ursell, taken January 29, 1957:

- (a) Page 15, lines 12 to 17, inclusive.
- (b) Page 16, lines 5 and 6.
- (c) Page 45, lines 13 to 21, inclusive. [202]

Dated at Los Angeles, California, this 11th day of February, 1958.

FULWIDER, MATTINGLY &
HUNTLEY,

ROBERT W. FULWIDER,
WALTER P. HUNTLEY,
JOHN M. LEE AND
JOHN A. WEYL,

/s/ By WALTER P. HUNTLEY,
Attorneys for Appellee. [203]

Affidavit of Service by Mail Attached. [204]

[Endorsed]: Filed Feb. 11, 1958.

[Title of District Court and Cause.]

CERTIFICATE BY CLERK

I, John A. Childress, Clerk of the above entitled Court, hereby certify that the items listed below constitute the transcript of record on appeal to the United States Court of Appeals for the Ninth Circuit, in the above-entitled case:

A. The foregoing pages numbered 1 to 204, inclusive, containing the original:

Complaint

Affidavit of John M. Lee

(Copy) Minute Order of Court, 12/13/54

Amended Answer to Complaint and Counterclaim

Answer to Counterclaim of Defendant Cee-Bee Chemical Co. Inc.

Stipulation and Order for Dismissal without prejudice of Plaintiff's Second and Third Causes of Action

Notice of Motion and Motion for Summary Judgment, with supporting Affidavits, Exhibits, File Wrapper, etc.

Defendant's Notice Re Plaintiff's Motion for Summary Judgment

Reporter's Transcript of Proceedings had on 9/13/54 in Case No. 15,820-WM Clarence P. Taylor v. Keuffel and Esser Co., etc., (attached to "Defendant's Notice Re Plaintiff's Motion for Summary Judgment")

Memorandum of Decision

Findings of Fact, Conclusions of Law and Summary Judgment

Notice of Appeal

Designation by Appellant Cee-Bee Chemical Co. Inc. of Contents of Record on Appeal

Statement by Appellant Cee-Bee Chemical Co. Inc. of Points on Appeal

Counter-Designation by Appellee Delco Chemicals Inc. of Additional Contents of Record on Appeal

B. Depositions of: Sydney G. Thornbury; Robert C. Bear; Thomas H. Edgin; and Charles R. Ursell.

C. One volume of Reporter's Transcript of Proceedings had on: February 11, 1957.

I further certify that my fee for preparing the foregoing record, amounting to \$2.00 has been paid by appellant.

Dated: February 13, 1958.

[Seal] JOHN A. CHILDRESS,
 Clerk,
 /s/ By WM. A. WHITE,
 Deputy Clerk.

[Title of District Court and Cause.]

DEPOSITION OF ROBERT C. BEAR

Washington, D. C.

Monday, September 12, 1955

* * * * *

ROBERT C. BEAR

called as a witness by counsel for defendant, and having first been duly sworn, was examined and testified as follows:

Direct Examination

Q. (By Mr. Welsh): Will you please state your full name? A. Robert C. Bear.

Q. Where do you live, Mr. Bear?

A. 1138 Linden Avenue, Takoma Park, Maryland.

Q. Is Takoma Park, Maryland, a suburb of Washington, D. C.? A. Yes.

Q. By whom are you employed?

A. Capital Airlines, Washington National Airport, Washington, D. C.

Q. How long have you been employed by Capital Airlines? A. Nine years.

Q. In what capacity or capacities have you been employed [2]* by that airline?

A. As a mechanic, instructor, and foreman.

Q. What is your present capacity with Capital Airlines? A. Assistant foreman.

Q. Assistant foreman of any particular depart-

* Page numbers appearing at top of page of Original Deposition.

(Deposition of Robert C. Bear.)

ment? A. The fuel tank repair department.

Q. Now, who is the foreman of that department?

A. There isn't any foreman of that department. I would be.

Q. Then, practically speaking, you are the foreman of the fuel tank repair section; is that correct?

A. That is right.

Q. As foreman of the fuel tank repair section, what are your duties generally?

A. To perform all maintenance and overhauls on the fuel tanks of the Douglas C-54s, DC-4s, and Lockheed Constellation aircraft. [3]

* * * * *

Q. At the time you used the fill-soak-and-drain method, [11] were you aware of any disadvantages in that method of procedure?

A. Yes, we were.

Q. Could you, in general, enumerate some of those disadvantages?

A. The one disadvantage was the amount of material needed to accomplish this procedure. [12]

* * * * *

Q. Now, in addition to the fact that the fill-soak-and-drain method consumed such a quantity of stripping chemical, were there any other disadvantages that were apparent to you at the time you were using it?

A. Well, the terrible odor that is given off from this material caused other workmen around the

(Deposition of Robert C. Bear.)

hangars to be very, very dissatisfied with working in that hangar. [14]

* * * * *

Q. Now, in addition to that, can you think of any other disadvantage that was apparent to you at the time you were using this fill-soak-and-drain method?

A. Well, another disadvantage is that this material is not light per gallon. I don't exactly remember the pounds per gallon that it weighs, but an airplane with 1,100 gallons of it in one side of the wing creates a hazard to this extent: that it throws the airplane slightly off balance and you are not able to have any other personnel working on the aircraft at that time, due to the unsafe condition that is presented there.

Q. During the process of stripping the sealant off of the inside of the tank when using the fill-soak-and-drain method, were you able to have other operations being performed to the aircraft?

A. No. [15]

* * * * *

Q. (By Mr. Welsh): Did the Cee-Bee process of stripping the inside of integral fuel tank wings through recirculation ever come to your attention?

A. Yes, it did.

Q. When? A. In late 1950.

Q. I will show you a photostatic copy of a purported patent No. 2,653,116, issued to K. R. Whitcomb, et al., and ask you to please observe Figure 1.

Does Figure 1 represent the Cee-Bee recirculat-

(Deposition of Robert C. Bear.)

ing process that came to your attention in 1950?

A. Yes. [19] * * * * *

Q. Now, at the time this method first came to your attention, did you have any resistance to it?

A. Yes, I did.

Q. Would you please explain why?

A. Well, I was skeptical of it, as I was skeptical of all fuel tank materials and methods, because in the past everybody was trying to get a new method and a better method, and none of them were any good; so any time a new method came up, you were always skeptical of it until you would see the thing in operation and it proved itself.

Q. Now, did you, on behalf of your employer, Capital Airlines, make any investigation of this Cee-Bee recirculating method?

A. Yes, I did. I went to Pacific Airmotive, in Chino, California, in September of 1951, and observed the working of this machine on C-54 aircraft out there. [20]

* * * * *

Q. (By Mr. Welsh): Then, subsequent to that, what did you do, if anything, in connection with the Cee-Bee method?

A. Well, we ordered the Cee-Bee Chemical Company to deliver us one of their machines, and their material, so we could start operation in October of 1951 on our C-54 aircraft overhaul.

Q. Did you, in fact, use the Cee-Bee method on any aircraft subsequent to that time? In other words, after you ordered it?

(Deposition of Robert C. Bear.)

A. Yes, we did. [21]

* * * * *

Q. First, I shall ask you, from your experience in desealing aircraft, both using the Cee-Bee method and the fill-and-drain method, and from the experiments which you conducted, can you tell us what the average elapsed time is in desealing a DC-4 aircraft with four tanks by the Cee-Bee method?

A. That would be 55 hours, average. [25]

Q. What would the average time consumed be, using the fill-and-drain method?

A. About 192 hours.

Q. Approximately, on the average, how many man hours are consumed in using the Cee-Bee method to deseal? A. About 200.

Q. Approximately how many man hours are consumed in using the fill-and-drain method to deseal? A. About 800, anyway.

Q. How many gallons of stripping chemical are you unable to use again if the Cee-Bee process is employed? A. About 250 gallons.

Q. This is per aircraft, all of this?

A. Per aircraft, yes.

Q. How many gallons are you unable to use again—— A. Approximately——

Q. Wait a minute.

——should you use the fill-soak-and-drain method?

A. Approximately 1,200 gallons. [26]

* * * * *

(Deposition of Robert C. Bear.)

ing process that came to your attention in 1950?

A. Yes. [19] * * * * *

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Q. Did you, in fact, use the Cee-Bee method on any aircraft subsequent to that time? In other words, after you ordered it?

(Deposition of Robert C. Bear.)

A. Yes, we did. [21]

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Q. This is per aircraft, all of this?

A. Per aircraft, yes.

Q. How many gallons are you unable to use again—— A. Approximately——

Q. Wait a minute.

——should you use the fill-soak-and-drain method?

A. Approximately 1,200 gallons. [26]

* * * * *

(Deposition of Robert C. Bear.)

Q. Could you list for us some of the advantages of the Cee-Bee recirculating spray method, compared to the fill-and-drain method?

A. Well, number one, you don't have to have as large a quantity of material on hand.

Number two, it only requires one man to operate the machine while it is in operation, and your safety hazard is pretty great, because you can work other men on the aircraft while it is in operation.

And your health standpoint from fumes is less in the recirculation or recirculating method.

And as a safety factor, to me, we don't have the hazard of this material or chemical dripping down on people underneath [37] the wing, or walking underneath the wings. It doesn't have to be roped off to keep men away from there.

Q. Safety for the employees you are talking about now? A. Yes.

Q. May I ask you in connection with the hand-picking whether there is an advantage or not in connection with the Cee-Bee method?

A. Well, there is considerably less hand-picking with the Cee-Bee method than there is with the fill-and-drain method. [38]

* * * * *

[Endorsed]: Filed Sept. 20, 1955.

[Title of District Court and Cause.]

DEPOSITION OF THOMAS H. EDGIN

Oklahoma City, Oklahoma

September 17, 1955

* * * * *

THOMAS H. EDGIN

being by me first duly sworn to tell the whole truth
as hereinafter certified, testified as follows:

Direct Examination

Q. (By Mr. Welsh): Will you please state your
full name? A. Thomas H. Edgin.

Q. Where do you live, Mr. Edgin?

A. 2503 South Central, Oklahoma City, Oklahoma.

Q. What is your business or occupation, sir?

A. I am a mechanical engineer.

Q. And by whom are you employed?

A. Tinker Air Force Base.

Q. That is the United States Air Force, is it?

A. Yes, sir.

Q. How long have you been associated with the
United States Air Force?

A. Thirteen years and three months. [3]*

* * * * *

Q. Now, the purpose of applying this sealant
material is what, sir? [11]

A. To prevent aircraft fuel tanks from leaking.

Q. And is it necessary once this material is

* Page numbers appearing at top of page of Original Deposition.

(Deposition of Thomas H. Edgin.)

applied to take it off again, or does it stay on there for the life of the aircraft?

A. It stays on until the aircraft develops sufficient leaks it no longer is practical to make spot repairs.

Q. And then what must be done?

A. The sealant material must be removed from the airplane and replaced.

Q. Now, back in 1946 and '47, did your work require you to supervise the desealing operation, or the operation conducted to take the sealant off of the wings? A. Yes, sir.

Q. And what method or methods did you use in order to deseal the integral fuel tanks at that time?

A. At that time there was two methods for local spot repairs and hand work was accomplished, and when aircraft with more extensive leaking the aircraft was returned for what we call fill and drain desealing. [12]

* * * * *

Q. Now, when you use this fill and drain method, do you encounter any particular problems?

A. Yes, we did. It was difficult to use due to the conditions in which the people that had to accomplish the work had to work, and after the airplane had soaked for its soak period of time the access doors were removed and it was necessary for people to get inside the aircraft wing and hand-remove the deposits that were left from the soak period, and it was very hazardous, if you got it on your hands it would burn, or if you got it in your eyes or nose or

(Deposition of Thomas H. Edgin.)

mouth it would be more detrimental to people, and it was toxic, and the [13] safety equipment the people were required to wear was very bundlesome and it cut down on the speed with which the working people could work.

Q. Were these various problems which you recited sufficiently great that there was work being done to attempt to find a better method, if you know? A. Yes.

Q. What was being done at that time to eliminate these problems?

A. Well, numerous trial and error approaches were made; however, none of them that we made were too effective.

Q. Did any of them come to your attention that were effective?

A. In the early part of 1952, there were two chemical companies brought it to our attention that they had a system which was much better, faster and cheaper than the method that we were using.

Q. And before then had you encountered any methods for doing this job that eliminated many, at least, of the problems that you have recited?

A. No. [14]

* * * * *

Q. Now, when the recirculating spray system was first brought to your attention, what was your reaction to that?

A. I was dubious as to its capability.

Q. Why were you dubious?

(Deposition of Thomas H. Edgin.)

applied to take it off again, or does it stay on there for the life of the aircraft?

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(Deposition of Thomas H. Edgin.)

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Q. What was being done at that time to eliminate these problems?

A. Well, numerous trial and error approaches were made; however, none of them that we made were too effective.

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Q. And before then had you encountered any methods for doing this job that eliminated many, at least, of the problems that you have recited?

A. No. [14]

* * * * *

Q. Now, when the recirculating spray system was first brought to your attention, what was your reaction to that?

A. I was dubious as to its capability.

Q. Why were you dubious?

(Deposition of Thomas H. Edgin.)

A. We had had past experiences with not too good results or no improvement.

Q. You mean that other persons had offered possible solutions?

A. We had tried it ourselves to improve the situation with very little positive results.

Q. Now, Mr. Edgin, I show you what purports to be a true copy of the Figures 1 and 2 of the Patent in suit, No. 2,653,116, and ask you whether or not that generally describes or graphically illustrates the recirculating spray system that you have just referred to?

A. The basic principles in this drawing are the same which I referred to. [15]

* * * * *

Q. Now, did you determine to make any tests using these circulating spray systems, the one proposed by Turco and the one proposed by Cee-Bee?

A. Yes.

Q. And did you, in fact, make any tests?

A. We made comparative tests of both systems against [16] our own fill and drain system.

Q. In making those tests, did you record the results therefrom? A. Yes.

Q. And did you make an original report based upon the test of your personal observations?

A. Yes.

Q. Could you please tell us where that original report is?

A. It is filed at Tinker Air Force Base.

Q. Did you bring it with you today?

(Deposition of Thomas H. Edgin.)

A. No, I did not. * * * * *

Q. Did you at the time you made your original report, make any copies thereof which were sent to any other agencies? A. Yes. [17]

Q. And among others, did you send a copy to the Cee-Bee Chemical Company? A. Yes.

Q. I show you, Mr. Edgin, what purports to be a copy of your report and ask you whether or not it is in all respects a true and correct copy of the original report filed with the Government?

A. Yes, it is.

* * * * *

Q. Alright, I would like to ask that this document to which we have been referring, the copy of the report, be marked as the defendants' exhibit first in order for the purposes of this deposition.

Mr. Fellers: To which the plaintiff objects as being incompetent, irrelevant and immaterial, and not the best evidence.

(The instrument produced and identified is now by the Notary marked for identification as Defendants' Exhibit A.) [18]

[See page 183.]

* * * * *

Q. Now, sir, if you will, turn to page 4 of Defendants' Exhibit A and tell me what that page contains?

A. It contains other important advantages of the Cee-Bee Chemical Company's process.

Q. And how many advantages have you listed there? A. Twenty-one.

(Deposition of Thomas H. Edgin.)

Q. Would you please read the first one, sir?

A. Automatic filtering unit incorporated in machine.

Q. And what advantage is there to you because the automatic filtering unit is incorporated in the machine?

A. Well, the automatic filtering unit removes all of the loose sealing material that has been stripped out of the wing and takes it out of the recirculating system, thereby preventing the further weakening of the solution; and also it eliminates the hand-work and any manual work of the people who had to previously had to get in the wing to carry it out.

* * * * *

Q. Alright, sir, what is the sixth advantage you have listed there?

A. The absence of fumes in the whole hangar to work.

Q. Did you have fumes in the whole hangar when you used the fill and drain method?

A. On numerous occasions it was quite a frequent happening that on fill and drain the desealing material would eat out the sealing material and leak out on the hangar floor causing a mess and it rapidly evaporated and bothered people's eyes.

Q. And this problem was entirely eliminated by the recirculating spray system, was it?

A. For all practical purposes it was. [27]

* * * * *

DEFENDANTS' EXHIBIT "A"

(Copy)

OKLAHOMA CITY AIR MATERIEL AREA

Tinker Air Force Base

Oklahoma City, Oklahoma

Cee-Bee Chemical Co., Inc.

655-57 East Gage Avenue

Los Angeles 1, California

Gentlemen:

Copy of evaluation report of the Cee-Bee desealing process is forwarded for your information.

Sincerely,

W. O. MOORE,

Colonel, USAF,

Director, Maint. Engineering,

By TOM EDGIN,

Engr.

1 Incl

Report

(Copy)

EVALUATION REPORT OF THE CEE-BEE
DESEALING PROCESS

A C-54 type airplane was selected for this demonstration. The fuel tanks were sealed with TC-48 material which averaged $\frac{1}{8}$ " thickness. The corners and doors were sealed with EC-801 (AAF Spec 14153) which averaged $\frac{1}{2}$ " thickness. The average time and materials required for desealing this type airplane by the fill and drain process is used for comparative purposes. The time and materials aver-

ages are taken only from airplanes sealed with TC-48 material that have been desealed at this Headquarters.

(Copy)

FILL & DRAIN METHOD

Material Needed

Mixture of 70% Dichloride, 30% methylene chloride. .01% Triethylamine and .1% Naccanol @ \$1.67 per gal. (mixed)
—4000 gal. required per airplane.

Total Material Cost: \$6,680.00

Cost of Material Lost

1200 gal. @ \$1.67 per gal..... \$2,004.00

Cost: \$2,004.00

Elapsed Time

14½ Days Total

12½ working days

2 days over weekend

2 shifts per day

Manhours

32 Manhours for mixing material

32 Manhours for setting up & filling tanks

1400 Manhours for hand work

1464 Total Manhours

Total Cost

1464 Manhours @ \$2.81 per hr..... \$4,113.84

1200 Gallon material @ \$1.67 per gal..... 2,004.00

Total Cost: \$6,117.84

CEE-BEE CHEMICAL CO. PROCESS

Material Needed

| | |
|-------------------------------------------|------------|
| 495 Gal. Cee-Bee PR-37 @ \$3.15 per gal. | \$1,559.25 |
| 55 Gal. Cee-Bee PR-38 @ \$3.65 per gal... | 200.75 |

Total Material Cost:..... \$1,760.00

Cost of current to operate equipment: negligible.

Cost of Material Lost

| | |
|---------------------------------------------|--------|
| 275 Gal. Cee-Bee PR-37 @ \$3.15 per gal. \$ | 866.25 |
| 55 Gal. Cee-Bee PR-38 @ \$3.65 per gal... | 200.75 |

Cost: \$1,067.00

Elapsed Time

5 Days Total

2 shifts per day

Manhours

24 Manhours for setting up equipment

460 Manhours for hand work

484 Total Manhours

Total Cost

| | |
|-----------------------------------|------------|
| 484 Manhours @ \$2.81 per hr..... | \$1,360.04 |
| 330 Gal. Cee-Bee Stripper..... | 1,067.00 |

Total Cost: \$2,427.04

ROTO JET PROCESS

Material Needed

| | |
|--------------------------------------------|------------|
| 522 Gal. Turco 2822 Thin @ \$2.97 per gal. | \$1,550.34 |
| 96 Gal. Gasoline @ \$.25 per gal..... | 24.00 |

Total Material Cost:..... \$1,574.34

Cost of Material Lost

| | |
|---------------------------------------------------|-----------|
| 192.5 gal. Turco 2822 Thin @ \$2.97 per gal. | \$ 569.80 |
| 96 gal. gasoline @ \$.25 per gal..... | 24.00 |

Cost: \$ 593.80

Elapsed Time

9 Days Total

- 7 working days
- 2 days over weekend
- 2 shifts per day

Manhours

- 40 Manhours for setting up equipment
- 763 Manhours for hand work

803 Total Manhours

Total Cost

| | |
|---------------------------------------------------|------------|
| 803 Manhours @ \$2.81 per hr..... | \$2,256.43 |
| 96 Gal. Gasoline @ \$.25 per gal. | 24.00 |
| 192.5 Gal. Turco 2822 Thin @ \$2.97 per gal. | 569.80 |

Total Cost: \$2,877.23

(Copy)

Other Important Advantages of the Cee-Bee
Chemical Co. Process

1. Automatic filtering unit incorporated in machine.
2. Individual electric driven pumps for each operation.
3. All desealing hoses metal covered.
4. Spray nozzles concentrated at corners and fittings.
5. Positive check on all spray nozzles during operation.
6. Absence of fumes in whole hangar to work.
7. Toxicity and hazards are minimized.
8. No need for transferring large quantities of material.
9. No need for large storage and inventory.
10. Workmen do not come in direct contact with stripper.
11. Desealing machine is portable and self contained.
12. Actual stripping time is reduced.
13. The need for spray or brush on of stripper is minimized.
14. No need for fill and drain.
15. Removal of loose sealant during recirculating permits following:
 - a. Longer tank life of solution.
 - b. Allows fresh stripper to work on unremoved sealant.
 - c. Minimizes removal of loose sealant by 90%.

16. With present facilities, twice as many tanks can be stripped with one unit.

17. Permits inspection of stripper process during operation.

18. Less damage to tank due to hand picking.

19. Small quantity of material required for operation.

20. Two outer panels can be run simultaneously or main and auxiliary.

21. High pressure rinse can be done simultaneously with desealing operation.

[Endorsed]: Filed Oct. 17, 1955.

[Title of District Court and Cause.]

DEPOSITION OF CHARLES R. URSELL

Brownsville, Texas

January 29, 1957

* * * * *

CHARLES R. URSELL

a witness named in the annexed notice, being of lawful age, and being first duly sworn in the above cause, testified on his oath as follows:

Direct Examination

Q. (By Mr. Welsh): Will you please state your full name, sir? A. Charles R. Ursell.

Q. Where do you reside, Mr. Ursell?

A. 1718 Boca Chica Boulevard, Brownsville, Texas.

Q. We are now in Brownsville, Texas taking your deposition, is that correct?

A. That is correct.

(Deposition of Charles R. Ursell.)

Q. Mr. Ursell, by whom are you employed?

A. Pan American World Airways.

Q. In what capacity are you employed by them?

A. Maintenance Engineer.

Q. How long have you been employed by that company?

A. Fourteen years.

Q. And in what particular division of the Pan American Airways are you employed?

A. Maintenance.

Q. Is there a maintenance plant or maintenance facilities here in Brownsville?

A. Yes. [4]*

* * * * *

Q. Have you ever written anything concerning airplane wings or fuel tanks?

A. Yes, in the late 1940's, I don't remember the year exactly, approximately 1945. Mr. Zerelli, Mr. Lindberg and myself, all with Pan American, wrote an S.A.E. paper on all forms of fuel carrying facilities, such as tanks, bladder and integral tanks. [6]

* * * * *

Q. Do you hold any position or do you have any quasi official position with the United States Civil Aeronautical Authority?

A. Other than a pilot's license I am also designated Engineering Representative for the Civil Aeronautics Administration qualified in structures, systems and equipment. [7]

* * * * *

Q. Now, would integral fuel tanks, their con-

* Page numbers appearing at top of page of Original Deposition.

(Deposition of Charles R. Ursell.)

struction and their sealing and so forth, come within your authority as representative of the C.A.A.?

A. Yes. Integral fuel tanks has always been considered a part of structure. [8]

* * * * *

A. Sealant was removed by what is commonly referred to as the hand method of scraping the sealant out and using solvent to clean it thereafter.

Q. Was that method unsatisfactory or satisfactory?

A. We consider it unsatisfactory. [11]

* * * * *

A. In 1946, I believe the date was, we tried to desal a Constellation oil barrel by the fill and drain method, simply by filling it up with stripping compound and pumping it out and filling it up again and pumping it out. This didn't prove very successful. [12] * * * * *

Q. All right, did you at some time hear of a method which the Cee-Bee Chemical Company had for recirculating chemicals in the integral fuel tanks? A. Yes.

Q. When was that? A. About 1946.

* * * * *

Q. I hand you this document, Mr. Ursell, which shows figures "1" and "2" of the patent in suit and ask you if the method indicated on that document is the method which the Cee-Bee [15] Chemical Company at some time showed to you?

A. Yes. * * * * *

(Deposition of Charles R. Ursell.)

(Said instrument marked for identification as Defendant's Exhibit "A".) [16]

* * * * *

A. When I was first told about it, and after four years of digging for answers to the desealing problem, I received it as skeptical as a person can be, because of so many other ideas that were offered along the same line. After visiting the L.A.S.I. desealing operation and viewing the end results I was impressed to the point that I advised our management in Miami that we should also make a trial utilization of this equipment.

* * * * *

A. I believe it took me about two years to convince my management and I think the time was 1948 or '49 when they desealed a Lockheed Constellation in Miami, which I believe is the first Lockheed Constellation to ever be completely [17] desealed and resealed to that date.

* * * * *

Q. What was the results of that procedure?

A. When the aircraft was ready for resealing after they had completed the entire desealing operation I was amazed to find that we could disassemble some of the structural joints without finding but a bare minimum of desealing compound in the faying surface.

* * * * *

Q. All right. How did you consider the entire job to have worked out?

A. Very satisfactory. In fact, that was the only

(Deposition of Charles R. Ursell.)

Lockheed Constellation we desealed and resealed in our entire fleet because we were preparing to retire the fleet or sell it and to date that airplane has had the fewest fuel leaks in integral [18] fuel tank problems on any of the Constellations we have been flying.

* * * * *

Q. As a result of your satisfaction with this method in using it on your own ground, what, if any, changes did you make in your procedures for desealing your aircraft?

A. All aircraft thereafter operated out of the Miami base that were desealed, were desealed by the Cee-Bee method.

* * * * *

A. In the three years that I have been working back in Brownsville we have solely used the Cee-Bee desealing method and that has been on a number of aircraft.

Q. Is that method the same method which is shown schematically in Defendant's Exhibit "A" for identification? A. Yes.

Q. Now, does the Cee-Bee recirculating method have certain advantages which were not present in the other methods which you had used? You may answer that "yes" or "no". A. Yes.

Q. Can you please state what those advantages are? [19]

A. The first advantage is the use of a minimum amount of manpower; second advantage——

* * * * *

(Deposition of Charles R. Ursell.)

A. The second advantage is the shorter elapsed time to accomplish the end results and this is accomplished by the fact there are only so many holes in the wing and therefore you can only put so many men in the holes to do the job. And therefore with the total man-hours it takes a certain elapsed amount of time to do that job whereas the machine can operate in all holes at once and eliminate all but one man to watch the machine. Therefore, saving considerable manpower and elapsed time by doing the job all at once. [20]

* * * * *

A. The end results of the job by using the Cee-Bee Method is a much cleaner tank. That naturally means better sealing because today's sealants are better than they used to be. It requires a chemically clean surface and by doing the job by hand it is much more difficult to get that clean a surface than it is by the spray method.

Q. All right. Can you think of any other advantages, if there is any?

A. The airplane down-time is shortened and the overall cost is shortened. [21]

* * * * *

Q. Is there any advantage in so far as protection to the plane's surface itself?

A. Yes. When you use the spray method or Cee-Bee Method you don't have to go in and scrape all this sealant out and therefore you can eliminate the possible damage to the structure. You can eliminate

(Deposition of Charles R. Ursell.)

the personnel hazard caused by handling the powerful stripping compound. [22]

* * * * *

Q. Before the Cee-Bee Method was brought to your attention did you at any time consider using a similar method to that used in cleaning railroad cars and ship's hulls, using such a method in your desealing operations? A. No.

Q. Since you have experience in this particular field of desealing, as you have indicated, can you tell me whether or not in your opinion one who is versed in the art of desealing aircraft integral fuel tanks would ordinarily think of applying to the desealing operation a method similar to that which is used in railroad tanks and ship's hulls?

A. No, I would never think to apply something like that to the aircraft business, because first the different types of metal. The aircraft is basically aluminum and light weight structure, very thin, whereas ships and railroad cars and so forth are basically steel and very heavy structure. And the loss of any of the thickness of metal wouldn't have very much [25] effect on a ship or tank whereas an airplane, even 1/1000 of an inch is important to us. I might add that in the engineering field that the decimal point that the bridge or ship engineers throw away, that is all we deal in in the aircraft business, the decimal point to the right. You have got a different size of unit, a ship or tank is a mammoth thing. Some tanks are fairly small, but at least they are normally big enough for a man to get

(Deposition of Charles R. Ursell.)

into, whereas an aircraft tank until the B-36 came along was rather small hole and normally a man couldn't even get into it. The second thing is, they normally wouldn't cut a hole big enough in one of those things for a man to get through, because of the basic structure of the airplane which you have to cut through.

* * * * *

Q. Now, before you used the Cee-Bee recirculating Method how did you take the sealant compound out of the aircraft stringers?

A. Well, at first they were so difficult to clean out that [26] we just plugged them up and forgot about them, but then we found out to have a tank free from leaks you have to get under there and clean that out and put it back together again, you have to lift the stringer out and clean it out and put it back.

* * * * *

Q. Now, you say it was necessary to actually physically remove this stringer in order to effectively clean it, is that right? A. Yes.

Q. Now, did the Cee-Bee recirculating method make any difference in the process you had to follow in order to effectively clean the stringers?

A. Yes. With that pressure spray method they offered a process of inserting a tube in that section and forcing the removed sealant out by pressure method and it would work all the way through the stringer if you would let it run full time that the tank was being desealed in the other areas. This

(Deposition of Charles R. Ursell.)

was [27] a time saving operation in that after the remainder of the tank was desealed you didn't have to go in and clean out the stringers, they were already cleaned out at the same time. [28]

* * * * *

Cross Examination * * * * *

Q. (By Mr. Huntley): You mentioned that in the old process you had to remove the stringers?

A. If we wanted to clean that section.

Q. The Cee-Bee Company has offered a method of cleaning these stringers in place? A. Right.

Q. Is that method shown on Exhibit "A"?

A. No, there is no reference on this Exhibit "A" at all dealing with stringers. [45]

* * * * *

[Endorsed]: Filed Feb. 12, 1957.

[Title of District Court and Cause.]

DEPOSITION OF SYDNEY G. THORNBURY

Los Angeles, California

March 7, 1957

* * * * *

SYDNEY G. THORNBURY

a witness called by the defendant and being first duly sworn, testified as follows:

* * * * *

Direct Examination

Q. (By Mr. Stratton): Will you state your name and business address, please?

A. My name is Sydney G. Thornbury. "Syd-

(Deposition of Sydney G. Thornbury.)

ney" is spelled with a "y". My business address is Turco Products, Inc., 6135 South Central Avenue, Los Angeles.

Q. What is your occupation?

A. I am the president of Turco Products.

Q. How long have you been connected with this company?

A. Since 1927 or about 30 years.

Q. How long have you been president of this company?

A. Since 1938. [2]*

* * * * *

Q. What college did you attend?

A. I attended the University of Oregon and the University of California at Los Angeles.

Q. How many years of academic training did you have in those two colleges?

A. Five.

Q. And did that academic training include any academic work in chemistry?

A. Yes; it did. [3]

* * * * *

Q. Are you a member of any chemical organization?

A. Yes; I am a member of the American Chemical Society.

Q. How long have you been a member of that Society?

A. For something over 20 years.

* * * * *

Q. Are you familiar with Cee-Bee Patent No.

* Page numbers appearing at top of page of Original Deposition.

(Deposition of Sydney G. Thornbury.)

2,653,116, which is the patent involved in the present suit? A. Yes.

Q. And are you familiar with the process of desealing integral aircraft wing fuel tanks covered in that patent? A. Yes; quite generally.

Q. When did you first hear of it?

A. I am not sure that I understand the question. When did I first hear of the patent?

Q. No; the process.

A. Of the process of removing sealant from integral fuel tanks?

Q. Yes.

A. About 1943 or '4, I believe. At least it was at [4] that point when it became a matter of some reasonable interest.

Q. Do you mean when the need for such arose?

A. Yes; that is right.

Q. Does not the patented process that I referred to include the removal of sealant by spraying solvent or stripper against the sealant in the aircraft wing tank? A. Yes; it does.

Q. What is the nature of the solvent or stripper that is used to remove the sealant from aircraft wing fuel tanks?

A. Typically, it is a highly volatile solvent. Those commonly in use are based upon chlorinated hydrocarbons, customarily methylene chloride, which are activated in various ways to cause them to attack the rubbery sealant compound either to tear it loose from the sides of the walls or by bringing it into solution. * * * * * [5]

(Deposition of Sydney G. Thornbury.)

Q. And what is the nature of the sealant after the solvent or stripper is applied to it?

A. Typically, it goes through various stages of gooiness. We have a term which we apply to this. We call it gooification. The solvent begins by causing the rubber to swell. In some cases the swelling may be sufficient to loosen the adhesive bond to the sides of the tank, but, more typically, it becomes gooey on the surface and gradually swells through the entire polymer, becoming increasingly gooey and eventually, if the contact time is sufficient it may pass into solution. [6]

Q. Would you say that the sealant has the same condition whether it is soaked in the solvent or whether the solvent is sprayed on the sealant?

A. Assuming that the exposure is equivalent, that is, equivalent in effect, not necessarily equivalent in time, the result should be the same.

Q. You were familiar with these facts about the nature of the solvent and sealant at the time that you first heard of the Cee-Bee spray process, weren't you? A. Yes; I was.

Q. Were you at that time of the opinion that the Cee-Bee spray process would or would not be operative?

A. I did not believe the process would be operative.

* * * * *

Q. Why did you feel that the Cee-Bee spray process would not be operative?

(Deposition of Sydney G. Thornbury.)

A. To begin with, there is an inherent difficulty in the cleaning of any enclosed vessel of complicated shape by a spray process and that problem is the problem of actually getting complete coverage of the entire inner surface, particularly in an aircraft wing tank where you have baffles and stringers, reinforcing members, rivets, and so on, behind which or under which the sealant is. The problem of actually getting contact of the desecant with the sealing [7] compound appeared to me to be probably unsolvable, and there were other difficulties which appeared to me to be quite real.

* * * * *

It seemed to me reasonably certain that the solvent saturated by this gooey material could not be successfully circulated through sprays; that the sprays would plug up; that the entire circulating system itself would quickly be fouled up to the point where the cleaning time necessary to keep it operating would make it economically impractical.

* * * * *

Q. (By Mr. Stratton): Does Turco Products, Inc. manufacture or have manufactured for it and either use or sell machines for spraying solvent or stripper on a sealant in an integral aircraft fuel tank for removing sealant from loosened solvent and for respraying the solvent on remaining sealant in a closed circuit? A. Yes. [9]

Q. And the Cee-Bee Chemical Company also has machines of this character? A. Yes; they do.

(Deposition of Sydney G. Thornbury.)

Q. And you have seen the latter in operation?

A. Yes.

Q. Did Turco Products, Inc. first build such a machine before or after you first saw Cee-Bee's such machines operate? A. Afterwards.

Q. Is Turco Products, Inc. now a licensee under the Cee-Bee patent in suit? A. Yes; it is. [10]

* * * * *

Q. What are stringers in aircraft?

A. Stringers are reinforcing members. Shall I describe them?

Q. Where are they found in aircraft?

A. They are located in the fuel cell structure.

Q. Do you mean in the wings of aircraft?

A. That is right, inside of the wings.

Q. And is it a fact that they run longitudinally with the wings and are for strengthening purposes?

A. That is correct.

Q. And are you familiar with the fill, soak and drain method of removing sealant from aircraft wing tanks? A. Yes; I am.

Q. And are you familiar with trying to remove sealant from stringers by the fill, soak and drain method? A. Yes.

Q. And what is the situation there?

A. Well, actually, by straight fill and drain, this job usually cannot be done. The stringer is thoroughly filled with the sealing compound in many of the ships and, while the solvent applied by fill and drain will attack the [11] sealant at the ends

(Deposition of Sydney G. Thornbury.)

of the stringers, it has some exposure to it. I have never seen an instance, that I recall, where the sealant in the stringer was successfully removed merely by that method.

* * * * *

Q. Could you tell me whether the fill, soak and drain method was ever generally used in the industry for desealing aircraft wing fuel tanks?

A. Yes; I would say it was generally used. [12]

* * * * *

Q. Can you tell what the effect is on the spray method of cleaning out the sealant from the stringers?

A. If the spray method is so arranged that there is definite contact of the vapors of the solvent with the sealant in the stringers, it can be removed.

Q. Are the stringers or are they not now required to have their sealant removed when there is a desealing operation on the fuel tank of an aircraft?

A. I understand generally it is required.

Q. Before Turco Products, Inc. built its first machine for desealing purposes, do you know whether any objections were made as to whether spraying the solvent or stripper would be dangerous?

* * * * *

The Witness: Yes.

Q. (By Mr. Stratton): And can you tell me what the nature of those objections was?

* * * * *

(Deposition of Sydney G. Thornbury.)

A. The objections raised were those that I mentioned earlier, the possibility of introducing toxic fumes into the air, the probability of high cost operation, the possibility of fire hazard and the practical difficulties of actually [13] getting contact of the solvent on all of the sealants, and there were other objections raised. As I think I pointed out, these tanks are of baffled construction, which means that they are divided into compartments with only small openings typically between the baffled compartments. This would appear to mean that some sort of plumbing job would be necessary in order to get spray heads into each separate compartment and so on.

* * * * *

Q. (By Mr. Stratton): Were you one of the persons who made these objections?

A. Yes; I was.

Q. Are these baffles sometimes called bulkheads?

A. Yes.

Q. Can you tell me what the effect is of spray fumes in an aircraft integral tank during the de-sealing operation when a desealant is sprayed in the tank?

A. The fumes themselves have an effect on the sealant analogous to the effect of the solvent in liquid form. The rubber absorbs the fumes and starts going through the swelling, softening the solution, stages which I think I described [14] earlier.

(Deposition of Sydney G. Thornbury.)

Q. Can you state whether these fumes reach any parts of the sealant that are not reached by impingement of the sprays?

A. Yes. This was an unexpected dividend of the spray process. We found, contrary to what we had supposed, it was possible to reach these areas effectively by the fumes even where the solvent in liquid form would not go.

Q. You say they were unexpected. Do you mean you did not anticipate these until it was actually tried?

A. That is true.

Q. Did Turco Products, Inc. have a license under Land Patent No. 1,666,015?

A. Yes; we did.

Q. And at what period, approximately?

A. As I recall it, we took out that license in 1930. I am not positive about this date, but that is my recollection, and we were licensed under the patent, I believe until it expired, which would have been in 1945 or 1947—1945. [15]

* * * * *

Q. Would you state whether or not the spray method about which you have testified has largely displaced the fill, soak and drain method in the industry of cleaning sealant from integral aircraft fuel tanks?

A. It has largely displaced it in many segments of the aircraft industry, but the other methods are still used to some extent.

Q. Which method is used more than any other?

(Deposition of Sydney G. Thornbury.)

A. The spray method is the most commonly used.

Q. Was there or was there not a long-felt need in the industry for a method to remove sealant satisfactorily, economically and with dispatch, when the spray method began to be adopted by the de-sealing industry?

A. Yes, sir. [16]

* * * * *

Cross Examination * * * * *

Q. (By Mr. Huntley): On the question of cleaning stringers, you stated that the spray process will clean the stringers out if the process was so arranged that there is a definite contact of the fumes with the sealant in the stringer. In the practice of this spray process, is it left solely to the contact of fumes with the sealant in the stringer or are there auxiliary methods used to clean out the stringers?

A. Very frequently auxiliary methods are used.

Q. And what are those?

A. As I have seen it done, an auxiliary line from the spray machine is directed at the stringer to get as much liquid contact as can be obtained in that way. [18]

Q. This is a separate spray?

A. That is right.

Q. Separate and distinct from the sprays that are used to spray the general interior of the tank, is that right?

A. It would be a separate nozzle. * * * * * [19]

Q. (By Mr. Huntley): You testified, I believe,

(Deposition of Sydney G. Thornbury.)

that in the fill, soak and drain method the stringers were not cleaned out but that in the spray method the stringers would be cleaned out if the fumes were to reach the material on the inside of the stringer, is that correct?

A. Yes; at least in part.

Q. And you also testified that the action of the fumes on the sealant is substantially the same as the action of the same chemical in a liquid phase has on the sealant? A. Yes.

Q. Would not the liquid in the fill, soak and drain process reach substantially every point that is reached by the fumes in the spray process?

A. Well, it is true that in both cases it was necessary to make adaptations of the process.

Q. In other words, for cleaning out the stringers, something extra and special has to be done to clean out the stringers?

A. It is advisable; yes. But, in the case of the fill and drain, this means the adoption of what may be an element of the spray method, that is, you may provide an auxiliary spray system with the fill and drain method in order to accomplish this thoroughly.

Q. And you may also provide such an auxiliary spray with the spray system, is that right?

A. Yes. [20]

Q. Did I understand your testimony correctly to be that the need for an economical and effective method of desealing first became apparent when

(Deposition of Sydney G. Thornbury.)

the need for desealing C-54s and DC-4s became apparent?

A. Yes; I think that is generally true. This was the first time that there were substantial numbers of these planes in constant daily use.

Q. I think you testified on one occasion that this may have been around 1943 or 1944 and then a few moments ago you said this was probably 1945 or 1946. Can you fix the date any more closely than the span of three or four years?

A. As I recall it, we first became actively interested in the problem in 1944 and actually desealed our first ship, our first C-54, in 1945. This is as I recall it and I think the dates are right.

Q. Prior to that time, at least as far as aircraft wing tanks were concerned, there was no actual need for such a desealing process, isn't that true?

A. Prior to that time some desealing was done, but it was minor in amount. So that the pressure for a more effective or less expensive method did not exist or at least it was not directed to our attention.

Q. Is it not true that, prior to 1945-1946, this same process was used in the cleaning of tanks other than airplane wing tanks, as, for example, railway tank cars? [21]

A. I think that would require me to define what the "same process" is. As I have indicated in an affidavit, the spray method of cleaning tank cars, marine tanks, storage vats, and so on, was in use for a very long time.

(Deposition of Sydney G. Thornbury.)

Q. And by a very long time, do you mean prior to 1945 or 1946? A. Yes.

* * * * *

Redirect Examination * * * * *

Q. (By Mr. Stratton): Can you tell me what method you used to deseal the [22] first aircraft integral fuel tank?

A. This was done by the method which we called the spray and scrape method. In other words, a man would actually stick his head up into the integral tank, the bottom section having been removed, and would apply the desealant by means of a pressure pot, something of the type used for spraying paint. This would then be allowed to stay in contact with the desealant until it was partially softened. It might be then resprayed one or several times and then finally the sealant would be removed by hand-scraping and then would follow various hand-cleaning methods, hand-picking, the use of a solvent applied by brush or a rag to clean up the residual traces, followed then perhaps by chromic acid rinse to passivate the surface. This is the method in which the so-called "Men From Mars" costumes were used. This involved protective clothing and the use of helmets to supply air for breathing and so on.

Q. Can you tell what objections there were to that method, why it wasn't continued instead of the patented spray method?

A. The basic objection was the question of the time required and the high labor charges.

(Deposition of Sydney G. Thornbury.)

Q. Do you mean it was prohibitively expensive for labor? A. Yes; I would say so. [23]

* * * * *

Q. And what were you referring to as having happened in 1944? That you first became acquainted with this method or what?

A. It was in 1944 we began to take a substantial interest in the possibility of a market for chemicals to be used for this purpose. We conferred with the representatives of the aircraft plants and with the military and we started designing our chemicals to be used for this purpose.

Q. In what year? A. In 1944. [24]

* * * * *

Q. Then you would be spraying the sealant in the stringer?

A. Yes. However, where the stringer is absolutely sealed, there is a good chance of the vapors getting in where it would be difficult for the liquid to follow, if I make myself clear. [26]

* * * * *

Q. Is there any complicated shape as to the tank car shown in that drawing?

* * * * *

A. The only complication shown is the bell-shaped top of the tank or I mean the point of entry.

Q. That small dome in the center of the top?

* * * * *

A. As shown in the drawing, it is a cylindrical-shaped tank, without any apparent complications.

(Deposition of Sydney G. Thornbury.)

Q. Does that cylindrical-shaped tank have any baffles or stringers in it? A. Not as shown.

* * * * *

Q. And is there any material in that that would have stages of gooification that you have referred to?

A. I don't recall any difficulties of that kind.

Q. And there is nothing in that tank that would foul up the sprays shown therein?

A. Well, nothing is shown in the drawing. I mean there is nothing shown as to the character of the soil that might be in the tank.

Q. What is the usual material, that you have referred to as soil, that would be removed from a tank car?

A. It varies considerably. These tanks, of course, carry many things; typically, vegetable oils, for example, lard, petroleum products, gasoline and light distillates and crude oil.

Q. Would you include molasses and milk in the contents of tank cars? A. Yes.

Q. Are any of these materials that you or I have mentioned of a gooey nature?

A. Well, you run into questions of definition there.

Q. Molasses might be gooey, but I mean, when it is mixed with water, is the resultant mixture or any part of it gooey?

A. It is not gooey in the sense that a softened rubber is gooey.

Q. Is there any mechanical problem in a tank

(Deposition of Sydney G. Thornbury.)

car in reaching the entire area within the tank?

A. Yes, depending on the construction of the tank.

Q. In the tank that is shown here in this drawing, [28] Exhibit B, is there any problem?

A. No.

Q. What is the nature of the material that is used to remove the different oily or petroleum products, that you have mentioned, in removing them from a tank car?

A. Most commonly it is an alkaline detergent dissolved in a heated-water solution.

Q. Is it a material, when so mixed, say similar to the result that a housewife obtains in a washing machine where she mixes a detergent with the water in it?

A. Yes; this would be comparable except that stronger chemicals are used than the housewife would commonly employ. [29]

* * * * *

Recross Examination * * * * *

Q. (By Mr. Huntley): You are reasonably familiar, then, with the construction of railway tank cars? A. Yes.

Q. It is not uncommon, is it, for such tank cars to have baffles and antislosh plates and such things?

A. That is true. They are built that way.

Q. Also, it is not uncommon to transport such materials as asphalt in these cars, is it? [30]

A. That is true.

Q. And do they not also carry some of the syn-

(Deposition of Sydney G. Thornbury.)

thetic plastic materials unpolymerized?

A. Yes; I believe that is true.

Q. These are fairly heavy, sticky, gummy, gooey, liquids, are they not? A. Undoubtedly.

* * * * *

Q. It is true, is it not, that in the cleaning of tank cars solvents are used as well as water solutions or detergents? A. Yes; on occasions.

Q. To go back to airplane wings, you testified on redirect examination concerning difficulties of getting contact between the liquid and the material in the stringer in the upper part of the tank?

A. Yes. * * * * * [31]

Q. Are there such stringers or reinforcing members in the lower part of the tank?

A. Yes; I believe so.

Q. These would be completely submerged in the fill and drain process, wouldn't they?

A. Yes.

Q. Now, considering the upper stringers, if I understand the problem correctly, you had what I will call a dead air space at the top of the tank?

A. That is correct.

Q. So that the liquid level did not reach up to the stringer? Is that the problem?

A. That is one of the problems; yes.

Q. Isn't this dead air space saturated with the vapor of the solvent with which the tank is filled?

A. Certainly, it would carry some of the vapor, but whether it would be saturated or not I don't really know. [32]

* * * * *

(Deposition of Sydney G. Thornbury.)

Q. This physical process that goes on in a dead space above a liquid consists in molecules of the chemical solvent escaping from the liquid body and entering the space above and other molecules returning back to the liquid and this is an equilibrium condition, isn't it? When equilibrium conditions are established, the molecules re-enter the liquid at the same rate the other molecules leave the liquid, isn't that true?

A. I think this is the accepted theory.

Q. So you have what is, in effect, a constant generation of vapor and a constant condensation back into the body of the liquid, is that true?

A. Yes.

Q. And it is in this space that the stringer we are talking about is located, is it not? [33]

A. That is true.

Q. So there would certainly be some opportunity, a substantial opportunity, for this vapor to come in contact with the sealant?

A. There would certainly be some opportunity for it to happen. [34]

* * * * *

Redirect Examination * * * * *

Q. (By Mr. Stratton): Let me restate it. Counsel for the plaintiff is apparently trying to show that there are fumes no matter which method is used, the fill, soak and drain method or the spray method, and I am asking whether there is any difference in the efficiency of those fumes when you use the fill, soak and drain method and the fumes

(Deposition of Sydney G. Thornbury.)

that are produced in the tank by the use of the spray method.

A. That is not quite the same thing, if I understand [35] your question. I said earlier that the typical solvent used in these desealants is methylene chloride and this solvent boils not many degrees above room temperature; and I believe that what occurs here is that, by the friction of spraying the solution, the solvent in part may actually be heated above its boiling point. So that what contacts the sealant in the spray method is something approaching pure solvent in the vapor phase rather than the theoretical mixture of air and solvent which might lay above a static body of the desealant liquid at a temperature below the boiling point of that liquid. [36]

* * * * *

Recross Examination * * * * *

Q. (By Mr. Huntley): Then, I will ask it again. Isn't it true that, in order to do a completely adequate and satisfactory job of cleaning out stringers, resort must be had to some means other than the mere contact of the vapor with the material in the stringer?

A. Yes; I would say, generally speaking, that is probably true.

Q. And these other expedients are the use of an auxiliary spray, for example, as you previously testified? Is [37] that not so? A. Yes. [38]

* * * * *

[Endorsed]: Filed March 27, 1957.

[Title of District Court and Cause.]

TRANSCRIPT OF PROCEEDINGS

Los Angeles, California

Monday, February 11, 1957

Honorable William C. Mathes, Judge Presiding.

Appearances: For the Plaintiff: Fulwider, Mattingly & Huntley, By—Walter P. Huntley, Esq., 5225 Wilshire Boulevard, Los Angeles, California. For the Defendant: C. G. Stratton, Esq. and Louis Welsh, Esq., 210 West Seventh Street, Los Angeles, California. [1]*

Monday, February 11, 1957; 10:10 A.M.

The Clerk: Case No. 17,387, Delco Chemicals, Inc. vs. Cee-Bee Chemical Co., Inc.

The Court: Is there anything to be said on these motions to produce other than what has been said in the memorandums, gentlemen?

Mr. Stratton: There is only one other thing, your Honor, in this motion to compel the production of documents that was not stated here.

The record shows that some over \$11,000 was paid by the plaintiff to its employees for salaries in supervising and directing the carrying out of the accused process.

The Court: The defendant's motion deals with the question of damages, doesn't it?

Mr. Stratton: Yes, your Honor.

The Court: We are a long ways from that.

Mr. Stratton: This is a jury case. We will need

* Page numbers appearing at top of page of Reporter's Transcript of Record.

it for the trial, your Honor. That is, at the time of the trial next week we will need to present to the jury how much damage the defendant has suffered.

The Court: Anything further?

Mr. Stratton: No, your Honor.

The Court: The plaintiff's motion for compelling production will be granted. [2]

Mr. Welsh: I wanted to oppose this motion.

The Court: Which motion?

Mr. Welsh: Plaintiff's motion for production of documents.

Mr. Stratton: We are the defendants.

Mr. Huntley: There are two motions.

The Court: Plaintiff's motion, and there is defendant's motion, as I read the record. I am granting the plaintiff's motion. I haven't ruled on the defendant's motion.

Mr. Stratton: It was the defendant's motion I was speaking of, your Honor.

The Court: I understand.

I will deny defendant's motion, without prejudice to a renewal of it if this case goes to trial by jury.

In going over this voluminous file, gentlemen, I am wondering if the matter couldn't possibly be disposed of if the plaintiff should make a motion for a summary judgment on the counterclaim. And I will entertain a motion for a summary judgment on the counterclaim if the defendant is advised to grant it. I am not disposed to spend a week hearing this case before a jury, gentlemen, in the present posture of it. I never had an opportunity to go over the file before. I received this case upon a transfer.

I don't know what the outcome of the motion would be, but I would like to explore the possibility of disposing of [3] it on a motion for summary judgment.

Mr. Welsh: May I speak to that, your Honor?

The Court: Yes.

Mr. Welsh: I question the advisability of a motion for summary judgment in this case because there is a very definite issue of fact which will be presented to the court.

The Court: What issue?

Mr. Welsh: The issues, of course, dealing with question of patentability. I don't think there is any question of infringement. The infringement is clear.

The Court: Is there anything complicated about this patent at all in process? Anything at all that could possibly be opened to require the testimony of experts to explain the process?

Mr. Welsh: Oh, I don't think we need experts.

The Court: Or is the prior art so complicated that the court can't understand it?

Mr. Welsh: I think the court could understand this case or any other case. That isn't the point.

The Court: That is very flattering, but we'll just talk about this case.

Mr. Welsh: My point is that I don't feel whether the court is capable of understanding it or not has anything to do with whether or not a motion for summary judgment should be granted. [4]

The Court: I am familiar with all that has been said, I think, in the Court of Appeals on this subject.

Then there is the question of prior public use. Is that affidavit of prior public use denied?

Mr. Welsh: There is no prior public use that I am aware of.

The Court: Isn't there an affidavit of prior public use?

Mr. Stratton: Not in this case. The affidavit was that they had used it before this case was filed, a few weeks before, so as to grant jurisdiction to this court. Otherwise, their case would have been thrown out of the court on the ground they had not made any use——

The Court: I misread the date in the affidavit.

Mr. Welsh: This court, of course, is thoroughly familiar with the—I forget the name of the case. Perhaps Mr. Stratton remembers it. The High Court case.

The Court: If I can't grant it on the issue of validity, perhaps I can grant it on the issue of infringement, which is quite a different situation.

Mr. Welsh: Well, I doubt very much——

The Court: In any event, I will invite a motion, and if the plaintiff doesn't wish to file it, then we will try this case some other time. But I don't intend to spend next week trying this case to a jury. I have never yet tried a [5] patent case to the jury and I don't intend to until I have to.

Mr. Welsh: Very well.

The Court: If the defendant doesn't wish to entertain the possibility of filing a motion for summary judgment, why, then that's another matter.

Mr. Welsh: You are speaking of the plaintiff.

The Court: Yes, on the counterclaim.

Mr. Welsh: Very well.

The Court: And that's another one of these anomalies. These things come in backwards. It's hard enough for the court to keep it straight. It's a patent infringement action backwards; that's what it is. And then you expect to present this to the jury?

Mr. Welsh: We were going to suggest in that connection this morning that we be permitted to proceed first as though we were plaintiff, if this case were tried.

We have no desire to present it in a way that is confusing, and we had planned to suggest that. I don't think we have asked for anything we are not entitled by the Constitution and laws of this nation.

The Court: You are entitled to a trial by jury.

Mr. Welsh: That is all we are asking for.

The Court: Yes.

Mr. Huntley: We will prepare a file and motion for summary [6] judgment as soon as possible.

The Court: Very well.

Mr. Huntley: Shall we attempt to set it for hearing on the date now set for trial, or at a later date?

The Court: Set it for hearing any Monday. I suggest you set it for hearing March 4th.

Mr. Huntley: That will be agreeable.

Mr. Stratton: Then they will, I take it, file it in due time and give us an opportunity of suggesting dates, thinking of the date.

The Court: Is March 4th too early?

Mr. Stratton: It depends on when we get the motion, your Honor.

The Court: It should be noticed in time under the rule.

Mr. Huntley: We should be able to file it within the end of this week. That will give you the 10 days.

Mr. Stratton: That will be satisfactory.

The Court: Very well. The pretrial hearing will be ordered off calendar, pending the hearing and determination on the motion for summary judgment. The trial will be ordered off calendar. And I have already ruled on the motion for production.

[Endorsed]: Filed Dec. 31, 1957.

[Endorsed]: No. 15893. United States Court of Appeals for the Ninth Circuit. Cee-Bee Chemical Co., Inc., a corporation, Appellant, vs. Delco Chemicals, Inc., a corporation, Appellee. Transcript of Record. Appeal from the United States District Court for the Southern District of California, Central Division.

Filed: February 14, 1958.

Docketed: February 19, 1958.

/s/ PAUL P. O'BRIEN,
Clerk of the United States Court of Appeals for
The Ninth Circuit.

In the United States Court of Appeals
for the Ninth Circuit

No. 15893

CEE-BEE CHEMICAL CO., INC., a corporation,
Appellant,

vs.

DELCO CHEMICALS, INC., a corporation,
Appellee.

ADOPTION BY APPELLANT OF STATE-
MENT OF POINTS ON APPEAL AND
DESIGNATION OF RECORD ON APPEAL

Comes now the above-named appellant, by its counsel, and hereby adopts the Statement of Points on Appeal, and the Designation by Appellant of Contents of Record on Appeal, appearing in the typed record on appeal filed in the above case by the Clerk of the District Court of the United States, Southern District of California, Central Division.

Dated at Los Angeles, California, this 26th day of February, 1958.

C. G. STRATTON,
LOUIS M. WELSH,
/s/ By C. G. STRATTON,
Attorneys for Appellant.

Affidavit of Service by Mail Attached.

[Endorsed]: Filed February 28, 1958. Paul P. O'Brien, Clerk.

[Title of Court of Appeals and Cause.]

ADOPTION AND DESIGNATION BY APPEL-
LEE OF ADDITIONAL PARTS OF THE
RECORD TO BE PRINTED

Comes now the above-named Appellee, by its counsel, and adopts the counterdesignation by Appellee, Delco Chemicals, Inc., of additional contents of Record on Appeal as its designation of the additional part of the record which it thinks material and which shall be printed.

Dated at Los Angeles, California, this 3d day of March, 1958.

FULWIDER, MATTINGLY &
HUNTLEY,
ROBERT W. FULWIDER,
WALTER P. HUNTLEY,
JOHN M. LEE AND
JOHN WEYL,

/s/ By WALTER P. HUNTLEY,
Attorneys for Appellee.

Affidavit of Service by Mail Attached.

[Endorsed]: Filed March 5, 1958. Paul P.
O'Brien, Clerk.